

***United States Court of Appeals  
for the Second Circuit***



**JOINT APPENDIX**





76-7189

IN THE  
United States Court of Appeals  
FOR THE SECOND CIRCUIT

Appeal No. 76-7189

SHATTUCK ET AL.,

*Appellants,*

v.

HOEGL ET. AL.,

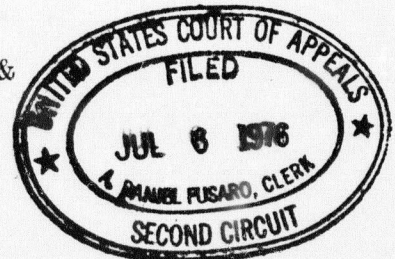
*Appellees.*

ON APPEAL FROM THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF NEW YORK

JOINT APPENDIX

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New York, New York 10017  
*Attorneys for Appellants*

BRUMBAUGH, GRAVES, DONOHUE &  
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*Attorneys for Appellees*



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DOCKET ENTRIES

BEST COPY AVAILABLE

UNITED STATES DISTRICT COURT

Jury demand date:

C. Form No. 106 Rev.

Misc. Civil

TITLE OF CASE	ATTORNEYS
SHATTUCK, et al.	For plaintiff: Bruce E. Hansen, Esq. (appe)
	William H. Helferich III
v.	<del>Wiser, Shaw, Freeman, VanGraafeiland</del>
	Harter, Secrest & Emery
HOEGL, et al.	700 Midtown Tower
	Rochester, N.Y. 14604
	Joseph G. Walsh
	IBM Corporation
	Monterey and Cottle Roads
	San Jose, Calif. 95114
	Robert J. Kadel
	Clyde C. Metzger
	Sidney R. Bresnick
	Pennie & Edmonds
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	New York, N.Y. 10017
	For defendant:
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	Rochester, New York 14614
	Francis J. Hone
	Ronald B. Hildreth
	Brumbaugh, Graves, Donohue & Raymond
	30 Rockefeller Plaza
	New York, N.Y. 10020
Boris Haskell	Anthony W. Karambelas
Paris, Haskell & Levine	Xerox Corporation
1232 Pennsylvania Bldg.	Xerox Square
Washington, D.C. 20004	Rochester, N.Y. 14644

STATISTICAL RECORD	COSTS	DATE	NAME OR RECEIPT NO.	REC.	DISB.
S. 5 mailed	Clerk	5/14/74	#94457	500	500
		5/22/74	translsc/PSD		
S. 6 mailed	Marshal				
asis of Action:	Docket fee				
ceedings ancillary to					
tion pending in U.S.	Witness fees				
tent Office (Interference					
ction arose at: No. 98,047)	Depositions				



A      2  
Docket Entries

Misc. Civil      Shattuck, et al. v. Hoegl, et al.

DATE 1974	PROCEEDINGS	Date Of Judgment
Feb. 11	Filed Shattuck's Notice of Taking Deposition of Giacomo Barchietto, Helmut Hoegl, John W. Weigl, Peter H. Kondo and Anthony W. Karambelas	
20	" Deposition Subpoena with Marshal's return--John W. Weigl served 2/11/74	
21	" Deposition Subpoena with Marshal's return--Peter H. Kondo served 2/19/74	
21	" Deposition Subpoena with Marshal's return--Anthony W. Karambelas served 2/19/74	
Mar. 6	" at Roch. Movant's motion and notice of motion for discovery in Interference No. 98,047 pending in the U.S. Patent Office--ret. 3/11/74 at Roch.	
6	" at Roch. Movant's Affidavit of Clyde C. Metzger	
7	" at Roch. Respondent's Affidavit and Order adjourning motion for discovery to 3/25/74--Burke, DJ	
11	Motion by movants for discovery in Interference No. 98,047 - no appearances--adj. to 3/25/74	
13	Filed at Roch. Movant's affirmation and Order that motion for discovery will be heard on 3/15/74	
15	" Deposition Subpoena with Marshal's return--John W. Weigl served 3/13/74	
19	" at Roch. Appearance of counsel of Elliott Horton as additional counsel for Hoegl, et al.	
27	" Order directing Mr. Weigl to answer questions he refused to at the deposition of 2/20/74 and he shall appear on 4/5/74 to answer said questions and at this time produce any documents in his possession, etc.--Burke, DJ Notice & copies to Wiser, Shaw, Freeman, VanGraafeiland, Harter & Secrest and Harris, Beach & Wilcox	F-1
Apr. 23	" at Roch. Order to show cause why witness Weigl should not be compelled to produce, allegedly privileged documents and supporting memorandum--Burke, DJ	
30	" Memorandum of Hoegl et al. in opposition to the Shattuck et al. request for a show cause order	
30	" Supplemental Memorandum in support of movants' request for an order to show cause why the witness Weigl should not be compelled to produce allegedly privileged documents	
May 3	" Supplemental Memorandum of Hoegl et al. in opposition to the Shattuck et al. request for privileged and work product documents	
3	" Letter dated 5/3/74 from Anthony W. Karambelas to the Hon. Harold P. Burke and attached Memorandum of Law submitted on behalf of party Hoegl et al. in response to fraud accusation and in opposition to motion of party Shattuck et al. for further discovery and exhibits	
8	" Order that witness Weigl produce identified documents and answer all questions relating to such documents, etc.--Burke, DJ Notice & copies to Wiser, Shaw, etc. and Harris, Beach & Wilcox	F-1
14	" at Roch. Motion by Hoegl, et al. for a stay pending appeal and supporting memorandum--ret. 5/16/74	
14	" at Roch. Respondent's Notice of Appeal (copy mailed 5/15/74 to Mr. Helferich and to Clerk, CCA with copy of docket entries; CCA's Forms C and D mailed to Mr. Horton)	
17	" at Roch. Stipulation and Order staying discovery proceedings pending appeal--Burke, DJ	F-1



A      3  
Docket Entries

DATE	PROCEEDINGS	Det Judge
1974		
May 21	Filed Transcript of proceedings on 3/19/74	
21	" Transcript of proceedings on 4/30/74	
29	Original pertinent papers, docket entries and Clerk's certificate mailed to Clerk, CCA	
June 17	Filed Bond for costs on appeal	
1975		
Oct. 22	Filed opinion & certified copy of judgment of CCA dismissing appeal for lack of jurisdiction with costs to be taken against the appellants in the amount \$376.82.	
Nov. 10	Original papers returned from CCA	
Dec. 4	Filed Pltfs. notice of motion to compel the witness Karambelas to produce allegedly privileged documents etc. ret. 12-22-75	
8	Filed stipulation & order adj. the motion ret. 12-8-75 to 12-22-75-Burke, DJ	F-
22	" Hoegl, et al., affidavit of Francis J. Hone	
22	" Hoegl, et al., affidavit of Boris Haskell	
22	" Hoegl, et al., affidavit of Anthony W. Karambelas	
22	" certificate of service of above affidavits.	
22	Motion by Shattuck, et al. to compel witness to produce & testify. to be submitted 10 days from today.	
1976	Supplemental	
Mar. 6	Filed Affidavit of Robert J. Kadel with exhibits and affidavit of Clyde Metz	F-1
Mar. 16	Filed Decision & Order denying the motion of Meredith D. Shattuck & Ulo Vahtra to compel the witness Karambelas to produce allegedly privileged documents & to compel witnesses to testify etc., - Burke, DJ Notice & copies to Harter, Secrest & Emery; Pennie & Edmonds; Joseph G. Walsh; Brumbaugh, Graves, Donohue & Raymond; Paris, Haskell & Levine and Anthony Karambelas; Harris, Beach and Wilcox	
Apr. 9	Filed at Roch. Notice of Appeal of Movants Meredith D. Shattuck, Ulo Vahtra and International Business Machines Corp. (copy mailed 4/12/76 to Messrs. Honeg, Horton, Haskell and Karambelas and to Clerk, CCA with copy of docket entries; CCA's Forms C and D mailed to Mr. Hansen)	
9	" Bond on Appeal	
19	" at Roch. Movants' Designation of Contents of Record and Statement of Issue	
26	" Movants' Certificate of Service of designation of contents of record and statement of issue	
30	" Respondents-Appellees' Response to designation of contents of record	
May 12	" Order sealing Exhibits 15 and 16 and Appellants' response to appellees' response to designation of record-Burke, DJ	
12	" Amended Appellants' response to appellees' response to designation of record	

DECISION AND ORDER OF JUDGE BURKE DATED MARCH 11, 1976

United States District Court  
FOR THE WESTERN DISTRICT OF NEW YORK

SHATTUCK, ET AL

Movants

vs

HOEGL, ET AL

Respondents

Patent Interference  
No. 98,047

*Misc. Civ.*

Decision

ORDER

BURKE, DISTRICT JUDGE



*Decision and Order of Judge Burke Dated March 11, 1976*

UNITED STATES DISTRICT COURT  
WESTERN DISTRICT OF NEW YORK

---

SHATTUCK, ET AL,

Movants

- vs -

Patent Interference  
No. 98,047

HOEGL, ET AL,

Respondents

---

Harter, Secrest & Emery  
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% International Business Machine Corp.  
San Jose, Calif. 94115  
(of counsel)

Brumbaugh, Graves, Donohue & Raymond  
30 Rockefeller Plaza  
New York, N.Y. 10020  
by Francis J. Hone

Paris, Haskell & Levine  
Washington, D.C.  
and  
Anthony W. Karambelas  
Xerox Corporation  
Xerox Square  
Rochester, N.Y. 14644  
Attorneys for respondents

Harris, Beach & Wilcox  
2 State Street  
Rochester, N.Y. 14614  
by Elliott Horton  
(of counsel)

By motion filed December 4, 1975, Meredith D. Shattuck and Ulo Vahtra, moved to compel the witness Karambelas to produce allegedly privileged documents, and to compel witnesses to testify by deposition in connection therewith. A subpoena duces tecum issued from this court on February 15, 1974 to Karambelas and Kondo, attorneys for Xerox Corporation. Those subpoenas sought testimony and production of documents relating to such work done at Xerox prior to August 1, 1964.

By this motion Shattuck et al seek certain documents, referred to in Shattuck, et al, Exhibit 27, from the files of Karambelas. In an effort to compromise this controversy and to make an accurate and complete record concerning the work done at Xerox under Weigl prior to August 1, 1964, Hoegl, et al, offered to disclose to Shattuck, et al, all of the subpoenaed information in the documents of Exhibits 27 and to permit continuation of the depositions. In return Shattuck, et al, were merely requested to agree that such voluntary disclosure by Xerox would not amount to waiver of the attorney-client privilege or work product immunity as to unsubpoenaed information. Details of this offer and the movants rejection are set forth in the affidavit of Francis J. Hone, attorney for Hoegl, et al.

Hoegl, et al, opposed the motion claiming that Shattuck, et al, have acquiesced in the claim of privileged



and work product immunity with respect to Exhibit 27 documents, and upon the ground that there is now no outstanding order or process of this court upon which the motion could properly be based.

The special proceedings instituted with respect to Karambelas and Kondo, both Xerox attorneys, by service of the subpoena issued in February 1974 were completed by the appearance and testimony of those witnesses in compliance with the subpoenas. The failure to Shattuck, et al, to take any action at that time in April 1974 with respect to the documents in question together with subsequent inaction, amounts to a waiver of any right Shattuck, et al, may have had over the subpoenas to obtain the documents and information which are the subject of this motion.

The witness Kondo appeared on February 21, 1974 and his deposition was concluded on that date. No question concerning documents within the scope of the subpoena duces tecum was propounded to Kondo. No question of complete compliance with the subpoena as to matters identified in the appended document schedule was raised. Kondo's deposition was therefore completed as to all matters. There is no basis for this motion to compel as to Kondo.

Karambelas gave testimony relative to all of the issues of the interference in his deposition which commenced

on February 21, 1974 and was completed on April 24, 1974. The claim of privileged and work product immunity as to information contained in the documents identified in Exhibit 27 was raised on April 24, 1974. Then Shattuck, et al, sought an order from this court requiring production of other privileged documents withheld by the witness Weigl. Although Shattuck, et al, referred to the Exhibit 27 privileged documents in oral argument before this court on April 30, 1975, Shattuck, et al, made no request that those documents be included within the scope of those matters submitted to the court. Shattuck, et al, have waited for nearly two years before asserting noncompliance of Karambelas with the February 1974 subpoena duces tecum.

The issues concerning production of the documents of Exhibit 27 are not the same as those raised previously in connection with the deposition Exhibit 26. The Exhibit 27 documents contain unsubpoenaed information. Karambelas did not agree that this court's ruling as to Exhibit 26 documents would govern Exhibit 27 documents. I so find.

The objections made at the Karambelas' deposition specifically put the movants on notice that Hoegl, et al, did not consider the issues to be the same. The election of movants to obtain a ruling only as to the Exhibit 26 documents



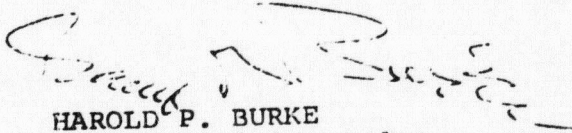
*Decision and Order of Judge Burke Dated March 11, 1976*

of Weigl amounts to a waiver of any continuance of the special proceeding instituted with respect to Karambelas. The proceeding directed to him was completed.

The materials called for by the Karambelas and Kondo subpoenas issued in February 1974 were specified by Shattuck, et al. The witnesses had a duty to produce materials which were not called for in the Shattuck, et al, subpoenas. By this motion Shattuck, et al, is seeking unsubpoenaed information contained in the documents of deposition Exhibit 27.

The motion of Meredith D. Shattuck and Ulo Vahtra to compel the witness Karambelas to produce allegedly privileged documents and to compel witnesses to testify by deposition in connection therewith, is in all respects denied.

SO ORDERED.

  
HAROLD P. BURKE  
United States District Judge

March 11, 1976.

A 10

NOTICE OF MOTION OF SHATTUCK ET AL. UNDER RULE 37  
F.R.CIV.P. TO COMPEL PRODUCTION OF HOEGL ET AL.

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF NEW YORK

-----x	)	
SHATTUCK ET AL.,	)	
	)	
Movants,	)	
	)	
v.	)	Re: Patent Interference
	)	No. 98,047
HOEGL ET AL.,	)	
	)	
Respondents.	)	
-----x	)	

NOTICE OF MOTION

TO: Messrs. Brumbaugh, Graves,  
Donohue & Raymond  
Francis J. Hone, Esq.  
30 Rockefeller Plaza  
New York, New York 10020

PLEASE TAKE NOTICE that movants, Meredith D.  
Shattuck and Ulo Vahtra, will present for hearing at the  
United States Courthouse, Rochester, New York, on the <sup>23d</sup> 8th  
day of December at 10:00 A.M., the attached SHATTUCK ET AL.  
MOTION UNDER RULE 37 F.R.Civ.P. TO COMPEL THE WITNESS  
KARAMBELAS TO PRODUCE ALLEGEDLY PRIVILEGED DOCUMENTS AND TO  
COMPEL WITNESSES TO TESTIFY IN CONNECTION THEREWITH.

Dated: November 26, 1975.

Respectfully submitted,

Of Counsel:

Pennie & Edmonds  
Clyde C. Metzger  
Robert J. Kadel  
Sidney R. Bresnick  
330 Madison Avenue  
New York, New York 10017

WISER, SHAW, FREEMAN, VAN  
GRAAFEILAND, HARTER & SECREST

By Pennie & Edmonds

700 Midtown Tower  
Rochester, New York 14604  
(716) 232-6500

Joseph G. Walsh, Esq.  
International Business Machines  
Corporation  
Monterey & Cottle Roads  
San Jose, California 95114



MOTION OF SHATTUCK ET AL. UNDER RULE 37 F.R.CIV.P. TO  
COMPEL PRODUCTION OF HOEGL ET AL. WITH ANNEXED EXHIBIT 27

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF NEW YORK

-----x	)	
SHATTUCK ET AL.,	)	
	)	
Movants,	)	
	)	
v.	)	Re: Patent Interference
	)	No. 98,047
HOEGL ET AL.,	)	
	)	
Respondents.	)	
-----x	)	

SHATTUCK ET AL. MOTION UNDER RULE 37 F.R.Civ.P. TO COMPEL THE  
WITNESS KARAMBELAS TO PRODUCE ALLEGEDLY PRIVILEGED DOCUMENTS  
AND TO COMPEL WITNESSES TO TESTIFY IN CONNECTION THEREWITH

Meredith D. Shattuck and Ulo Vahtra ("Shattuck et. al."),  
Movants herein, having sought to obtain the production of docu-  
ments and the deposition testimony of one Anthony W. Karambelas,  
Xerox Corporation, Xerox Square, Rochester, New York, to whom a  
subpoena duces tecum issued from this Court on or about February  
15, 1974 pursuant to U.S.C., Section 24, respectfully moves this  
Court for an Order:

I. Compelling the witness Anthony W. Karambalas, or the  
real party in interest, Xerox Corporation, to produce to Movants  
the documents identified in Shattuck et al. Deposition Exhibit 27  
annexed hereto.

II. Compelling the witness Anthony W. Karambalas and the  
witness Peter H. Kondo to appear at the offices of Wiser, Shaw,  
Freeman, Van Graafeiland, Harter & Secrest, 700 Midtown Tower,

*Motion of Shattuck et al. under Rule 37 F.R.Civ.P. to  
Compel Production of Hoegl et al. with Annexed Exhibit 27*

Rochester, New York 14604, on December 10, 1975 at 2:00 P.M. or as soon thereafter as the attorneys for the respective parties herein agree, to answer all questions relating to such documents.

III. Requiring that Respondents pay to Movants the reasonable expenses incurred in obtaining this Order, including attorney's fees.

Submitted herewith in support of this Motion is Shattuck et al.'s Memorandum In Support Of Motion Under Rule 37, F.R.Civ.P., and the Affidavit of Robert J. Kadel.

Respectfully submitted,

WISER, SHAW, FREEMAN, VAN GRAAFEILAND,  
HARTER & SECREST

By \_\_\_\_\_

700 Midtown Tower  
Rochester, New York 14604  
Tel. (716) 232-6500  
Attorneys for Movants

OF COUNSEL:

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Clyde C. Metzger  
Robert J. Kadel  
Sidney R. Bresnick

Joseph G. Walsh  
International Business Machines Corporation  
Monterey & Cottle Roads  
San Jose, California 95114



*Motion of Shattuck et al. under Rule 37 F.R.Civ.P. to  
Compel Production of Hoegl et al. with Annexed Exhibit 27*

List of Privileged or Work Product Documents in the  
Xerox Files Relating to Interference No. 98,047 Between  
Hoegl et al and Shattuck et al in the United States  
Patent Office Which Were Prepared on or Before November 7,  
1972 and Which Relate to Work done in Connection With the  
Subject Matter of the Interference Prior to August 1, 1964:

<u>Originator</u>	<u>Recipient/Distributees</u>	<u>Date</u>	<u>Subject</u>
J. Weigl	A. Mahassel,-J. Mammino	4/2/70	Battelle Work on Heavily Doped PVK.
Patent Department	-----	----	Draft Patent Application PVK/TNF.
H. Hoegl	A. W. Karambelas	9/14/72	Meeting attended by A. W. Karambela: H. Hoegl, G. Barchietto, B. Dousse, M. Vimic
G. Barchietto	A. W. Karambelas	9/14/72	Meeting attended by A. W. Karambela: H. Hoegl, G. Barchietto, B. Dousse, M. Vimic
J. Weigl	A. W. Karambelas	9/5/72	Capsule history of interactions with H. Hoegl (Aug'62-Sept'64)
J. Mammino	J. Weigl	3/26/70	Invention proposal: High Speed Organic Photoconductor Coatings.
Peter H. Kondo	Francis J. Hone - A. A. Mahassel J. J. Ralabate	4/10/70	Transmittal of information and documents.
Patent Department	-----	-----	Revised Application. Draft PVK/TNF
Patent Department	-----	-----	Handwritten notes (10pages) re: PVK/TNF work
Patent Department	-----	-----	Correlation between Mammino work and Fig. 2 of IBM Pater.

*Motion of Shattuck et al. under Rule 37 F.R.Civ.P. to  
Compel Production of Hoegl et al. with Annexed Exhibit 27*

- |     |                   |       |       |  |
|-----|-------------------|-------|-------|--|
| 11. | P. H. Kondo       | ----- | ----- | Draft of "Request<br>for Interference."  |
| 12. | Patent Department | ----- | ----- | Draft Affidavit.   |
| 13. | Patent Department | ----- | ----- | Typed and handwritten<br>notes and questions<br>re: PVK-TNF work<br>(2 pages). |



AFFIDAVIT OF ROBERT J. KADEL WITH ANNEXED EXHIBITS 1-17  
IN SUPPORT OF SHATTUCK ET AL.'S MOTION TO COMPEL  
RULE 37 F.R.CIV.P.

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF NEW YORK

-----x	)	
SHATTUCK ET AL.,	)	
	)	
Movants,	)	
	)	
v.	)	Re: Patent Interference
	)	No. 98,047
HOEGL ET AL.,	)	
	)	
Respondents.	)	

AFFIDAVIT OF ROBERT J. KADEL

STATE OF NEW YORK )  
: ss.:  
COUNTY OF NEW YORK )

ROBERT J. KADEL, being duly sworn, deposes and  
says:

1. I am a member of the Bar of the State of New York,  
the Court of Appeals for the Second Circuit and of the firm  
of Pennie & Edmonds, 330 Madison Avenue, New York, New York  
10017, counsel for movants, Meredith D. Shattuck and Ulo  
Vahtra ("Shattuck, et al."), in the above-captioned action.

2. On information and belief, the following docu-  
ments, annexed as exhibits to this affidavit, are true and  
correct copies of the originals thereof:

Exhibit 1: Subpoena Duces Tecum dated February 15,  
1974, served on Anthony W. Karambelas.

Exhibit 2: Subpoena Duces Tecum dated February 15,  
1974, served on Peter H. Kondo.

*Affidavit of Robert J. Kadel*

- Exhibit 3: Subpoena Duces Tecum dated February 11, 1974, served on John W. Weigl.
- Exhibit 4: Decision by the Honorable Harold P. Burke dated March 26, 1974.
- Exhibit 5: Shattuck et al. Deposition Exhibit 26.
- Exhibit 6: "ORDER TO SHOW CAUSE WHY THE WITNESS WEIGL SHOULD NOT BE COMPELLED TO PRODUCE ALLEGEDLY PRIVILEGED DOCUMENTS" with accompanying memorandum.
- Exhibit 7: "SUPPLEMENTAL MEMORANDUM IN SUPPORT OF MOVANTS' REQUEST FOR AN ORDER TO SHOW CAUSE WHY THE WITNESS WEIGL SHOULD NOT BE COMPELLED TO PRODUCE ALLEGEDLY PRIVILEGED DOCUMENTS"
- Exhibit 8: First page of a Memorandum of Hoegl Et Al. in Opposition to the Shattuck Et Al. Request for a Show Cause Order.
- Exhibit 9: Decision by the Honorable Harold P. Burke dated May 7, 1974.
- Exhibit 10: Decision by United States Court of Appeals for the Second Circuit dated July 16, 1975, Docket No. 74-1767.
- Exhibit 11: Letter from Mr. Kadel to Mr. Hone dated November 6, 1975.
- Exhibit 12: Letter from Mr. Hone to Mr. Kadel dated November 14, 1975.
- Exhibit 13: Transcript of Deposition testimony of Anthony W. Karambelas taken April 24, 1974, pages 109 and 110.
- Exhibit 14: Transcript of Deposition testimony of Peter Kondo taken February 21, 1974, pages 62 and 63.
- Exhibit 15: Copy of memorandum from Mr. Weigl to Mr. Mahassel dated April 2, 1970, entitled "Invention Record: High Speed Organic Photoconductor Coatings (J. Mammino)."
- Exhibit 16: Copy of memorandum from Mr. Weigl to Mr. Mahassel dated April 2, 1970, entitled "Battelle Work on Heavily Doped PVK."



*Affidavit of Robert J. Kadel*

Exhibit 17: Transcript of Deposition testimony of John W. Weigl taken April 5, 1975, pages 32-34.

3. On April 23, 1974, when Shattuck et al. were applying in this Court for an ORDER TO SHOW CAUSE WHY THE WITNESS WEIGL SHOULD NOT BE COMPELLED TO PRODUCE ALLEGEDLY PRIVILEGED DOCUMENTS, Mr. Anthony W. Karambalas agreed, in a telephone conversation on that date with Mr. Clyde C. Metzger and Robert J. Kadel, attorneys for Shattuck et al., that any Court ruling as to the withheld Weigl documents of Shattuck et al. Deposition Exhibit 26 would be applicable to his withheld documents of Shattuck et al. Deposition Exhibit 27. It was the desire of Mr. Karambalas, Mr. Metzger and Mr. Kadel to avoid unnecessarily burdening this Court with additional motions since the same legal and factual issues were involved with respect to the allegedly privileged documents withheld by Weigl and the allegedly privileged documents withheld by Karambalas.

Robert J. Kadel  
Robert J. Kadel

Subscribed to and sworn  
before me this 26th day  
of November, 1975.

Notary Public

Notary Public for the State of New York  
Qualified in New York County  
My Comm. Expires March 30, 1977

EXHIBIT 1--SUBPOENA DUCES TECUM DATED FEBRUARY 15,  
1974, SERVED ON ANTHONY W. KARAMBELAS  
ANNEXED TO AFFIDAVIT OF ROBERT J. KADEL

DISPOSITION SUBPOENA TO TESTIFY

PRODUCE DOCUMENTS OR THINGS

Revised (Oct. 1963) D. C. Form No. 9

# United States District Court

FOR THE

Western District of New York

CIVIL ACTION FILE NO.

Shattuck et al

vs.

Interference 98,047

Hoegl et al

TO Anthony W. Karambelas  
Xerox Corporation  
Xerox Square  
Rochester, New York  
YOU ARE COMMANDED to appear at  
700 Midtown Tower  
on the 21st day February, 1974, at 10:00  
on behalf of party Shattuck et al

In the city of Rochester, N.Y.  
o'clock A. M. to testify

Patent Office

at the taking of a deposition in the above entitled action pending in the United States ~~Patent Office~~  
~~XXXXXX~~ and bring with you all documents  
~~XXXXXX~~ described in Schedule A attached hereto.

Dated February 15, 1974.

JOSEPH G. WALSH, ESQ.

JOHN K. ADAMS

the party Shattuck et al  
Monterey and Cottle Roads  
San Jose, Calif. 95114  
Address Tele: 408-227-7100

Clerk.

By

Deputy Clerk.

1. Strike the words "and bring with you" unless the subpoena is to require the production of documents or tangible things, in which case the documents and things should be designated in the blank space provided for that purpose.

## RETURN ON SERVICE

Received this subpoena at \_\_\_\_\_ on \_\_\_\_\_  
and on \_\_\_\_\_ at \_\_\_\_\_  
served it on the within named \_\_\_\_\_  
by delivering a copy to him and tendering to him the fee for one day's attendance and the mileage  
allowed by law.<sup>\*</sup>

Dated: \_\_\_\_\_

Service Fees

Travel \$ \_\_\_\_\_  
Services \$ \_\_\_\_\_

By \_\_\_\_\_

Total \$ \_\_\_\_\_

Subscribed and sworn to before me, a  
day of \_\_\_\_\_ 19 \_\_\_\_\_

this

<sup>\*</sup> Fees and mileage need not be tendered to the witness upon service of a subpoena issued in behalf of the United States or an officer or agency thereof. 28 USC 1826.

Note.—Affidavit required only if service is made by a person other than a United States Marshal or his deputy.



**Schedule of Documents for Subpoena Duces Tecum  
To Be Served on Witnesses Identified in the  
Accompanying Notice**

All documents referring to work done before August 1, 1964, that comes within the terms of the Count (i.e., claim 1 of Shattuck et al. United States Patent No. 3,484,237) of Interference No. 98,047 between the parties Hoegl et al and Shattuck et al now pending before the Board of Patent Interferences in the United States Patent Office.

Schedule A

EXHIBIT 2--SUBPOENA DUCES TECUM DATED FEBRUARY 15,  
1974, SERVED ON PETER H. KONDO ANNEXED  
TO AFFIDAVIT OF ROBERT J. KADEL

DEPOSITION SUBPOENA TO TESTIFY

PRODUCE DOCUMENTS OR THINGS

Revised (Oct. 1953) D. C. Form No. 9

## United States District Court

FOR THE

Western District of New York

CIVIL ACTION FILE NO.

Shattuck et al

vs.

Hoegl et al

Interference No. 98,041

TO Peter H. Kondo  
Xerox Corporation  
Xerox Square  
Rochester, New York  
YOU ARE COMMANDED to appear at

700 Midtown Tower  
on the 21st day February, 1974, at 10:00  
on behalf of the party Shattuck et al

in the city of Rochester, N.Y.  
o'clock A.M. to testify

at the taking of a deposition in the above entitled action pending in the United States Patent Office  
~~XXXXXX~~  
and bring with you all documents  
~~XXXXXX~~

described in Schedule A attached hereto.

Dated February 15, 1974  
February 15, 1974

JOSEPH G. WALSH, ESQ.

Attorney for the party Shattuck et al  
Monterey and Cottle Roads

Address San Jose, Calif 95114  
Telephone: 408-227-7100

JOHN K. ADAMS

Clerk.

By

Deputy Clerk.

1. Strike the words "and bring with you" unless the subpoena is to require the production of documents or tangible things, in which case the documents and things should be designated in the blank space provided for that purpose.

## RETURN ON SERVICE

Received this subpoena at  
and on

at

on

served it on the within named

by delivering a copy to h and tendering to h  
allowed by law.

the fee for one day's attendance and the mileage

Dated:

, 19

Service Fees

Travel

Services

Total

\$

By

Subscribed and sworn to before me, a  
day of 19

this

\* Fees and mileage need not be tendered to the witness upon service of a subpoena issued in behalf of the United States or an officer or agency thereof. 28 USC 1825.

Note.—Affidavit required only if service is made by a person other than a United States Marshal or his deputy.



**Schedule of Documents for Subpoena Duces Tecum  
To Be Served on Witnesses Identified in the  
Accompanying Notice**

All documents referring to work done before August 1, 1964, that comes within the terms of the Count (i.e., claim 1 of Shattuck et al. United States Patent No. 3,484,237) of Interference No. 98,047 between the parties Hoegl et al and Shattuck et al now pending before the Board of Patent Interferences in the United States Patent Office.

Schedule A

EXHIBIT 3--SUBPOENA DUCES TECUM DATED FEBRUARY 11,  
1974, SERVED ON JOHN W. WEIGL ANNEXED  
TO AFFIDAVIT OF ROBERT J. KADEL

DEPOSITION: SUBPOENA TO TESTIFY OR PRODUCE DOCUMENTS OR THINGS (Revised April, 1971) DC Form No. 9

United States District Court

FOR THE

Western District of New York

CIVIL ACTION FILE NO.

Shattuck et al

vs.

Interference No. 93,C47

Hoegl et al

TO: JOHN W. WEIGL  
534 Wahlmont Drive  
West Webster, New York 14580

YOU ARE COMMANDED to appear at  
700 Midtown Tower  
on the 20th day February, 1974, at 10:00 o'clock in the city of Rochester, N.Y.  
on behalf of the party Shattuck et al A-M. to testify

at the taking of a deposition in the above entitled action pending in the United States Patent Office  
and bring with you all documents  
described in Schedule A attached hereto.

Dated February 11, 1974

JOSEPH G. WALSH, ESQ.

JOHN K. ADAMS

Attorney for the party Shattuck et al  
Monterey and Cottle Roads  
San Jose, Calif. 95114  
Address Tel: 408-227-7100

Clerk.  
By Deputy Clerk.

Any subpoenaed organization not a party to this suit is hereby admonished pursuant to Rule 30 (b) (6), Federal Rules of Civil Procedure, to file a designation with the court specifying one or more officers, directors, or managing agents, or other persons who consent to testify on its behalf, and shall set forth, for each person designated, the matters on which he will testify or produce documents or things. The persons so designated shall testify as to matters known or reasonably available to the organization.

1. Strike the words "and bring with you" unless the subpoena is to require the production of documents or tangible things, in which case the documents and things should be designated in the blank space provided for that purpose. If testimony by an organization representative or designee is requested, describe with reasonable particularity the matters on which examination is requested.

RETURN ON SERVICE

Received this subpoena at \_\_\_\_\_ on \_\_\_\_\_  
and on \_\_\_\_\_ at \_\_\_\_\_  
served it on the within named \_\_\_\_\_  
by delivering a copy to him and tendering to him the fee for one day's attendance and the mileage  
allowed by law.  
Dated: \_\_\_\_\_

Service Fees \_\_\_\_\_, 19\_\_\_\_  
By \_\_\_\_\_  
Travel \$ \_\_\_\_\_  
Services \_\_\_\_\_  
Total \$ \_\_\_\_\_

Subscribed and sworn to before me, a \_\_\_\_\_ this \_\_\_\_\_  
day of \_\_\_\_\_ 19\_\_\_\_

This subpoena must not be returned to the witness upon issuance of a subpoena issued in behalf of the United States or an officer or agency thereof, 28 U.S.C. 1722.

Interim Affidavit required only if service is made by a person other than a United States Marshal or his deputy.



**Schedule of Documents for Subpoena Duces Tecum.  
To Be Served on Witnesses Identified in the  
Accompanying Notice**

All documents referring to work done before August 1, 1964, that comes within the terms of the Count (i.e., claim 1 of Shattuck et al. United States Patent No. 3,484,237) of Interference No. 98,047 between the parties Hoegl et al and Shattuck et al now pending before the Board of Patent Interferences in the United States Patent Office.

Schedule A

EXHIBIT 4--DECISION BY THE HONORABLE HAROLD F. BURKE  
DATED MARCH 26, 1974 ANNEXED TO AFFIDAVIT  
OF ROBERT J. KADEL

UNITED STATES DISTRICT COURT  
WESTERN DISTRICT OF NEW YORK

---

SHATTUCK, ET AL.,

Movants

- vs -

Patent Interference  
No. 98,047

HOEGL, ET AL.,

Respondents

---

Wiser, Shaw, Freeman, VanGraafeiland,  
Harter & Secrest  
700 Midtown Tower  
Rochester, N.Y. 14604  
Attorneys for movants

Pennie & Edmonds  
330 Madison Avenue  
New York, N.Y. 10017  
and  
Joseph G. Walsh  
% International Business Machine Corp. ✓  
San Jose, Calif. 95114  
(of counsel)

Brunbaugh, Graves, Donohue & Raymond  
30 Rockefeller Plaza  
New York, N.Y. 10020  
by Francis J. Hone

Paris, Haskell & Levine  
Washington, D.C.  
and  
Anthony W. Karambelas  
Xerox Corporation  
Xerox Square  
Rochester, N.Y. 14644  
Attorneys for respondents

Harris, Beach & Wilcox  
2 State Street  
Rochester, N.Y. 14614  
by Elliott Horton  
(of counsel)



- 2 -

The movants on March 6, 1974 filed a motion with five separately numbered paragraphs under Rule 37, Federal Rules of Civil Procedure, for an order compelling the production of documents and answers to questions propounded under Rule 30, Federal Rules of Civil Procedure.

The motion was argued orally on March 19, 1974 and was submitted on written memoranda.

This court has jurisdiction to determine the motion under Title 35 U.S.C. Section 24.

The documents and the testimony which the movants attempted to get through the deposition of Weigl have a direct bearing on the movants allegations of fraudulent misconduct on the part of Hoegl, et al in filing their Preliminary Statement. The alleged fraud is ancillary to priority of invention. If fraud should be established it could be the basis for striking the Preliminary Statement. In that sense any testimony of Weigl relating to the subject of Shattuck, et al.'s, claim of fraud is relevant to the interference proceeding.

The movants have a statutory right to the desired discovery through this court. This court has ancillary jurisdiction over discovery in the interference proceeding. This court should exercise that jurisdiction

- 3 -

to complement patent office jurisdiction in search for the truth. Patent Office rules of admissibility of evidence do not govern discovery under the Federal Rules of Civil Procedure in an interference proceeding.

There is no ground for objection that the documents or evidence sought in the discovery will be inadmissible at the trial, so long as the documents and testimony sought to be elicited appear to be reasonably calculated to lead to the discovery of evidence that would be admissible. The movants are entitled to unrestricted access to sources of information bearing on the question of fraud. Weigl is not a party to the interference proceeding. He has no standing to refuse to answer questions asked at the deposition on the ground that they are irrelevant to the interference proceeding.

Weigl is directed to answer the questions which he refused to answer on the advice of counsel at the deposition on February 20, 1974, and which appear in the copy of the transcript submitted as Exhibit 3 annexed to the affidavit of Clyde T. Metzger.



- 4 -

Weigl is directed to appear at the Office of Wiser, Shaw, Freeman, VanGraafeiland, Harter & Secrest, 700 Midtown Tower, Rochester, New York 14604, on April 5, 1974 at 10:00 A.M. to answer the questions previously asked him and to answer any further questions he may be asked with respect to his work for Xerox Corporation in the field of photoconductive compositions relating to possible fraud in connection with the filing of the Preliminary Statement in Interference No. 98,047 and as they relate to any further issues relevant to said interference.

Weigl is directed to produce at said time and place any documents in his possession, custody or control, within the scope of Schedule A annexed to the subpoena duces tecum served on him on or about February 11, 1974, and particularly such documents as laboratory reports, memoranda, correspondence, or notes relating to work done prior to August 1, 1964, either by Weigl or by Dr. E. Lell, with whom Weigl worked at Xerox Corporation in Rochester, New York, or by others under his direction or control, which relate to photoconductive compositions comprising from about 0.49

- 5 -

to about 1.23 moles of 2, 4, 7-trinitro-9 flourenone ("TNF") per monomeric unit of a polymerized vinyl-carbazole ("PVK") compound.

Weigl is directed to testify with respect to any documents produced in accordance with the schedule of the subpoena duces tecum.

Weigl is directed, if asked by the attorneys representing the movants, to state the names of co-workers in the laboratory with him, and their addresses, if known to him, in relation to the work done prior to August 1, 1964.

The application of the movants for expenses incurred in connection with this motion, including attorneys' fees, is denied.

ALL OF THE ABOVE IS SO ORDERED.

*Harold P. Burke*  
HAROLD P. BURKE  
United States District Judge

March 26, 1974.



EXHIBIT 5--SHATTUCK ET AL. DEPOSITION EXHIBIT 26  
ANNEXED TO AFFIDAVIT OF ROBERT J. KADEL

IDENTIFICATION OF PRIVILEGED DOCUMENTS IN  
THE FILES OF DR. WEIGL RELATING TO THE  
COUNT OF INTERFERENCE NO. ~~94,067~~  
98,047

<u>ORIGINATOR</u>	<u>RECIPIENT/DISTRIBUTEES</u>	<u>DATE</u>	<u>SUBJECT</u>
J. Weigl	A. Mahassel/ J. Mammino A. G. Tweet W. W. Tyler D. L. Stockman J. J. Ralabate	4/2/70	Invention Record: High Speed Organic Photo- conductor Coatings (J. Mammino)
Attachments to Document 1			
a. J. Mammino	J. Weigl	3/26/70	"
b. J. Mammino G. Jvirblis		8/15/64	RL64- <del>25</del>
c. J. Weigl	A. Mahassel/ J. Mammino J. Urbach	4/2/70	Battelle Work on Heavily Doped PVK

Shattuck Exh #26  
22.

RmF

4-5-74

EXHIBIT 6--"ORDER TO SHOW CAUSE WHY THE WITNESS  
WEIGL SHOULD NOT BE COMPELLED TO PRO-  
DUCE ALLEGEDLY PRIVILEGED DOCUMENTS"  
WITH ACCOMPANYING MEMORANDUM ANNEXED  
TO AFFIDAVIT OF ROBERT J. KADEL

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF NEW YORK

-----x  
SHATTUCK ET AL., :  
 :  
 : Movants, :  
 :  
 : v. : Patent Interference 93,047  
 :  
HOEGL ET AL., :  
 :  
 : Respondents. :  
-----x

ORDER TO SHOW CAUSE WHY THE WITNESS WEIGL SHOULD NOT BE  
COMPELLED TO PRODUCE ALLEGEDLY PRIVILEGED DOCUMENTS

On the file of the above-captioned case and the affi-  
davit of Clyde C. Metzger and Movants' Memorandum in Support of  
Request for Court Order attached hereto

IT IS HEREBY ORDERED that Respondents show cause at a  
<sup>at the United States Court House, Rochester, N.Y.</sup>  
hearing before this Court, to be held on the 24<sup>th</sup> day of April  
1974, at 10:00 o'clock A.M. why an Order should not be issued  
compelling the witness Weigl, or the real party in interest, Xerox  
Corporation, to produce to Movants the documents identified in  
Shattuck et al. Exhibit 26 annexed hereto, and compelling the  
witness Weigl to answer all questions relating to such documents.

IT IS FURTHER ORDERED that sufficient cause for waiving  
ordinary notice requirements having been shown, Movants, by their  
attorneys, are directed to serve a copy of this Order on Anthony  
W. Karambelas, Esq., Xerox Corporation, Xerox Square, Rochester,  
New York 14644, and Francis J. Hone, Esq., Brumbaugh, Graves,  
Donohue & Raymond, 30 Rockefeller Plaza, New York, New York 10020  
attorneys for Respondents on or before the 24<sup>th</sup> day of April  
1974.

By: Harold P. Burke  
United States District Judge

Dated: Rochester, New York  
April 23, 1974



Exhibit 6 Annexed to Affidavit of Robert J. Kadel

IDENTIFICATION OF PRIVILEGED DOCUMENTS IN  
THE FILES OF DR. WEIGL RELATING TO THE  
COURT OF INTERFERENCE NO. ~~24-087~~

98,047

<u>ORIGINATOR</u>	<u>RECIPIENT/DISTRIBUTEES</u>	<u>DATE</u>	<u>SUBJECT</u>
J. Weigl.	A. Mahassel/ J. Mammino A. G. Tweet W. W. Tyler D. L. Stockman J. J. Ralabate	4/2/70	Invention Record: High Speed Organic Photo- conductor Coatings (J. Mammino
Attachments to Document 1			
J. Mammino	J. Weigl	3/26/70	"
J. Mammino G. Jvirblis		8/15/64	RL64-25
J. Weigl	A. Mahassel/ J. Mammino J. Urbach	4/2/70	Battelle Work on Heavily Doped PVK

Shattuck Exh #26  
22.

Rm F

4-5-74

*Exhibit 6 Annexed to Affidavit of Robert J. Kadel*

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF NEW YORK

-----x  
SHATTUCK ET AL., :  
Movants, :  
v. : Patent Interference 98,047  
HOEGL ET AL., :  
Respondents :  
-----x

MEMORANDUM IN SUPPORT OF MOVANTS' REQUEST FOR AN  
ORDER TO SHOW CAUSE WHY THE WITNESS WEIGL SHOULD  
NOT BE COMPELLED TO PRODUCE ALLEGEDLY PRIVILEGED DOCUMENTS

Introduction

This request for an Order directing the witness Weigl to produce allegedly privileged documents relates to the above-entitled ancillary proceeding which was initiated on March 4, 1974 by the filing with this Court of the Shattuck et al. "Motion Under Rule 37 F.R.C.P. For Order Compelling The Production Of Documents And Answers To Questions Propounded Under Rule 30, F.R.C.P." (hereinafter "Motion Under Rule 37").

The ancillary proceeding is based on Patent Office Interference No. 98,047 between the interference parties Meredith D. Shattuck and Ulo Vahtra ("Shattuck et al.") and Helmut Hoegl and Giacomo Barchietto ("Hoegl et al.").

The real parties in interest are International Business Machines Corporation ("IBM"), assignees of Shattuck et al., and Xerox Corporation ("Xerox"), assignees of Hoegl et al.

The original Motion Under Rule 37 had been brought because, in attempting to take the deposition of a witness, John W. Weigl, an employee of Xerox, the witness refused to answer all substantive questions or produce any documents specified in a subpoena duces tecum which had been served upon him.



*Exhibit 6 Annexed to Affidavit of Robert J. Kadel*The Court Order Of March 26, 1974

In an opinion dated March 26, 1974 (annexed hereto as Exhibit A) this Court held, inter alia,

- (i) that Shattuck et al. are "entitled to unrestricted access to sources of information bearing on the question of fraud,"

and

- (ii) that "Weigl is directed to produce at said time [April 5, 1974] and place any documents in his possession, custody or control, within the scope of Schedule A annexed to the subpoena duces tecum served on him on or about February 11, 1974, and particularly such documents as laboratory reports, memoranda, correspondence, or notes relating to work done prior to August 1, 1964, either by Weigl or by Dr. E. Lell, with whom Weigl worked at Xerox Corporation in Rochester, New York, or by others under his direction or control, which relate to photoconductive compositions comprising from about 0.49 to about 1.23 moles of 2, 4, 7-trinitro-9 fluorenone ("TNF") per monomeric unit of a polymerized vinyl carbazole ("PVK") compound.

"Weigl is directed to testify with respect to any documents produced in accordance with the schedule of the subpoena duces tecum."

The Testimony Of Weigl And Its Significance

At the deposition on April 5, 1974, pursuant to the Court's Order requiring the witness Weigl to answer questions which he had previously refused to answer, Weigl admitted, as alleged by Shattuck et al., that he had in fact carried out work in 1963 coming within the subject matter of the interference count! (Transcript of Weigl testimony of April 5, 1974, pp.14-15, annexed hereto as Exhibit B.)

The significance of this admission lies in the fact that Hoegl et al. (or their attorneys), although they knew of this earlier work by Weigl, nevertheless, stated under oath in their Preliminary Statement in this interference that they, Hoegl et al., were the true inventors of the invention covered by the interference count and that they made that invention in 1964. Moreover,

*Exhibit 6 Annexed to Affidavit of Robert J. Kadel*

this early work of Weigl, constituting highly relevant prior art uniquely within the knowledge of Xerox, was not brought to the attention of the Patent Office as clearly required by the law.

The significance of Xerox holding Hoegl et al. out as the inventors of the subject matter of the interference count is of critical importance, as noted below, because it enabled Xerox to institute this interference which they could not otherwise have done.

It is submitted that Shattuck et al., as pointed out below in more detail, have established a prima facie showing that fraud has been perpetrated in connection with (i) the filing of the Hoegl et al. Preliminary Statement, (ii) the filing of the Hoegl et al. patent application involved herein, and (iii) the withholding of material facts from the Patent Office so as to justify this Court in issuing the requested ORDER TO SHOW CAUSE WHY THE WITNESS WEIGL SHOULD NOT BE COMPELLED TO PRODUCE ALLEGEDLY PRIVILEGED DOCUMENTS. Such allegedly privileged documents were withheld at the April 5, 1974 deposition of Weigl and are identified in Shattuck et al.'s Deposition Exhibit 26 annexed to said Order.

The Relevant Sequence Of Events

Summarizing the relevant facts, some of which have already been set forth in the Shattuck et al. Motion Under Rule 37 filed with this Court on or about March 4, 1974, the following sequence of events are particularly pertinent to the present motion:

1. On January 6, 1966 Hoegl et al. filed a parent patent application relating to an electrophotographic plate and process. The invention described and claimed therein was directed to a special type of "overcoat layer" which could be used with various assertedly old, prior art photoconductive compositions.



*Exhibit 6 Annexed to Affidavit of Robert J. Kadel*

One of the many assertedly old and "unuseable" (according to Hoegl et al.) photoconductive compositions referred to by Hoegl et al. was a PVK-TNF composition (ratio 1:1) which comes within the scope of this interference count.

2. On December 16, 1969 the Shattuck et al. United States patent 3,484,237, which is involved in this interference, issued to IBM. This patent described and claimed a photoconductive composition which is now the subject matter of this interference, namely,

"An organic photoconductive composition comprising from about 0.49 to about 1.23 mols of 2,4,7-trinitro-9-fluorenone per monomeric unit of a polymerized vinyl-carbazole compound."

3. In April 1970 IBM commenced commercial production of IBM copier machines employing a specific photoconductive composition coming within the terms of claim 1 in the Shattuck et al. patent.

4. On January 21, 1971, after learning of the issuance of the Shattuck et al. patent (Weigl deposition p. 22, annexed hereto as Exhibit B), and while the Hoegl et al. parent patent application was still pending in the Patent Office, Hoegl et al. filed a "continuation-in-part" application (hereinafter "CIP application") wherein their original parent application was radically altered so that instead of being directed to the special "overcoat layer," the CIP application was now directed to, and even claimed, the very same PVK-TNF composition (ratio 1:1) which Hoegl et al. had previously thought to be "unuseable in conventional imaging systems" and "undesirable" in regard to certain important properties. Thus, of all the innumerable photoconductive compositions which Hoegl et al. had originally disclosed in their parent application as being old and "unuseable," the CIP application was now entirely directed to just one photoconductive composition, namely, a PVK-TNF composition (ratio 1:1) which was now described as "new" and "acceptable." This composition, of

*Exhibit 6 Annexed to Affidavit of Robert J. Kadel*

course, came within the scope of the claims of the Shattuck et al. patent. The CIP application was accompanied by a declaration of inventorship (equivalent to an oath) wherein Hoegl et al. declared that they believed themselves to be (i) the "original" and (ii) the "first" inventors of a PVK-TNF composition (ratio 1:1) as the law required them to do! The purpose of the filing of the CIP application was, of course, to provoke an interference with the Shattuck et al. patent on the grounds that the invention claimed therein was supposedly first made by Hoegl et al.

5. On November 7, 1972, after the declaration of the present interference between the Shattuck et al. patent and the Hoegl et al. CIP application, Hoegl et al. swore that they made the invention set forth in the present interference count, that is, the invention defined by claim 1 of the Shattuck et al. patent.

The Hoegl Et Al. Preliminary Statement  
And CIP Application Are Tainted With Fraud

We submit that a prima facie showing has been made that fraud has been perpetrated in connection with the filing of the Preliminary Statement, as well as the filing of the Hoegl et al. CIP application. Specifically:

It has now been established that Hoegl et al. (or their attorneys as noted below) knew of Weigl's early work with TNF and PVK before the filing of the Hoegl et al. CIP application on January 21, 1971, and before the filing of the Hoegl et al. Preliminary Statement on or about November 7, 1972. A document attached to the Hoegl et al. Preliminary Statement, written by, inter alia, Hoegl et al. on November 25, 1964 states that the work which Hoegl et al. carried out in 1964 "show again what E. Lell and J. Weigl already have pointed out; namely, that TNF is the best CT sensitizer found so far for PVK" (Exhibit C annexed hereto comprises the relevant portion of the Hoegl et al. Preliminary Statement and attachment, specifically page 3 of such attachment).



*Exhibit 6 Annexed to Affidavit of Robert J. Kadel*

It has further been established that this work of Lell and Weigl involved PVK and TNF coming within the scope of the interference count (Weigl deposition, pp. 15-16, annexed hereto as Exhibit B).

It has further been established that the Xerox patent attorneys were also aware of the earlier work of Lell and Weigl and that such attorneys must therefore have improperly caused the filing of the CIP application and the Preliminary Statement in the name of Hoegl et al. (Shattuck et al. Exhibit 26, annexed to the Order requested herein, was produced by Xerox during the Weigl deposition. This Exhibit 26 describes documents relating to the early work of Weigl which comes within the scope of the Weigl subpoena [and thus the interference count] and were sent to Mr. A. Mahassel, the Xerox Patent Manager, and Mr. J. J. Ralabate, a Xerox patent attorney. See pp. 45-46 of Weigl deposition annexed hereto as Exhibit B.)

The Significance Of A False Assertion Of Inventorship  
In A CIP Application And A Preliminary Statement

Without extensive discussion of the purposes of the Patent Laws and Patent Office Rules requiring sworn statements (or declarations) as to the proper inventorship on a CIP application (35 U.S.C. § 115)\* and in a Preliminary Statement (Patent Office Rule 216),\*\* suffice it to say that the requirement for such oaths is to prevent an attempt by a party, after seeing an invention patented (and even commercially used) by another, to improperly usurp that invention as its own. When Xerox filed the Hoegl et al. CIP

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\* 35 U.S.C. § 115 provides that, "The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent ..."

\*\* Patent Office Rule 216 provides that, "The preliminary statement must state that the party made the invention set forth by each count of the interference ..."

*Exhibit 6 Annexed to Affidavit of Robert J. Kadel*

Application there was no way under the Patent Laws in which Xerox could have even instituted this interference except by improperly holding out Hoegl et al. as the inventors of this subject matter. It was statutorily impermissible at that time to file a new application in the name of Weigl or anyone else.\*

The Allegedly Privileged Documents

The documents which Weigl refused to produce on the ground of attorney-client privilege are described in Shattuck et al. Deposition Exhibit 26 which was produced by Xerox and is annexed to the Order requested herein. Regarding Document 1 referred to therein:

J. Weigl, a non-lawyer, was Manager of Imaging Materials Department of the Applied Research Laboratory (Exhibit B, p. 7).

A. Mahassel was Xerox Patent Manager in Rochester, an attorney but not a member of the New York Bar (Exhibit B, p. 46).

A. G. Tweet, a non-lawyer, was Weigl's supervisor (Exhibit B, p. 46).

W. W. Tyler, a non-lawyer, was Manager of the Xerox Research Laboratories (Exhibit B, p. 46).

D. L. Stockman, a non-lawyer, was a Research Manager concerned with photoconductors, generally (Exhibit B, p. 46).

J. J. Ralabate was a Xerox patent attorney (Exhibit B, p. 46).

Regarding Document 1(a):

J. J. Mammino and J. Weigl referred to above were non-lawyers.

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\* 35 U.S.C. § 102(b) provides that a person shall not be entitled to a patent if "the invention was patented ... in this or a foreign country ... more than one year prior to the date of application for patent in the United States ..." By the time the Hoegl et al. CIP application was filed on January 21, 1971, the Shattuck et al. U. S. patent had long since issued (December 16, 1969) and the corresponding Shattuck et al. British and New Zealand patents had already been published and issued on August 7, 1968, and June 15, 1967, respectively.



*Exhibit 6 Annexed to Affidavit of Robert J. Kadel*

Regarding Document 1(b):

Attorney-client privilege is not being asserted as to this document and it has been produced except for portions alleged by Hoegl et al. to be irrelevant.

Regarding Document 1(c):

J. Weigl, A. Mahassel, J. Mammino, have been identified above.

J. Urbach, a non-lawyer, was a Research Manager, Xerox, Palo Alto Research Center (Exhibit B, p. 47).

The Need For Discovery Of The  
Alleged Privileged Documents

It should be noted that the privileged documents withheld by Weigl are dated in March and April 1970, just about the time IBM commenced commercial production of its IBM copier machines employing a specific PVK-TNF composition coming within the scope of the Shattuck et al. patent.

Since these documents admittedly relate to the early work of Weigl coming within the scope of the interference count and since such work was admittedly done prior to the alleged invention date of Hoegl et al., it is considered extremely relevant to the issue of fraud to learn, for example, what possible basis the Xerox patent attorneys had for causing Hoegl et al. to declare that they, Hoegl et al., believed themselves to be the original and first inventors of PVK-TNF compositions (ratio 1:1) when any such alleged invention was apparently derived from the earlier work of Weigl.

Did Xerox initially consider filing an application in Weigl's name at that time? Did Xerox attempt to attribute Weigl's work to Hoegl et al. and then, failing to do so, improperly cause the filing of the Hoegl et al. CIP application and the Preliminary Statement in the name of Hoegl et al? Why did Xerox not advise the Patent Office of Weigl's early work, as they should have done, and thus permit the Patent Office to make its determination of whether Weigl's work would be a statutory bar to the Hoegl et al.

*Exhibit 6 Annexed to Affidavit of Robert J. Kadel*

CIP application?\*" All these questions are relevant to Xerox's intent, which is an important aspect regarding the issue of fraud

The only way such very critical answers can properly be determined and the only way that all the facts regarding the intent of Xerox can be brought to the attention of the Patent Office is by the production of the documents herein requested.

The Special Facts In This Case Justify The  
Production Of The Documents Requested Herein

In connection with this interference, it is particularly significant that the alleged inventors, Hoegl and Barchietto, are not residents of the United States. They reside in Europe and are not subject to subpoena. IBM requested Xerox to produce these witnesses and offered to pay the expenses which they would incur in a trip to the United States. IBM also requested Xerox to enter into a stipulation under Patent Office Rule 284 (e) which would permit the taking of the testimony of Hoegl and Barchietto in Europe. Xerox refused both requests (Exhibit D).

Moreover, the Patent Office has already held, as previously pointed out in the Shattuck et al. Motion Under Rule 37, that it "has no authority to order or force a person to testify in an interference proceeding," but that "Shattuck et al. can, however, call the persons involved as their own witnesses which apparently is what they intend to do." This is what Shattuck et al. are now doing and this is why Shattuck et al. require the assistance of this Court in obtaining the documents requested herein. The Patent Office, in their December 20, 1970 decision, also indicated that any evidence regarding fraud in connection with ex parte prosecution of the Hoegl et al. CIP patent application should be brought to the attention of the Commissioner of

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\* 35 U.S.C. § 102(g) provides that, "A person shall be entitled to a patent unless ... (f) he did not himself invent the subject matter sought to be patented, or (g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it ..."



*Exhibit 6 Annexed to Affidavit of Robert J. Kadel*

Patents by way of a Petition to the Commissioner Under Patent Office Rule 56 (Motion Under Rule 37, Exhibit 6 annexed thereto).

Patent Office Rule 56 provides in part that:

"Any application ... fraudulently filed or in connection with which fraud is practiced or attempted on the Patent Office, may be stricken from the files." (emphasis added)

Accordingly, it is respectfully submitted that it is essential for Shattuck, et al. to have access to the documents requested herein and thus be able to present all the facts to the Patent Office regarding the issue of fraud.

It should be further noted that the documents requested herein are extremely narrowly defined, namely, documents relating to work which was (i) admittedly carried out by persons other than Hoegl et al. and coming within the scope of the interference count, (ii) admittedly carried out prior to the date of invention which was sworn to by Hoegl et al., and (iii) admittedly known to Hoegl et al. (or their attorneys) prior to the time Hoegl et al. filed their CIP application and their Preliminary Statement.

A further justification for ordering the production of the allegedly privileged documents requested herein is the fact that, as stated above, Hoegl et al. made such a radical change in their patent application after learning of the issuance of the Shattuck et al. patent and after IBM began commercial production of their copier machines employing PVK and TNF. The radical change appearing in the Hoegl et al. CIP application had obviously been prompted by the issuance of the Shattuck et al. patent and by IBM's commercial use of PVK-TNF compositions. It was clearly not the result of any recent work done by or invention made by Hoegl et al. since Hoegl et al. had completed all their work on PVK-TNF compositions back in 1966, nearly five years before Xerox filed the CIP application in their name (Exhibit B, pp.26-27).

*Exhibit 6 Annexed to Affidavit of Robert J. Kadel*

In summary, therefore, this is a case where Xerox, after being spurred into activity by the issuance of the IBM patent, permitted Hoegl et al. to swear in a CIP application that they were the inventors of a photoconductive composition covered by that IBM patent (i) in spite of the fact that Hoegl et al. had previously described that very same composition as old, "unsuitable," and "undesirable," and (ii) in spite of the fact that this very same composition was known by Xerox to have already been made by others prior to Hoegl et al., and (iii) in spite of the fact that Xerox failed to disclose to the Patent Office, as required by law, this highly significant prior art work of others.

Then, during this interference, Xerox refused to produce the alleged inventors, Hoegl et al., for testimony; then refused to even permit the taking of such testimony in Europe under Patent Office Rule 284(e); then instructed all its employees and former employees to not answer any questions whatsoever on the issue of fraud; and then, after being ordered by this Court to provide Shattuck et al. with "unrestricted access" to evidence regarding the issue of fraud, Xerox ordered the witnesses not to produce the most relevant documents on the ground of attorney-client privilege.

The Issue Of Fraud In Interference Proceedings Regarding  
The Hoegl Et Al. CIP Application And Preliminary Statement

As stated by this Court in its Order of March 26, 1974 compelling the witness Weigl to testify and to produce documents, "fraud is ancillary to priority." (Exhibit A, p. 2). It is also clear that in connection with an interference proceeding a fraudulent CIP oath or Preliminary Statement is a serious issue relevant to such proceeding. Langer v. Kaufman, 465 F.2d 915 (CCPA 1972).



*Exhibit 6 Annexed to Affidavit of Robert J. Kadel*

The Issue Of Fraud Regarding Hoegl Et Al's Failure To Advise The Patent Office Of Facts Regarding The Critical Prior Art Work Of Weigl

The extremely pertinent prior art work of Weigl, admittedly known to Xerox, and involving the very same PVK-TNF composition (ratio 1:1) which Hoegl et al. asserted to be their invention, was improperly withheld from the Patent Office.

In Langer v. Kaufman, 465 F.2d 915, 920-1 (CCPA 1972), the Court referred back to its earlier decision in Norton v. Curtiss, 453 F.2d 779 (CCPA 1970), stating:

"[W]e \*\*\* subscribe to the recognition of a relationship of trust between the Patent Office and those wishing to avail themselves of the governmental grants which that agency has been given authority to issue. \*\*\* [The Patent Office] must rely on applicants for many of the facts upon which its decisions are based. The highest standards of honesty and candor on the part of applicants in presenting such facts to the office are thus necessary elements in a working patent system. We would go so far as to say they are essential. (emphasis added.)

\* \* \* \*

"[W]e \*\*\* repeat the words of the Supreme Court:

"A patent by its very nature is affected with a public interest. \*\*\* The far reaching social and economic consequences of a patent, therefore, give the public a paramount interest in seeking that patent monopolies spring from backgrounds free from fraud or other inequitable conduct and that such monopolies are kept within their legitimate scope."

The importance of the principle that relevant facts known to an applicant should be submitted to the Patent Office for consideration rather than being dismissed as nonrelevant in the opinion of applicant or its advisors is emphasized in Beckman Instruments Inc. v. Chemtronics Inc., 428 F.2d 555 (5 Cir. 1970). In that case Beckman and the inventor, Clark, knew about, but failed to disclose to the Patent Office, a prior art device invented by Stow which the Court found to completely anticipate the Clark invention. The Court stated the rationale

*Exhibit 6 Annexed to Affidavit of Robert J. Kadel*

and measure of Beckman and Clark's duty to disclose facts to the Patent Office as follows:

"Appellants' conduct must be examined against the standard of conduct required of an applicant before the Patent Office. The Patent Office does not have full research facilities of its own, and it has never been intended by Congress that it should. In examining patents, the Office relies heavily upon the prior art references that are cited to it by applicants. It is therefore evident that our patent system could not function successfully if applicants were allowed to approach the Patent Office as an arm's length adversary." (pp. 564-5) (emphasis added.)

\* \* \*

"Appellants' only reply to these facts is that they did not consider Stow's work to be relevant prior art. This assertion, however, is rendered utterly incredible both by Beckman's conduct and by the obvious similarity of the Stow and Clark devices. Furthermore, the determination that the prior art did not render the patent invalid should have been left to the Patent Office rather than being decided privately by Beckman and Clark. Consequently, we conclude that there was no excuse for appellants' failure to disclose Stow's work to the Patent Office, and this conclusion prevents us from considering Beckman's conduct as fulfilling an "uncompromising duty" of good faith disclosure. We are constrained to hold the patent invalid on this ground also." (p. 566) (emphasis added)

Prima Facie Evidence Of Fraud Vitiates  
The Asserted Attorney-Client Privilege

It has long been the rule, not only in cases involving fraudulent procurement of a patent, but in any case involving a crime or fraud, that a claim of attorney-client privilege respecting a communication, relating to the furtherance or commission of such crime or fraud, is vitated or destroyed. 8 Wigmore, Evidence, § 2298 (McNaughton Rev. 1961). In the case of Clark v. United States, 289 U.S. 1 (1933), Justice Cardozo summarized the rationale upon which the attorney-client privilege is pierced:



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" ... There is a privilege protecting communications between attorney and client. The privilege takes flight if the relation is abused. A client who consults an attorney for advice that will serve him in the commission of fraud will have no help from the law. He must let the truth be told ... To drive the privilege away, there must be 'something to give colour to the charge;' there must be 'prima facie evidence that it has some foundation in fact.' ... When that evidence is supplied, the seal of secrecy is broken.... Nor does the loss of the privilege depend upon the showing of a conspiracy, upon proof that client and attorney are involved in equal guilt. The attorney may be innocent, and still the guilty client must let the truth come out ... (p. 15)

Other cases which support this general proposition are: United States v. Bob, 106 F.2d 37, 40 (2 Cir. 1939); SEC v. Harrison, 80 F.Supp. 226, 230 (D.C. 1948); United States v. Weinberg, 226 F.2d 161, 172 (3 Cir. 1955), cert. den., 350 U.S. 933 (1955).

The foregoing proposition that the attorney-client privilege disappears in the face of prima facie evidence of fraud has been held to apply to patent interference proceedings. In Ziegler v. Natta, 157 U.S.P.Q. 400 (S.D.N.Y. 1968) the District Court held, at page 400, as follows:

"The documents, mostly lawyers' letters and opinions, are undoubtedly relevant to the issue of bona fides of the attribution of inventorship to Ziegler and Martin in plaintiff's application Serial No. 514,068 in 1955, thereafter amended in 1958 to Ziegler, Martin, Breil and Holzkamp. Although we have some doubt as to whether or not they are privileged communications, we are satisfied that the defendant has offered sufficient prima facie evidence seriously challenging the bona fides of the aforementioned amendment. We have been told that 'the far-reaching social and economic consequences of a patent, therefore, give the public a paramount interest in seeing that the patent monopolies spring from backgrounds free from fraud or other inequitable conduct. \* \* \* Precision Instrument Mfg. Co. v. Automotive Maintenance Mach. Co., 324 U.S. 806, 816, 65 USPQ 133, 138 (1945).

*Exhibit 6 Annexed to Affidavit of Robert J. Kadel*

"Accordingly, whether the documents are privileged as confidential communications or as work products, these privileges disappear when otherwise a fraud would be committed on the public ... The documents, therefore, must be made available.

The circumstances of this case clearly demonstrate that should the documents sought to be withheld by the witness Weigl fall within the purview of the attorney-client relationship, they are nonetheless subject to an order requiring their production to movants. Shattuck et al. have clearly demonstrated herein prima facie evidence of fraud in connection with (i) the Hoegl et al. CIP oath, (ii) the Hoegl et al. Preliminary Statement, and (iii) the failure of Xerox to advise the Patent Office of highly relevant prior art uniquely within the knowledge of Xerox. Thus, any allegedly attorney-client documents pertaining to the very specific issue of Xerox's knowledge of Weigl's early work and how Xerox handled such knowledge in connection with the Hoegl et al. CIP application and Preliminary Statement should be produced in order that the truth with respect to these matters be brought out and presented to the Patent Office.

CONCLUSION

For all of the reasons stated above, and particularly by reason of the fact that the public interest is directly affected by the grant of a patent, the Court should grant Movants', Shattuck et al.'s, request for an order directing the witness Weigl to produce the allegedly privileged documents identified in Shattuck et al.'s Exhibit 26 annexed to the Order to Show Cause, and to answer all questions relating to such documents.

Dated:

Respectfully submitted,

WISER, SHAW, FREEMAN, VAN GRAAFEILAND,  
HARTER & SECRETS

By

700 Midtown Tower  
Rochester, New York 14604  
(716) 232-6500

-15- Attorneys for Movants



*Exhibit 6 Annexed to Affidavit of Robert J. Kadel*

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*Exhibit 6 Annexed to Affidavit of Robert J. Kadel*

UNITED STATES DISTRICT COURT  
WESTERN DISTRICT OF NEW YORK

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SHATTUCK, ET AL.,

Movants

- vs -

Patent Interference  
No. 98,047

HOEGL, ET AL.,

Respondents

---

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The movants on March 6, 1974 filed a motion with five separately numbered paragraphs under Rule 37, Federal Rules of Civil Procedure, for an order compelling the production of documents and answers to questions propounded under Rule 30, Federal Rules of Civil Procedure.

The motion was argued orally on March 19, 1974 and was submitted on written memoranda.

This court has jurisdiction to determine the motion under Title 35 U.S.C. Section 24.

The documents and the testimony which the movants attempted to get through the deposition of Weigl have a direct bearing on the movants allegations of fraudulent misconduct on the part of Hoegl, et al in filing their Preliminary Statement. The alleged fraud is ancillary to priority of invention. If fraud should be established it could be the basis for striking the Preliminary Statement. In that sense any testimony of Weigl relating to the subject of Shattuck, et al.'s, claim of fraud is relevant to the interference proceeding.

The movants have a statutory right to the desired discovery through this court. This court has ancillary jurisdiction over discovery in the interference proceeding. This court should exercise that jurisdiction

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to complement patent office jurisdiction in search for the truth. Patent Office rules of admissibility of evidence do not govern discovery under the Federal Rules of Civil Procedure in an interference proceeding.

There is no ground for objection that the documents or evidence sought in the discovery will be inadmissible at the trial, so long as the documents and testimony sought to be elicited appear to be reasonably calculated to lead to the discovery of evidence that would be admissible. The movants are entitled to unrestricted access to sources of information bearing on the question of fraud. Weigl is not a party to the interference proceeding. He has no standing to refuse to answer questions asked at the deposition on the ground that they are irrelevant to the interference proceeding.

Weigl is directed to answer the questions which he refused to answer on the advice of counsel at the deposition on February 20, 1974, and which appear in the copy of the transcript submitted as Exhibit 3 annexed to the affidavit of Clyde T. Metzger.



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Weigl is directed to appear at the Office of Wiser, Shaw, Freeman, VanGraafeiland, Harter & Secrest, 700 Midtown Tower, Rochester, New York 14604, on April 5, 1974 at 10:00 A.M. to answer the questions previously asked him and to answer any further questions he may be asked with respect to his work for Xerox Corporation in the field of photoconductive compositions relating to possible fraud in connection with the filing of the Preliminary Statement in Interference No. 98,047 and as they relate to any further issues relevant to said interference.

Weigl is directed to produce at said time and place any documents in his possession, custody or control, within the scope of Schedule A annexed to the subpoena duces tecum served on him on or about February 11, 1974, and particularly such documents as laboratory reports, memoranda, correspondence, or notes relating to work done prior to August 1, 1964, either by Weigl or by Dr. E. Lell, with whom Weigl worked at Xerox Corporation in Rochester, New York, or by others under his direction or control, which relate to photoconductive compositions comprising from about 0.49

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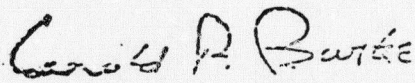
to about 1.23 moles of 2, 4, 7-trinitro-9 flourenone ("TNF") per monomeric unit of a polymerized vinyl-carbazole ("PVK") compound.

Weigl is directed to testify with respect to any documents produced in accordance with the schedule of the subpoena duces tecum.

Weigl is directed, if asked by the attorneys representing the movants, to state the names of co-workers in the laboratory with him, and their addresses, if known to him, in relation to the work done prior to August 1, 1964.

The application of the movants for expenses incurred in connection with this motion, including attorneys' fees, is denied.

ALL OF THE ABOVE IS SO ORDERED.

  
HAROLD P. BURKE  
United States District Judge

March 26, 1974.



1 A. Yes, sir.

2 DQ13 Which of these people would be group leaders, at  
3 that time?

4 MR. HONE: Do you mean, with  
5 group leaders?

6 MR. WALSH: With group leaders.

7 A. To the best of my recollection, Dr. Lell who worked  
8 independently, Dr. Martel and Dr. Brynko.

9 DQ14 At that time, did those three report to you?

10 A. Yes, sir.

11 DQ15 And, am I correct, I might have asked this, I am not  
12 certain, but at that time, was your title manager  
13 of Imaging Materials Department of the Applied Re-  
14 search Laboratory?

15 A. To the best of my recollection, that was the title,  
16 at that time.

17 DQ16 You testified the last time that during or shortly  
18 after 1962, the people at Xerox -- "we" is the word  
19 used, initiated discussions leading toward a re-  
20 search project between Xerox and Battelle, I will  
21 ask you, was any research agreement reached between  
22 Xerox and Battell?

23 MR. HONE: Now, to the extent

1 MR. WALSH: Do you have with  
2 you now the documents as to which you  
3 claim privilege?

4 MR. HONE: No.

5 MR. WALSH: You did not bring  
6 them with you?

7 MR. HONE: That is correct.

8 MR. WALSH: Do you have a  
9 list of the documents with the dates  
10 on which they were written and the  
11 addressees to whom they were sent and  
12 the person who sent them?

13 MR. HONE: No, I haven't such  
14 a list. That could be obtained if  
15 you feel it appropriate. I don't  
16 think it bears on the issue, but we  
17 could obtain them.

18 MR. WALSH: Let the record  
19 show that there appears to be, I  
20 would guess, approximately fifty  
21 pages, maybe seventy or so, which  
22 have been handed to us.



1 the year 1963, did you, Dr. Weigl, or anyone else  
2 in your group at Xerox work with compositions com-  
3 prising from about 0.49 to about 1.23 moles of  
4 2, 4, 7 trinitro-9 fluorenone per monomeric unit  
5 of a polymerized vinylcarbazole compound? To make  
6 certain everybody understands the question I will  
7 repeat it. In 1963, Dr. Weigl, did you or any  
8 member of your group at Xerox work with an organic  
9 photo conductive composition comprising from about  
10 0.49 to about 1.23 moles of 2, 4, 7 trinitro-9  
11 fluorenone per monomeric unit of a polymerized  
12 vinylcarbazole compound?

13 MR. HONE: When you say,  
14 "from 0.49 to about 1.23," you mean  
15 anything within that range, is that  
16 correct?

17 MR. WALSH: That is correct.

18 MR. HONE: Fine.

19 A. Yes.

20 DQ33 Is that work the subject of the records which Mr.  
21 Hone just handed to me?

22 A. Completely covers that.

23 DQ34 Would you give us a brief summary of what is cover-

1 the call.

2 DQ45 At the time of the call, regardless of who initiated  
3 it, were you in the United States and was he in  
4 Switzerland?

5 A. Yes, sir.

6 DQ46 Do you recall the circumstances of this telephone  
7 call?

8 MR. HONE: Well, I object on  
9 the ground that it calls for an irre-  
10 levant and possibly confidential sub-  
11 ject matter, but if Dr. Weigl can  
12 answer without revealing any confiden-  
13 tial subject matter other than dis-  
14 cussion of the subject matter of the  
15 count of this interference I will be  
16 glad to let him answer.

17 A. I will try to the very best of my ability to recon-  
18 struct this. To the best of my recollection, both  
19 Hoegl and I were aware of the I.B.M. issued patent  
20 on polyvinylcarbazole doped with 0.49 to 1.23 mole  
21 to mole ratios of T.N.F. We were both aware of his  
22 intention and we were trying to retrace in our minds  
23 the origins and background of this invention.



1 cation to Xerox as he understood it.

2 THE WITNESS: I am sorry, which  
3 question would you like me to answer?

4 MR. WALSH: I will start  
5 again.

6 THE WITNESS: Please.

7 DQ56

8 You say that work under the sponsorship of Xerox in  
9 the field of T.N.F. and P.V.C. containing materials  
10 stopped. You seem to leave open the possibility  
11 that work under somebody else's sponsorship might  
12 have been going on. I am asking you if work had  
13 been done under the sponsorship of Xerox, would it  
14 or would it not have been assigned to Xerox?

15 A.

16 To the best of my understanding, work sponsored by  
17 Xerox was the product of it, was the property of  
18 Xerox.

19 DQ57

20 And, after April, 1966, to the best of your know-  
21 ledge, and information, and, incidentally, if I  
22 understood you correctly, Dr. Hoegl was sending you  
23 reports and keeping you informed of his work so that  
if work had gone on you would have known about it,  
to the best of your knowledge, he did not work in  
this field of T.N.F. and P.V.C. after April, 1966,

1 is that correct?

2 A. Dr. Hoegl's reports to Xerox would cover work spon-  
3 sored by Xerox and it is correct that there was no  
4 Xerox sponsored work on polyvinylcarbazole and T.N.F.  
5 subsequent to termination of this project.

6 DQ58 And, that termination was April, 1966?

7 A. That is correct, or very close to that time.

8 DQ59 There were a few incidental, further reports to which  
9 you referred. When would they have terminated, in  
10 a month or two?

11 MR. HONE: Dr. Weigl has al-  
12 ready answered.

13 A. I believe by mid-1966. We have furnished you with  
14 all information relating to the count that appears  
15 in any reports that we were able to find from all  
16 relevant Battell-Geneva projects. There is only  
17 one relevant Geneva project so far as I know and you  
18 have information for everything.

19 DQ60 I'd like to call your attention again to the tele-  
20 phone call between you and Dr. Hoegl in late 1972.  
21 Am I correct, in concluding that during that tele-  
22 phone conversation the work done by Xerox in 1963  
23 and 1964, was discussed with Dr. Hoegl?



1 MR. WALSH: What is the basis  
2 for that omission?

3 MR. HONE: The other portions  
4 of that document are not relevant to  
5 the subject matter of the interference,  
6 that is, the polyvinylcarbazole mix-  
7 tures in the proportions that are  
8 described in the count.

9 MR. WALSH: You are aware,  
10 of course, that the court order says  
11 not only relevant materials, but any-  
12 thing reasonably calculated to lead  
13 to relevant materials.

14 MR. HONE: That is correct.  
15 I understand that.

16 MR. WALSH: You still say it  
17 is not relevant and you will not pro-  
18 duce it?

19 MR. HONE: That's right, it  
20 is not reasonably calculated to lead  
21 to relevant materials.

22 DQ82

23 Could I ask you, Dr. Weigl, to identify the recipients,  
document 1, A. Mahassel, could you identify him?

1 A. Certainly, patent manager in Rochester.

2 DQ83 J. Mammino?

3 A. He is one of the members of my group.

4 DQ84 That's right. A.G. Tweet?

5 A. I believe Dr. Tweet was my supervisor, at the time.

6 DQ85 W.W. Tyler?

7 A. I believe he was manager of the research laboratories,  
8 at the time.

9 DQ86 D.L. Stockman?

10 A. He was a research manager concerned with photocon-  
11 ductors generally, at the time.

12 DQ87 Were all these men in Xerox in the United States?

13 A. Yes, sir.

14 DQ88 And, J.J. Ralabate I know as the Xerox patent  
15 attorney?

16 A. That's right.

17 DQ89 Do you know if Mr. Mahassel is a member of the New  
18 York Bar?

19 A. I can't answer that.

20 DQ90 Do you know if Mr. Ralabate is a member of the New  
21 York Bar?

22 MR. KARAMBELAS: Mr. Mahassel

23 is not a member of the New York Bar,



Mr. Ralabate is.

DQ91 Document 1-B, the name, J.V. Imbilis, could you identify that person?

A. Same person as G. Salazry after her marriage.. This is her married name.

DQ92 She is a research worker in your group?

A. She specifically was a research aid during 1964, in my group.

DQ93 And, the other name, J. Erbauch?

A. J. Erbauch is a research manager, Xerox, Palo Alto research center who I felt might possibly be interested.

DQ94 May I ask you, what is the basis for the privilege which you are alleging in regard to these documents, specifically, document 1?

MR. HONE: The basis, Mr.

Walsh, is attorney-client communication, more specifically, a communication in response to an attorney request in connection with the legal activities of the attorney and, I might add, that in addition to attorney-client privilege which attaches to this,

*Exhibit 6 Annexed to Affidavit of Robert J. Kadel*

IN THE UNITED STATES PATENT OFFICE

d/3451A Shattuck et al )

v. )

Hoegl et al )

Interference No. 98,047

PRELIMINARY STATEMENT

I, Helmut HOEGL along with Giacomo BARCHIETTO, declare that we are parties in the above-identified interference; that we made the invention set forth by the counts of the Interference; and that the invention set forth by the counts of the Interference was made by us as early as July, 1964, in Geneva, Switzerland; that

1) the invention was introduced into the United States as related to count 1 by written disclosure in a letter report No. 19, mailed August 24, 1964, and received in the United States on or about August 26, 1964, as evidenced by page 3 of said letter report attached hereto as Exhibit A, and as related to count 2 in letter report No. 21 mailed November 25, 1964, and received in the United States on or about November 27, 1964, as evidenced on pages 1 and 2 of said report attached hereto as Exhibit B.

2) The dates of reduction to practice in the United States are on or about August 26, 1964, as to count 1, and on or about November 27, 1964, as to count 2, the respective dates of reception for the written description of the reductions to practice in Geneva, Switzerland, embraced in letter reports Nos. 19 and 21 respectively.



3). If the allegations offered in 2) above are not found to be reductions to practice of the respective counts in the United States under law, then the date after conception of the invention when active exercise of reasonable diligence of reducing the invention to practice began was on or about August 26, 1964, and November 27, 1964, the reception dates of the respective letter reports Nos. 19 and 21.

We declare further that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or patent issuing thereon.

7 November 1972  
Date

Helmut Hoegl  
Helmut HOEGL

Sworn before me at  
Geneva, Switzerland,  
this 7<sup>th</sup> day of  
November, 1972

Giacomo Barchietto  
Giacomo BARCHIETTO

Minister

A 64

*Exhibit 6 Annexed to Affidavit of Robert J. Kadel*

THE STUDY OF FUNDAMENTAL ASPECTS RELATED  
TO THE PHOTO-CREATION AND MOBILITY OF FREE  
CHARGE CARRIERS IN ORGANIC MATERIALS

Letter-Report No. 21

to

XEROX CORPORATION  
Research & Engineering Center  
800 Phillips Road

W e b s t e r  
New York, USA

by

Giacomo Barchietto, Helmut Hoegl,  
Adolf Steinemann and Demokos Tar

This letter-report describes the work done during the  
month of October 1964.



The work we did was concerned mainly with the following points:

- Preparation of highly sensitive PVK layers strongly absorbent in the UV and visible regions of the spectrum.
- Continuation of measurements of dye-sensitised PVK layers.
- Fluorescence measurements on various PVK films.
- Thermoluminescence measurements on pure PVK films.

1. Highly sensitised PVK

As mentioned in our latest letter-report, No. 20, we have prepared double layers of both PVK and 2.4.7.-trinitrofluorene (TNF) (in Lucite 2046 resin binder). These double layers showed very rapid photo-induced and slow dark decay. We observed that a residual charge stayed on the plates, and that the amount of it depended on the thickness of the top Lucite 2046 resin layer.

We made a number of experiments to reduce the thickness of the Lucite top layer by the dip coating techniques. We found that the solvent removes too much of the base coating, and that it is too difficult to prepare films of less than  $10^{-4}$  cm thickness.

For those reasons, we next used the flow discharge polymerization process\*) to overcoat strongly doped PVK layers of about 5...3  $\mu$  thickness. We obtained very satisfactory results with this technique. Highly doped PVK layers that show too fast a dark discharge may thus be overcoated with a very thin insulating film, which reduces very effectively the dark discharge of the photoconductive layer; however, these layers are not sufficiently thick to cause significant residual charges upon illumination.

We made experiments with two types of layers:

- PVK + TNF (1:1, molar ratio 6:5) and
- PVK + p-chloranil [pCA] (10:1, molar ratio 15:1).

\*) see e.g. J. Goodman, J. Polymer Sci. XLIV, Issue 144 (1960), 551, and A. Bradley and J.P. Hammes, J. Electrochem. Soc. 110 (1963), 15

## Exhibit 6 Annexed to Affidavit of Robert J. Kadel

-2-

These photoconductive layers were overcoated with a polymer obtained by glow discharge polymerization of methylmethacrylate. (Another experiment was made with ethylsilicate, but the results with methylmethacrylate were much better, obviously owing to much better insulating properties.)

Absorption and emission spectra of these photoconductive films were measured. Both the PVK/TNF and PVK/pCA layers are strongly absorbent between 350 and 800 m/ $\mu$ , where pure PVK practically does not absorb at all. No fluorescence or phosphorescence were observed up to 700 m/ $\mu$ .

Dark and phot-induced discharge characteristics were measured. As the decay of the voltage follows over a wide range that expected for ohmic behavior, we have used the well-known equations for condensers to calculate the data listed in the following tables:

Table 1

Layer: PVK + TNF (1:1), overcoated with glow discharge polymerized methylmethacrylate. Sample No. 50.

Thickness:  $7.0 \times 10^{-4}$  cm.

	Dark (D)	430 m/ $\mu$	Light 550 m/ $\mu$	640 m/ $\mu$
$I_L$ Light intensity (watt $\text{cm}^{-2}$ )	-	$8.8 \times 10^{-6}$	$4.15 \times 10^{-5}$	$4.35 \times 10^{-3}$
F <sub>act.</sub> absorption A	-	1	0.9	0.45
$\tau_H$ (sec.), half-time	300	0.8	0.27	0.5
$\sigma$ ( $\text{ohm}^{-1} \text{cm}^{-1}$ )	$6 \times 10^{-16}$	$2 \times 10^{-13}$	$7 \times 10^{-13}$	$4 \times 10^{-13}$
$\frac{\sigma_L}{\sigma_D \cdot I_L}$	-	$4.5 \times 10^7$	$2.7 \times 10^7$	$1.4 \times 10^7$
Gain	-	0.067	0.006	0.044



*Exhibit 6 Annexed to Affidavit of Robert J. Kadel*

Layer: PVK + pCA (1:1), overcoated with glow discharge polymerized methylmethacrylate. Sample No. 51.

Thickness:  $7.5 \times 10^{-4}$ .

	Dark (D)	360 m/ $\mu$	Light 375 m/ $\mu$	590 m/ $\mu$
$I_L$	-	$7.3 \times 10^{-5}$	$7.2 \times 10^{-5}$	$4.2 \times 10^{-5}$
Fract.abs. A	-	0.8	0.33	0.4
$t_H$ (sec.)	106	3.5	4.6	1.2
$(\Omega^{-1} \text{cm}^{-1})$	$1.7 \times 10^{-15}$	$5.3 \times 10^{-14}$	$4 \times 10^{-14}$	$1.5 \times 10^{-13}$
$\sigma_L$				
$\sigma_D \circ I_L$	-	$4 \times 10^5$	$3.7 \times 10^5$	$2.1 \times 10^4$
Gain	-	0.0016	0.005	0.013

These results show again what E. Lell and J. Weigl already have pointed out; namely, that TNF is the best CT sensitizer found so far for PVK.

We believe that the process of overcoating organic photoconductive films with glow discharge polymerized thin films will be very useful. These top films can be used both to enhance the insulating properties of the base layers and act as protection against photo-chemical degradation.

## 2. Dye-sensitized PVK

We have continued absorption, emission, and electrostatic measurements on the series of PVK layers sensitized with increasing concentrations of Nile Blue A.

These measurements are somewhat complicated by the fact that the dye is used in form of its salt with sulfuric acid. PVK being a base, though a rather weak one, it reacts to a certain extent with the sulfuric acid. Consequently, to a small extent, the free dye base is formed, and therefrom the leucobase, when Nile Blue A is added to PVK. Therefore, on sensitizing PVK with Nile Blue A (or any other dye sensitizer), we have both the dye salt and the leucobase to consider in

November 1, 1973

Anthony Karambelas, Esq.  
Ralabate, Mahassel and Kondo  
Xerox Corporation  
Xerox Square  
Rochester, New York 14603

Subject: Interference 98,047

Dear Tony:

I am writing to confirm and make of record our telephone conversation of this morning, in regard to the suggestion in my letter of October 16, 1973.

The party Hoegl et al declined the offer of the party Shattuck et al to pay the expenses of bringing Drs. Hoegl and Barchietto to the United States. The party Hoegl et al also declined to enter into a stipulation under Rule 284(e) so that the testimony of Dr. Hoegl and Dr. Barchietto could be taken orally in Europe.

Yours truly,

Joseph G. Walsh  
Attorney for the Party  
Shattuck et al

JGW:mmm



*Exhibit 6 Annexed to Affidavit of Robert J. Kadel*

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF NEW YORK

-----x  
SHATTUCK ET AL., :  
Movants, :  
v. : Patent Interference 98,047  
HOEGL ET AL., :  
Respondents. :  
-----x

AFFIDAVIT OF CLYDE C. METZGER

STATE OF NEW YORK )  
: ss.:  
COUNTY OF NEW YORK )

CLYDE C. METZGER, being duly sworn, deposes and says:

1. I am a member of the Bar of the State of New York, the Court of Appeals for the Second Circuit, and of the firm of Pennie & Edmonds, 330 Madison Avenue, New York, New York 10017, counsel for Movants, Meredith D. Shattuck and Ulo Vahtra ("Shattuck et al."), in the above-captioned action.

2. There is presently pending in the United States Patent Office a patent interference proceeding, No. 98,047, which was declared by the Patent Office on August 16, 1972 between Shattuck et al. and Hoegl et al.

3. The real parties in interest are International Business Machines Corporation ("IBM"), assignees of Shattuck et al., and Xerox Corporation ("Xerox"), assignees of Hoegl et al.

4. This affidavit is made in support of Movants' Request For An Order To Show Cause Why The Witness Weigl Should Not Be Compelled To Produce Allegedly Privileged Documents.

5. The party Shattuck et al. makes this request for an Order To Show Cause because its time for taking the testimony in this interference is presently set to expire on April 24, 1974.

*Exhibit 6 Annexed to Affidavit of Robert J. Kadel*

and although an extension has been applied for, it is not certain how much time will be granted by the Patent Office. In any event, time is clearly of the essence in connection with Shattuck et al.'s diligent completion of testimony in the interference.

26. On information and belief, the following documents, annexed to the Memorandum submitted herewith in support of the above Request For Order are true and correct copies of the originals thereof:

Exhibit A - Court Order of March 26, 1974  
Compelling The Witness Weigl To  
Produce Documents And To Answer  
The Questions Propounded To Him.

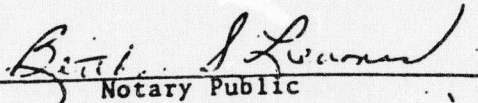
Exhibit B - Copies of Transcript Pages 7, 14,  
15, 26, 27, 45, and 46 from the  
deposition of John W. Weigl.

Exhibit C - Relevant portions of the Hcegl  
et al. Preliminary Statement in  
this Interference No. 98,047.

Exhibit D - Letter dated November 1, 1973  
from Joseph G. Walsh, Esq.,  
attorney for the party Shattuck  
et al. to Anthony Karambelas,  
Esq., attorney for the party  
Hoeigl et al.

  
Clyde C. Metzger

Subscribed and sworn to before me  
this 15<sup>th</sup> day of April 1974.

  
Notary Public

BERTHA S. LEVONAS  
NOTARY PUBLIC, State of New York  
No. 41 238 183 Queens County  
Exp. 12-31-75 New York County  
Term Expires March 30, 1975



EXHIBIT 7--"SUPPLEMENTAL MEMORANDUM IN SUPPORT OF MOVANTS'  
REQUEST FOR AN ORDER TO SHOW CAUSE WHY THE WIT-  
NESS WEIGL SHOULD NOT BE COMPELLED TO PRODUCE  
ALLEGEDLY PRIVILEGED DOCUMENTS" ANNEXED TO  
AFFIDAVIT OF ROBERT J. KADEL

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF NEW YORK

-----x

SHATTUCK ET AL.,	:	
	:	
Movants.	:	
	:	
v.	:	Patent Interference 98,047
HOEGL ET AL.,	:	
	:	
Respondents.	:	

-----x

SUPPLEMENTAL MEMORANDUM IN SUPPORT OF MOVANTS' REQUEST  
FOR AN ORDER TO SHOW CAUSE WHY THE WITNESS WEIGL SHOULD  
NOT BE COMPELLED TO PRODUCE ALLEGEDLY PRIVILEGED DOCUMENTS

Introduction

Subsequent to the Court's Show Cause Order dated April 23, 1974 in the above-captioned case, Shattuck et al., on April 24, 1974, took the further deposition of the witness Weigl and also the deposition of Anthony W. Karambelas, Xerox's in-house patent counsel.

During these further depositions, highly significant additional evidence was elicited which (a) strongly confirms the prima facie evidence of fraud set forth in Shattuck et al.'s original Memorandum filed on April 23, 1974, and (b) strongly confirms the necessity for Shattuck et al. to have access to the allegedly privileged documents withheld by the witness Weigl.

The Prior Art Work Of  
Dr. Weigl's Group

In regard to the equal weight PVK-TNF composition which Hoegl et al. swore they invented,<sup>1</sup> and which they declared themselves to be the first and original inventors of,<sup>2</sup> it now

<sup>1</sup> Hoegl et al. Preliminary Statement, pg.1, annexed as Exhibit C to Shattuck et al.'s original Memorandum filed with this Court on April 23, 1974.

<sup>2</sup> Hoegl et al. CIP Declaration (lines 1-10) and Claims (claim 1), annexed hereto as Exhibit E.

*Exhibit 7 Annexed to Affidavit of Robert J. Kadel*

appears that prima facie evidence now exists that these oaths were not correct and that the Xerox patent attorneys were aware of this evidence when the Hoegl et al. CIP Declaration and Preliminary Statement were filed. Specifically:

(i) This very same composition was previously made in the United States by members of Dr. Weigl's group, i.e., Mr. J. Mammino and/or others in 1963 and on up through May 1964.<sup>3</sup>

(ii) Legible photocopies had actually been produced during that time from photoconductive plates employing that equal weight PVK-TNF composition.<sup>4</sup>

(iii) Mr. Mammino prepared an Invention Record on March 26, 1970 covering that composition and submitted it to Dr. Weigl, who in turn submitted it to the Xerox Patent Department.<sup>5</sup>

(iv) The Xerox Patent Department thereafter prepared a draft patent application and a revised draft application thereon (but never filed it as discussed hereinafter).<sup>6</sup>

(v) The Mammino work in 1963 through May 1964 was prior to the earliest date of "invention" alleged by Hoegl et al. in their Preliminary Statement.<sup>7</sup>

(vi) This early Mammino work was not abandoned, suppressed, or concealed as far as Xerox is concerned, since as late as 1970, as noted above, Mammino prepared an Invention Record on that work and the Xerox Patent Department even drafted a patent application and a revised patent application thereon.

(vii) Thus, in regard to the equal weight PVK-TNF composition, the Mammino work is prior to, and apparently a complete anticipation of, Hoegl et al.<sup>8</sup>

Allegedly Privileged Documents  
Withheld By The Witness Karambelas

During the deposition on April 24, 1974 of Xerox's in-house patent attorney, Anthony W. Karambelas, an extensive list of allegedly privileged documents was produced,<sup>9</sup> all relating

<sup>3</sup> Weigl deposition, annexed hereto as Exhibit F, pgs.74-77,80-82.

<sup>4</sup> Weigl deposition, annexed hereto as Exhibit F, pgs.109-112.

<sup>5</sup> Shattuck et al. Exhibit 26 (Items 1 and 1a) annexed to the Show Cause Order herein dated April 23, 1974.

<sup>6</sup> Karambelas deposition, annexed hereto as Exhibit G, pgs.97,98.

<sup>7</sup> See Footnote 1 above.

<sup>8</sup> 35 U.S.C. § 102(f) and (g) are set forth in the footnote at page 9 of Shattuck et al.'s original Memorandum filed April 23, 1974.

<sup>9</sup> Shattuck et al. Exhibit 27, annexed hereto as Exhibit H.



*Exhibit 7 Annexed to Affidavit of Robert J. Kadel*  
to the work of Weigl's group prior to August 1, 1964.<sup>10</sup> This list of documents itself (correspondence between Weigl and the Xerox patent attorneys, draft applications on Mammino's work, Xerox Patent Department affidavits, and documents relating to Mammino's work, correspondence with Hoegl and Barchietto, etc.) further establishes that the Xerox patent attorneys were well aware of the early work of Weigl's group and considered it as being obviously highly relevant prior art in regard to any assertion of inventorship by Hoegl et al. Yet, the Xerox Patent Department still permitted the filing of the Hoegl et al. CIP Declaration and Preliminary Statement Oath. Moreover, Hoegl et al. themselves, having full knowledge of the prior work of Weigl's group on the exact same composition,<sup>11</sup> swore that they invented, and were the first and original inventors of, that composition.

The Significance Of The Allegedly Privileged Documents Withheld By Weigl In View Of The Additional Evidence Referred To Above

The three documents withheld by Dr. Weigl,<sup>12</sup> one dated March 26, 1970 and two dated April 2, 1970, are particularly significant since they were all generated within two weeks after IBM representatives informed Xerox (on March 20, 1970) of the PVK-TNF composition used in the IBM copier machines which were to be put on commercial sale the following month, April 1970.<sup>13</sup>

It is believed the documents requested herein may firmly establish that Dr. Weigl and the Xerox attorneys, in April 1970, concluded that the work of Dr. Weigl's group was not abandoned, suppressed, or concealed, and that therefore a patent application should be drafted in connection with that work (which was in fact done).<sup>14</sup> It would then, of course, be improper to permit the

<sup>10</sup> Karambelas deposition, annexed hereto as Exhibit G, pgs.97-98.

<sup>11</sup> Shattuck et al. Exhibit 27, annexed hereto as Exhibit H, Items 3 and 4.

<sup>12</sup> Items 1, 1a, and 1c of Shattuck et al. Exhibit 26, annexed to the Show Cause Order herein.

<sup>13</sup> Karambelas deposition, annexed hereto as Exhibit G, pg.106.

<sup>14</sup> Karambelas deposition, annexed hereto as Exhibit G, pgs.97-98.

*Exhibit 7 Annexed to Affidavit of Robert J. Kadel*

subsequent filing of the Hoegl et al. CIP Declaration and Preliminary Statement Oath.

For example, the documents withheld on the grounds of privilege may very well show that the actual reason for not filing the draft application was, not because Weigl's work was abandoned, suppressed, or concealed by Xerox, but because the Shattuck et al. United States and corresponding foreign patents had long since issued and Xerox was thereby statutorily barred from filing a new application in the name of Mammino or anyone else in Weigl's group. (See footnote 7 of original Shattuck et al. Memorandum.)

It is respectfully submitted that the highly pertinent facts regarding the prior art work of Dr. Weigl's group, and Xerox's reasons for permitting the filing of the Hoegl et al. CIP Declaration and Preliminary Statement Oath in spite of that earlier work, are facts and reasons which Xerox in any event should have presented to the Patent Office so that the Patent Office could properly assess the Hoegl et al. CIP application against the prevailing statutory criteria, namely 35 U.S.C. § 102(f) and (g).<sup>15</sup>

In Monsanto Company v. Rohm & Haas Company, 456 F2d 592 (3 Cir. 1972), cert. denied, 407 U.S. 934 (1972), for example, Monsanto had not disclosed all the relevant facts to the Patent Office regarding the invention claimed in their patent application. The Court stated therein at page 600:

"Under these circumstances, it was impossible for the Patent Office fairly to assess Monsanto's application against the prevailing statutory criteria. Thus, Monsanto's failure to disclose amounted to misrepresentation transgressing equitable standards of conduct owed the public by the applicant in return for its monopoly."

<sup>15</sup> 35 U.S.C. § 102 provides that, "A person shall be entitled to a patent unless ... (f) he did not himself invent the subject matter sought to be patented, or (g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it ..."



CONCLUSION

The Hoegl et al. CIP Declaration and Preliminary Statement Oath appear to be obviously inconsistent with the earlier work of Weigl's group relating to the exact same composition. The only way all the relevant facts on the issue of fraud can be brought to the attention of the Patent Office is by Shattuck et al. having unrestricted access to sources of information, including allegedly privileged documents, which relate to this admittedly pertinent prior art work of Dr. Weigl's group. This is particularly so since all the facts regarding this prior art work, and Xerox's reasons for permitting the filing of the Hoegl et al. CIP Declaration and Preliminary Statement Oath in spite of that earlier work, are facts and reasons which Xerox should have, by law, voluntarily disclosed to the Patent Office in any event. They are also, obviously, critical to the issue of fraud in this interference.

Dated: ,

Respectfully submitted,

WISER, SHAW, FREEMAN, VAN GRAAFEILAND,  
HARTER & SECREST

By

---

700 Midtown Tower  
Rochester, New York 14604  
(716) 232-6500  
Attorneys for Movants

OF COUNSEL:

Pennie &amp; Edmonds.

Clyde C. Metzger  
Robert J. Kadel  
Sidney R. Bresnick  
330 Madison Avenue  
New York, New York

10017

ORIGINAL CLAIMS OF HOEGL ET AL.  
CIP APPLICATION SERIAL NO. 108,548,  
FILED JANUARY 21, 1971.

## WHAT IS CLAIMED IS:

1. An organic photoconductive composition comprising about one part by weight of 2,4,7-trinitro-9-fluorenone per one part by weight of polyvinylcarbazole.

2. An electrophotographic process comprising the steps of:

forming an electrostatic image on a photoconductive element comprising about one part by weight of 2,4,7-trinitro-9-fluorenone per one part by weight of polyvinylcarbazole, and developing the electrostatic image.

*add*



A 77

Exhibit 7 Annexed to Affidavit of Robert J. Kadel

DECLARATION, POWER OF ATTORNEY, AND PETITION FOR  
 We, HERBERT HOFER and GIACOMO BARBILOTTO, declare

that we are citizens of GERMANY and ITALY, respectively  
 residing at GRAND-LANCH  
Geneva (Switzerland) and Rusto Arazio (Italy)

; that we have  
 made the foregoing specification and claims and we verily believe that we are  
 the original first and joint inventors of the invention in  
ELECTROPHOTOGRAPHIC PLATE - D/3451 described and  
 claimed in the foregoing specification; that this application in part discloses  
 subject matter disclosed in our earlier filed pending application,  
 Serial No. 519,081, filed January 6, 1966; that, as to

the subject matter of this application which is common to said earlier  
 application, we do not know and do not believe that the same was ever known  
 or used before our invention thereof, or patented or described in any printed  
 publication in any country before our invention thereof, or more than one  
 year prior to said earlier application; or in public use or on sale in the  
 United States more than one year prior to said earlier application; that  
 said common subject matter was not patented before the date of said earlier  
 application in any country foreign to the United States, on an application  
 filed by us or our legal representatives or assigns more than twelve months  
 before said earlier application; that, as to the subject matter of this  
 application which is not common to said earlier application, we do not know  
 and do not believe that the same was ever known or used before our invention  
 thereof, or patented or described in any printed publication in any country  
 before our invention thereof or more than one year prior to this application,  
 or in public use or on sale in the United States more than one year prior  
 to this application; that said subject matter was not patented in any  
 country foreign to the United States on an application filed by us or our legal  
 representatives or assigns more than twelve months before this application;  
 that no application for patent on the non-common subject matter of this  
 invention has been filed by us or our legal representatives or assigns in  
 any country foreign to the United States more than twelve months before  
 this application, except as follows:

and that the earliest application for patent on this invention that has  
 been filed by us or our legal representatives or assigns in any country  
 foreign to the United States, and a claim for the priority of which is  
 made under 35 U.S.C. 119, is as follows:

And we hereby appoint James J. Ralabate, Registration No. 19,211;  
 Robert Mahassel, Registration No. 19,064; Peter H. Kondo, Registration No.  
 724; and 503 Registration No. 503, all  
 of Xerox Corporation, Xerox Square, Rochester, New York, 14603 our attorneys  
 to prosecute this application and to transact all business in the Patent  
 Office connected therewith. All correspondence is to be held with James J.  
 Ralabate.

Wherefore we pray that Letters Patent be granted us for the invention  
 or discovery described and claimed in the foregoing specification and claims,  
 and we hereby subscribe our names to the foregoing specification and claims,  
 declaration, power of attorney, and this petition.

The undersigned petitioners declare further that all statements made in of their own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Inventor

First Name

Middle Initial

Last Name

Post Office Address

25, chem. des Palettes; 1212 GRAND-LANCY/GENEVA (Switzerland)

Date

Dec. 23, 1970

Inventor

First Name

Middle Initial

Last Name

Post Office Address

Via Macchiavelli 15, BUSTO ARSIZIO (Italy)

Date

Dec. 29, 1970

Inventor

First Name

Middle Initial

Last Name

Post Office Address

Date



1 A. Yes, sir.

2 DQ136. Was this work represented on Shattuck, et al  
3 Exhibit "28" the result of her idea?

4 MR. HONE: I object. Same objection  
5 as before. Dr. Walsh can't know-- Dr.  
6 Weigle can't know that, what was in Miss  
7 Salasny's mind at the time.

8 MR. WALSH: Let him answer whether or  
9 not he knew.

10 MR. HONE: Let him answer as to whether  
11 or not he had any understanding with respect  
12 to that question.

13 DQ137. All right. I will ask you that question. Do you  
14 have any understanding as to whether or not this  
15 work was the idea of Miss Salasny?

16 A. I believe it was the idea, probably, of Mr.  
17 Mammino, who was her supervisor, and was charged  
18 with work in the area of organic photoconductors.

19 DQ138. What was Miss Salasny's position at the time?

20 A. Research Aide; Mr. Mammino's assistant under his  
21 supervision.

22 DQ139. Is it correct to classify her as a laboratory  
23 technician?

1 A. Yes, that would be quite right.

2 DQ140. I will then again call your attention to the  
3 writing which says, "10 Micron Film of one to one  
4 PVK:TNF", and ask you to explain what those  
5 abbreviations mean.

6 A. Certainly.

7 MR. HONE: I object to the question as  
8 calling for a conclusion by Dr. Weigle.

9 MR. WALSH: Dr. Weigle is an expert in  
10 this field, well capable of drawing this  
11 simple conclusion.

12 MR. HONE: Dr. Weigle has not been  
13 called as an expert; he has been called as  
14 a fact witness. If you want to elicit facts,  
15 please do so, but don't call on him as an  
16 expert to interpret notebook records. If  
17 you asked Dr. Weigle if he had any under-  
18 standing at the time of this entry as to  
19 what the meaning of that entry was, please  
20 do so, but don't ask him to interpret it.

21 MR. WALSH: I will ask Dr. Weigle what  
22 those symbols mean.

23 MR. HONE: I object and instruct him



Exhibit 7 Annexed to Affidavit of Robert J. Kadel

Dr. John Weigle

1 not to answer. You are here to elicit facts  
2 from Dr. Weigle, not expert opinion.

3 MR. WALSH: The meaning of those symbols  
4 is a fact.

5 MR. HONE: His understanding of what  
6 they meant on this notebook page at the  
7 time they were entered and at the time he  
8 saw them might be a fact; his interpretation  
9 of what they mean is not, it's opinion.

10 MR. WALSH: His understanding is really  
11 very secondary and irrelevant. The impor-  
12 tant point is what is the meaning. I will  
13 ask him again.

14 DQ141. Dr. Weigle, I will split the question up. When  
15 the expression, "one to one" is used, what is  
16 meant?

17 MR. HONE: Used by whom, Mr. Walsh?

18 MR. WALSH: Used by Miss Salasny on this  
19 page.

20 MR. HONE: As of 1963?

21 MR. WALSH: What was meant at that time.

22 MR. HONE: I will let Dr. Weigle answer  
23 as to what his understanding was. If you

will turn to Exhibit "29".

A. It was, I believe, attached, and it refers directly to the same work. Well, you will see that it is substantially "one to one" by weight of trinitrofluorenone-- PVK.

DQ142. No, no, please. Spell it out.

MR. HONE: It says "PVK".

A. It says "PVK".

DQ143. I want the record to show very clearly that the "TNF" does, in fact, mean trinitrofluorenone and "PVK" does, in fact, mean poly-n-vinylcarbazole, so I'll ask you again, Dr. Weigle, what was your understanding as to the meanings of these abbreviations?

A. Very clearly that which is factually stated on Exhibit "29", "0.5475 grams of TNF and 0.55 grams of PVK".

DQ144. And what is "TNF"?

A. 247 trinitro (9) fluorenone.

DQ145. And what is "PVK"?

A. Poly-n-vinylcarbazole.

DQ146. Is that a polymized vinylcarbazole compound?

A. Yes, sir.



Dr. John Weigle

1 it, we will produce it.

2 THE WITNESS: The original notebook will  
3 show it. I am sorry, it ran off the end  
4 of the page.

5 DQ153. Does Miss Salasny still work for Xerox?

6 A. Miss Salasny's married name is Jvirblis, and she,  
7 again, works for Xerox after some years of not  
8 having worked for Xerox.

9 DQ154. In calling your attention specifically to the  
10 material containing equal weights of PVK and TNF,  
11 the one:one by weight, do you know whose sugges-  
12 tion it was to use that specific composition?

13 A. I can only speculate. Thinking back, I am quite  
14 sure that it was not mine and I can tell you why,  
15 if necessary.

16 MR. HONE: You are not required to  
17 speculate, Dr. Weigle.

18 THE WITNESS: Am I permitted?

19 MR. WALSH: I have no objections.

20 THE WITNESS: I believe it was probably

21 Mr. Mammino's.

22 DQ155. Could you explain the basis for your belief that  
23 it was Mr. Mammino's suggestion?

1 A. Yes.

2 DQ156. Would you, please?

3 A. The prime objective of this project was directed  
4 to novel compositions of great mechanical strength,  
5 based upon materials other than PVK, and sufficiently  
6 transparent to be useful as a Xerographic microfilm  
7 for direct projection, and our prime objectives,  
8 then, were to fabricate-- to innovate and to  
9 fabricate materials which were mechanically strong,  
10 self-supporting and useful for transparency pro-  
11 jections. These materials were really outside the  
12 prime objectives of the project.

13 MR. HONE: When you say "these materials",  
14 what do you mean, Dr. Weigle?

15 THE WITNESS: The materials which fall--  
16 I'm sorry, the materials in the general  
17 range of one to one by weight PVK to TNF  
18 compositions, and similar compositions which  
19 we are discussing here today, were somewhat  
20 outside the scope of the project and of its  
21 main objectives, and therefore, of relatively  
22 casual interest to us at that time.

23 DQ157. This doesn't connect it, at least I don't see how



Exhibit 7 Annexed to Affidavit of Robert J. Kadel

Dr. John Weigle

1 it connects it to Mr. Mammino.

2 A. Mr. Mammino, as project leader, was free to take  
3 reasonable excursions as his interest dictated  
4 and as a research man and research product leader  
5 would be expected to.

6 DQ158. But this work was done under your supervision,  
7 is that correct?

8 A. That is correct.

9 DQ159. Who else would have knowledge of this work at this  
10 time? Specifically, was there any intermediate  
11 leader or manager between Mr. Mammino and you?

12 A. There was none.

13 DQ160. Would other group leaders have knowledge of it?

14 MR. HONE: What do you mean by "other  
15 group leaders"? Outside Dr. Weigle's group?

16 MR. WALSH: Well, all right, outside of  
17 Dr. Weigle's group, yes.

18 A. At the time, as best I can recall, this was a  
19 very brief excursion and one which we did not take  
20 very seriously, and I don't know whether it was  
21 widely discussed.

22 DQ161. Would, for example, Dr. Martel have had knowledge  
23 of this?

Dr. John Weigle

1 (Whereupon, the Reporter marked for identification

2 Shattuck, et al Exhibit "45")

3 DQ233. Turning to the first page of Exhibit "35", you  
4 will note that apparently it is a continuation  
5 of page 91, which is the prior page here. On the  
6 bottom of this page, on the left hand side, it  
7 has "50/50 PVK/TNF" from 5-5-64. What is the  
8 significance of that notation, Dr. Weigle?

9 MR. HONE: As you understood it at the  
10 time.

11 DQ234. As you understood it at the time, and if you  
12 understand it differently now, please let us know.

13 A. I believe that it means that it is equal weight  
14 proportions of PVK and TNF, and the coating as  
15 those described previously--probably identical to  
16 them.

17 DQ235. And the upper portions of this, are these actual  
18 pictures made using that photoconductive composi-  
19 tion?

20 A. In the original notebook, they are actual pictures  
21 made from a test target in an enlarger at a series  
22 of exposures, constant light bulb setting, constant  
23 current setting, variable aperture and time.



Dr. John Weigle

1 The apertures have been noted as "F" stops.

2 The times are noted in seconds. What this whole  
3 series does as a group is to provide an idea of  
4 the photosensitivity of this particular combina-  
5 tion of materials or this--

6 DQ236. The other notations on this page refer to other  
7 varying ratios of PVK and TNF, is that correct,  
8 on the right hand side?

9 A. Yes. They actually fall outside of the count.

10 DQ237. The date of this page is May 5, 1964, is that  
11 correct?

12 A. Yes, sir.

13 DQ238. In summary, therefore, Shattuck, et al Exhibit  
14 "35" shows a legible electrographic copy of a  
15 document copied using as a photoconductor a  
16 composition consisting of equal weights of poly-  
17 vinylcarbazole and trinitrofluorenone, is that  
18 correct?

19 A. That's correct.

20 DQ239. The symbol on the extreme left hand side is a  
21 negative sign with a circle around it. What is  
22 the significance of that?

23 A. I don't know for sure.

Exhibit 7 Annexed to Affidavit of Robert J. Kadel

Dr. John Weigle

1 DQ240. Shattuck, et al Exhibit "36", the next page, once  
2 again the lower left hand corner shows equal  
3 weights of PVK and TNF. I'll ask you, is the  
4 image on the top of the page a Xerographic copy  
5 prepared using that composition as the photo-  
6 conductor?

7 A. Yes, as I said before, this whole series is a  
8 series of images made quite clearly with the one  
9 to one by weight PVK:TNF plate, and it was done  
10 in an attempt to find the optimal exposure.

11 DQ241. The important work-- the important fact I am  
12 trying to get at, Dr. Weigle, is that these are  
13 actual legible copies made using this composition  
14 as a photoconductor, is that correct?

15 A. I can read them.

16 DQ242. And this work was done on May 5, 1964, is that  
17 correct?

18 A. Yes, sir.

19 DQ243. All right. Do you recall when you first saw this  
20 work?

21 MR. HONE: Do you mean the work recorded  
22 on these pages?

23 MR. WALSH: No, either the work recorded



Dr. John Weigle

1 on these pages or a subsequent summary or  
2 report reflecting this work.

MR. HONE:

3 Well, why don't you ask the  
4 questions one at a time?

5 DQ244. All right, when did you first see these pages,  
6 Dr. Weigle?

7 A. I don't believe I recall, but certainly it was, at  
8 the very latest, at the time of the review of the  
9 notebook in 1967, and I might possibly have reviewed  
10 them during 1963 or 1964. Well, these in 1964.

11 DQ245. These pages, do they or do they not all bear the  
12 notation "Project number 532412"?

13 A. Yes.

14 DQ246. I'll call your attention to the next group of  
15 three pages stapled together entitled, "Xerox  
16 Research and Engineering Division Research  
17 Laboratories Report Number RL64-45". Later down  
18 in the page it bears the notation, "Project Number  
19 532412".

20 A. All right, sir.

21 DQ247. There are two names on it; J. Mammino and  
22 G. Jvirblis, am I correct? I believe you pre-  
23 viously testified that Jvirblis is the married

1 MR. HONE: I will answer for him. No,  
2 he did not, and I, as his attorney, did not.

3 MR. WALSH: I will ask him to answer the  
4 question.

5 DQ255 Did you bring the documents?

6 A No, I did not.

7 DQ256 I'll call your attention to document 8. It says  
8 "revised application draft, PVK/TNF." Did this  
9 document specifically concern a patent application  
10 relating to work done in the United States prior to  
11 August 1, 1964?

12 A Yes, I believe it did.

13 DQ257 This was the work done by people in Weigle's group?

14 A Yes, I believe so.

15 DQ258 Is that statement also true in regard to document 2,  
16 "Draft Patent Application, PVK:TNF"?

17 A Yes, I believe so.

18 DQ259 Were these applications ever filed?

19 A No, they were not.

20 DQ260 Why not?

21 MR. HONE: Objection. The reasons why or  
22 why not applications were filed are privileged  
23 and calls for an attorney's conclusions, calls



1 for all kinds of things that you are not  
2 entitled to.

3 DQ261 I'll call your attention to document 12 entitled  
4 "Draft Affidavit." I will ask you what this  
5 affidavit pertains to?

6 MR. HONE: Objection, the contents of that  
7 affidavit is a privileged matter.

8 DQ262 Did it relate to work done in the United States  
9 under the direction of Dr. Weigle prior to August 1,  
10 1964?

11 MR. HONE: Well, if it hadn't, it wouldn't  
12 have been on this list.

13 MR. WALSH: Mr. Hone --

14 A Yes. The answer is yes.

15 MR. WALSH: I want the witness to answer  
16 the questions, please.

17 DQ263 I didn't hear your answer, I'm sorry.

18 A I believe so. I believe so.

19 DQ264 For whose signature was that affidavit drafted?

20 A Can I have a minute?

21 MR. WALSH: Sure.

22 (The witness confers with Mr. Hone.)

23 MR. HONE: I am going to object to any

1 Zealand or the one from Great Britain or the one  
2 from any other foreign country you might care to  
3 name?

4 A I think the first time that I became aware of those  
5 is when I received papers from you and you listed  
6 the foreign counterparts. I believe that was the  
7 first time I was aware of them.

8 DQ279 In connection with your becoming aware of the  
9 composition of the IBM photoconductor I'd like to  
10 refresh your memory again.

11 MR. HONE: If he's aware of it.

12 MR. WALSH: I'd like to attempt again to  
13 refresh his memory -- not your memory, Mr. Hone,  
14 his.

15 DQ280 I'll tell you that on March 20, 1970, representatives  
16 of IBM informed representatives of Xerox what the  
17 composition of the proposed IBM photoconductor would  
18 be in the copier which was put on commercial sale  
19 the following month, April, 1970. I will ask you  
20 again, did you or did you not, very shortly -- say  
21 within three months of that date, know the compo-  
22 sition of the IBM photocopier -- the photoconductive  
23 composition in the copier?



## Exhibit 7 Annexed to Affidavit of Robert J. Kadel

64-24-74  
H-24-74  
J.O.  
re amended

List of Privileged or Work Product Documents in the Xerox Files Relating to Interference No. 98,047 Between Hoegl et al and Shattuck et al in the United States Patent Office Which Were Prepared on or Before November 7, 1972 and Which Relate to Work done in Connection With the Subject Matter of the Interference Prior to August 1, 1964:

<u>Originator</u>	<u>Recipient/Distributees</u>	<u>Date</u>	<u>Subject</u>
J. Weigl ①	A. Mahassel - J. Mammino	4/2/70 ✓	Battelle Work on Heavily Doped PVK.
Patent Department	-----	----	Draft Patent Application PVK/TNF.
F. Hoegl	A. W. Karambelas	9/14/72	Meeting attended by A. W. Karambela H. Hoegl, G. Barchietto, B. Dousse, M. Vimi
G. Barchietto	A. W. Karambelas	9/14/72	Meeting attended by A. W. Karambela H. Hoegl, G. Barchietto, B. Dousse, M. Vimi
J. Weigl	A. W. Karambelas	9/5/72	Capsule history of interactions with H. Hoegl (Aug '62 - Sept '64)
J. Mammino ②	J. Weigl	3/26/70 ✓	Invention proposal High Speed Organic Photoconductor Coatings.
Peter H. Kondo	Francis J. Hone - A. A. Mahassel J. J. Ralabate	4/10/70	Transmittal of information and documents.
Patent Department	-----	----	Revised Application Draft PVK/TNF
Patent Department	-----	----	Handwritten notes (10 pages) re: PVK/TNF work
Patent Department	-----	----	Correlation between Mammino work and Fig. 2 of IBM Patent
P. H. Kondo	-----	----	Draft of "Request for Interference."
Patent Department	-----	----	Draft Affidavit.
Patent Department	-----	----	Typed and handwritten notes and question re: PVK-TNF work (2 pages).

Exhibit 7 Annexed to Affidavit of Robert J. Kadel  
IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF NEW YORK

-----x  
SHATTUCK ET AL., :  
Movants, :  
v. : Patent Interference 98,047  
HOEGL ET AL., :  
Respondents. :  
-----x

SUPPLEMENTAL AFFIDAVIT OF CLYDE C. METZGER

STATE OF NEW YORK )  
: ss.:  
COUNTY OF NEW YORK )

CLYDE C. METZGER, being duly sworn, deposes and says:

1. I am a member of the Bar of the State of New York, the Court of Appeals for the Second Circuit, and of the firm of Pennie & Edmonds, 330 Madison Avenue, New York, New York 10017, counsel for Movants, Meredith D. Shattuck and Ulo Vahtra ("Shattuck et al."), in the above-captioned action.

2. On information and belief, the following documents annexed to the Supplemental Memorandum submitted herewith are true and correct copies of the originals thereof:

Exhibit E - Pennie & Edmonds file copy of Hoegl et al. CIP Declaration and Claims (application Serial No. 108,548, filed January 21, 1971).

Exhibit F - Weigl deposition, April 24, 1974, pages 74-77, 80-82, and 109-112.

Exhibit G - Karambelas deposition, April 14, 1974, pages 97, 98, and 106.

Exhibit H - Shattuck et al. Exhibit 27.

*Clyde C. Metzger*  
Clyde C. Metzger

Subscribed and sworn to before  
me this 29th day of April 1974

*Richard S. Liora*  
NOTARY PUBLIC  
No. 412210103 Onondaga County  
Cert. Exp. 12/31/75  
Term Expires 12/31/75



EXHIBIT 8--FIRST PAGE OF A MEMORANDUM OF HOEGL ET AL.  
IN OPPOSITION TO THE SHATTUCK ET AL. REQUEST  
FOR A SHOW CAUSE ORDER ANNEXED TO AFFIDAVIT  
OF ROBERT J. KADEL

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF NEW YORK

----- X  
SHATTUCK ET AL., :  
Movants, :  
v. : Patent Interference 98,047  
HOEGL ET AL., :  
Respondents. :

----- X  
MEMORANDUM OF HOEGL ET AL IN OPPOSITION TO THE  
SHATTUCK ET AL REQUEST FOR A SHOW CAUSE ORDER

I. INTRODUCTION

Shattuck et al seek an order for the production of three documents from the files of Dr. Weigl as to which Hoegl et al claim attorney-client privilege and attorney-work product. As shown herein, production of those documents should not be required because:

- (1) the documents being sought are privileged and also constitute attorney-work product;
- (2) Shattuck et al have not established any basis for a charge of fraud;
- (3) even if the documents were produced they could have no bearing whatsoever on Shattuck's charges of fraud;
- (4) Shattuck et al have already been provided with all of the factual information contained in the documents;
- (5) Shattuck's arguments regarding the content of the documents are based upon misstatements of the facts.

SHATTUCK, ET AL.,

- ۷۸ -

Patent Interference  
No. 98,047

HOEGL, ET AL.,

## Respondents

Wiser, Shaw, Freeman, VanGraafeiland,  
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by Francis J. Hone

Paris, Haskell & Levine  
Washington, D.C.  
and

Anthony W. Karambelas  
Xerox Corporation  
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Harris, Beach & Wilcox  
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Rochester, N.Y. 14614  
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(of counsel)

REC'D	5/9/74
SERIALIZED	
FILED	5/9/74
FBI - MEMPHIS	
COMMUNICATIONS SECTION	
MAY 9 1974	
BY SP-6 JAC/vac	



- 2 -

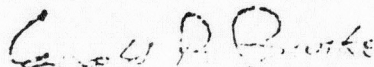
This is a motion by movants, brought on by order to show cause, to compel the witness Weigl and Xerox Corporation to produce documents identified in the moving papers attached to the order to show cause dated April 23, 1974, and compelling Weigl to answer all questions relating to such documents. The documents withheld by Weigl are dated in March and April, 1970, about when IBM commenced commercial production of its IBM Copier machines employing a specific composition coming within the scope of the Shattuck et al patent.

Reference is here made to the order of this court dated March 26, 1974 compelling the witness Weigl to testify and to produce documents, including the documents now withheld, and holding in part, "The movants are entitled to unrestricted access to sources of information bearing on the question of fraud.----". It is essential that Shattuck, et al, have access to the documents to be able to present the facts to the Patent Office regarding the issue of fraud.

The objection of Xerox to the production of the documents on the ground of attorney-client privilege is over-ruled.

- 3 -

IT IS HEREBY ORDERED that the witness Weigl produce the identified documents and answer all questions relating to such documents. If the parties can not agree upon a time and place, I will, on ex parte application of either party, fix the time and place by order.



HAROLD P. BURKE  
United States District Judge

May 7. 1974.



EXHIBIT 10--DECISION BY THE UNITED STATES COURT OF  
APPEALS FOR THE SECOND CIRCUIT DATED  
JULY 16, 1975, DOCKET NO. 74-1767 ANNEXED  
TO AFFIDAVIT OF ROBERT J. KADEL

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

No. 222—September Term, 1974.

(Argued November 25, 1974      Decided July 16, 1975.)

Docket No. 74-1767

MEREDITH D. SHATTUCK and ULO VAHTRA (IBM),

*Movants-Appellees,*

v.

HELMUT HOEGL and GIACOMO BARCHIETTO (XEROX),

*Respondents-Appellants.*

Before:

CLARK, *Associate Justice*,\*  
and MOORE and TIMBERS, *Circuit Judges.*

Appeal from an order entered in the Western District  
of New York, Harold P. Burke, *District Judge*, directing a  
witness to produce certain documents and to testify with  
respect thereto in connection with a Patent Office inter-  
ference proceeding.

Appeal dismissed for lack of appellate jurisdiction.

FRANCIS J. HONE, New York, N.Y. (Brumbaugh,  
Graves, Donohue & Raymond, New York,  
N.Y., on the brief), *for Respondents-Appel-  
lants.*

\* Associate Justice Tom C. Clark, United States Supreme Court, Retired,  
sitting by designation.

JOSEPH G. WALSH, San Jose, California (Clyde C. Metzger, Robert J. Kadel, Sidney R. Bresnick, and Pennie & Edmonds, New York, N.Y., on the brief), for *Movants-Appellees*.

TIMBERS, *Circuit Judge*:

On this appeal from an order entered May 7, 1974 in the Western District of New York, Harold P. Burke, *District Judge*, pursuant to 35 U.S.C. §24 (1970),<sup>1</sup> directing a deposition witness, Dr. John W. Weigl, to produce certain documents and to testify with respect thereto in connection with a Patent Office interference proceeding, we find decisive the threshold question whether the order is appealable as a final decision within the meaning of 28 U.S.C. §1291 (1970).<sup>2</sup>

We hold that the order is not appealable and therefore we dismiss the appeal for lack of appellate jurisdiction.

1 35 U.S.C. §24 (1970) in relevant part provides:

"The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office.

. . .

A judge of a court whose clerk issued a subpoena may enforce obedience to the process or punish disobedience as in other like cases, on proof that a witness, served with such a subpoena, neglected or refused to appear or to testify. . . ."

2 28 U.S.C. §1291 (1970) in relevant part provides:

"The courts of appeals shall have jurisdiction of appeals from all final decisions of the district courts of the United States . . . ."



## I.

The instant discovery proceedings in the district court are ancillary to a patent interference proceeding (Interference No. 98,047),<sup>3</sup> which presently is pending in the United States Patent Office between Meredith D. Shattuck and Ulo Valtra (Shattuck) and Helmut Hoegl and Giacomo Barchietto (Hoegl).

The real parties in interest are International Business Machines Corporation (IBM), assignee of Shattuck U. S. Patent No. 3,484,237, and Xerox Corporation (Xerox), assignee of Hoegl application Serial No. 108,548, filed January 29, 1971. The latter is a continuation-in-part of Hoegl application Serial No. 519,081, filed January 6, 1966. In this opinion, we shall refer to the real parties in interest: IBM (Shattuck) and Xerox (Hoegl).

3 An interference proceeding has been described as follows:

"A patent interference is a statutory administrative proceeding, authorized by 35 U.S.C. §135, to determine which of two or more applicants is the first inventor and, therefore, entitled to a patent. The Board of Patent Interference assumes jurisdiction after the interference is declared by the Patent Examiner. The earliest applicant is awarded the status of senior party and is granted a prima facie date of invention as of the date of his application. All other parties are junior and have the burden of proving a date of actual invention earlier than that of the senior party. After each party files a preliminary statement in which he sets forth the earliest date of invention he intends to claim, the parties are granted a period of time to file motions to clarify or reform the interference prior to trial. The motions are heard by the Patent Examiner who originally declared the interference. The preliminary statements are then exchanged, and the matter returned to the Board of Patent Interferences for trial. The Board then establishes a time schedule within which the parties must present their cases. All evidence must conform to the Patent Office rules. Under those rules, testimony is presented by deposition or oral examination, by affidavit or stipulation. Presentation times are assigned to the various parties based upon the inverse order of filing dates." *In re Natta*, 388 F.2d 215, 216 (3 Cir. 1968), *overruled on other grounds*, *Friette v. Kimberlin*, 508 F.2d 205 (3 Cir. 1974) (en banc), *cert. denied*, — U.S. — (1975).

The patent interference involves IBM's production of copier machines which began in April 1970. In January 1966, Hoegl filed a parent patent application relating in part to a photoconductive composition involved in the copying process. In December 1969, the disputed Shattuck patent also relating to this composition issued to IBM. In January 1971, after learning of the issuance of the Shattuck patent, Xerox filed a continuation-in-part (CIP) application which was accompanied by a declaration of inventorship in which Hoegl and Barchietto claimed to be the first inventors. After institution by the Patent Office on August 16, 1972 of patent interference No. 98,047 between the Shattuck patent and the Hoegl CIP application, Hoegl and Barchietto in November 1972 swore in their preliminary statement in this interference proceeding that they were the first inventors.

IBM initially sought discovery in the Patent Office on various issues relating to the interference, including the possibility of fraud on the Patent Office in connection with Xerox's CIP application and its preliminary statement. The gravamen of IBM's charge was that Xerox attorneys were aware of relevant prior art work by members (Mammino and Salasny) of a technical group directed by Dr. John W. Weigl, an employee of Xerox, when the Xerox attorneys caused Hoegl and Barchietto to make (1) the declaration of inventorship in the CIP application in which they declared that they believed themselves to be the "original, first and joint inventors" of the subject matter thereof, and (2) the preliminary statement in the interference in which they swore that they were the inventors of the subject matter of the interference. If Xerox's attorneys had improperly withheld from the Patent Office evidence of the Weigl group's work, this could constitute fraud and could provide grounds for striking Xerox's preliminary



statement. Priority of invention in that event would be awarded to IBM.

Xerox's position is that the work of the Weigl group was abandoned and therefore did not constitute prior art under 35 U.S.C. §102(g) (1970), there being no duty to disclose to the Patent Office abandoned work which is not prior art.

IBM's motion for discovery under Patent Office Rule 287(c)<sup>4</sup> was essentially denied on December 20, 1973 by the Board of Patent Interferences. In so ruling, the Board stated:

"Turning to the question of possible fraud by Hoegl et al., we do not consider that the showing by Shattuck et al. in support of their motion establishes that the interest of justice requires the ordering of the additional discovery requested. Where, as here, a broad allegation of fraud has been leveled by one of the parties no order for broad discovery will be issued merely to investigate the possibility of the existence of fraud. . . ."

The Board considered the possibility of fraud in the CIP application to be irrelevant to the question of priority of invention at issue in the interference. It did grant discovery to IBM, however, on the question of fraud in the

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<sup>4</sup> Patent Office Rule 287(c), 37 C.F.R. 1.287(c) (1974), provides:

"Upon a motion [Rule 243] brought by a party during the period for preparation for testimony, or thereafter as authorized under [Rule 245], and upon a showing that the interest of justice so requires, the Board of Patent Interferences may order additional discovery as to matters under the control of a party within the scope of the discovery rules of the Federal Rules of Civil Procedure, specifying the terms and conditions of such additional discovery. An order by the Board granting or denying a motion under this paragraph shall not be subject to review prior to a decision awarding priority."

preliminary statement but only to the extent that Xerox did not oppose answering three interrogatories. The Board then added somewhat cryptically:

"It should be further noted in connection with the Shattuck et al. request for the production of witnesses that this Board has no authority to order or force a person to testify on an interference proceeding. Shattuck et al. can, however, call the persons involved as their own witnesses which apparently is what they intend to do."

On February 11, 1974, by a subpoena duces tecum issued pursuant to 35 U.S.C. §24, IBM sought to obtain certain documents from Dr. Weigl (among others) relating to work done before August 1, 1964 which involved the subject matter of the interference and to take his testimony with respect thereto. Dr. Weigl appeared for his deposition. On the advice of the Xerox attorneys, however, he refused to answer any questions of substance propounded by IBM or to produce the subpoenaed documents.

IBM then moved in the district court for an order to compel Dr. Weigl to produce the documents and to testify about them. Xerox opposed the motion on the ground that the district court was without authority to order the relief sought in view of the Patent Office's denial of discovery and on the further ground that the documents sought were not relevant to the interference because any work done by the Weigl group was unrelated to the issue of priority as between Shattuck and Hoegl.

On March 26, 1974, after oral argument and submission of written memoranda, the district court granted IBM's motion. It held that the subpoenaed documents and testimony had a direct bearing on the allegations of fraudu-



lent misconduct on Xerox's part in filing the preliminary statement. The court held that the discovery sought was relevant to the interference because alleged fraud was ancillary to priority of invention and, if established, would provide a basis for striking the preliminary statement. Viewing its order as complementing "patent office jurisdiction in search for the truth", the court stated:

"The movants are entitled to unrestricted access to sources of information bearing on the question of fraud. Weigl is not a party to the interference proceeding. He has no standing to refuse to answer questions asked at the deposition on the ground that they are irrelevant to the interference proceeding."

Xerox did not appeal from this order. The deposition of Weigl was resumed on April 5, 1974. On the advice of the Xerox attorneys, however, Weigl continued to withhold three documents within the scope of the subpoena, claiming that they were attorney-client privileged communications or the work-product of attorneys.

IBM moved in the district court to compel compliance with the court's order of March 26. On May 7, after further oral argument and submission of additional written memoranda, the court overruled Xerox's claim of attorney-client privilege, and directed Weigl to produce the three documents and to answer all questions about them. After quoting from its previous order, the court stated:

"It is essential that Shattuck, et al., have access to the documents to be able to present the facts to the Patent Office regarding the issue of fraud."

Xerox took the instant appeal from the order entered May 7, 1974.

## II.

In ordering disclosure pursuant to Rules 30 and 27, Fed. R. Civ. P., the district court exercised its jurisdiction under 35 U.S.C. §24 which gives ancillary jurisdiction to the district courts to compel attendance of witnesses and production of documents in patent interference proceedings. *Babcock & Wilcox Co. v. Combustion Engineering, Inc.*, 314 F.Supp. 235, 237 (D. Conn.), *aff'd on district court's opinion*, 430 F.2d 1177 (2 Cir. 1968).

Before we may reach the merits of the district court's order, we first must determine the threshold question whether we have jurisdiction to review it. Xerox has taken the instant appeal pursuant to 28 U.S.C. §1291 (1970), asserting that the district court's order is a final decision within the meaning of §1291.<sup>5</sup> We disagree.

It is axiomatic that consideration of the finality of disclosure orders of a district court involves a balancing process. On the one hand, there is the deeply rooted policy against piecemeal review and the obstruction of an ongoing judicial proceeding through such review. If the person against whom such an order is directed insists upon interlocutory review, he may be required to risk a contempt citation and subsequent review of the contempt order rather than to be permitted to appeal the disclosure order itself. See *United States v. Fried*, 386 F.2d 691, 695 (2 Cir. 1967). On the other hand, interlocutory review of a disclosure order may be proper where denial of such review would effectively preclude any review at all of an individual's claim. See *United States v. Nixon*, 418 U.S. 683, 690-92 (1974). Courts also have considered

<sup>5</sup> No application has been made to the district court or to our Court for certification under 28 U.S.C. §1292(b) (1970); nor has a petition for a writ of mandamus been filed pursuant to 28 U.S.C. §1651 (1970). We do not intimate any views as to the propriety of either procedure in this or similar cases.



whether the order is too important to be denied review. Cf. *United States v. Nixon, supra*; *International Business Machines Corp. v. United States*, 471 F.2d 597, 513 (2 Cir. 1972), *rev'd en banc*, 480 F.2d 293 (2 Cir. 1973), *cert. denied*, 416 U.S. 980 (1974).

Orders which have compelled testimony or production of documents generally have been held to be non-final and therefore not appealable. *Alexander v. United States*, 201 U.S. 117 (1906); *Baker v. United States Steel Corp.*, 492 F.2d 1074, 1077-78 (2 Cir. 1974).<sup>6</sup> The rule of non-appealability, however, has been relaxed where the only pending judicial proceeding is the application for disclosure. See *Baker v. United States Steel Corp., supra*, 492 F.2d at 1077; 8 Wright & Miller, *Federal Practice & Procedure* §2006, at 29 (1970) (hereinafter Wright & Miller); 4 Moore's *Federal Practice* ¶26.83[4] (2d ed. 1974) (hereinafter Moore). In the instant case, the motion pursuant to 35 U.S.C. §24 in the district court is the only proceeding in that court although the interference is still pending in the Patent Office.

Professors Wright and Miller state flatly:

"[A]n order of a district court allowing or denying discovery in [a] proceeding ancillary to a patent interference case in the Patent Office is appealable as a final judgment." 8 Wright & Miller §2006, at 3 (Supp. 1974) (footnote omitted).

Professor Moore, however, indicates that the rule is "far from clear". 4 Moore ¶26.83[4], at 26-591 n. 7. We agree with Professor Moore's observation.

<sup>6</sup> It has been suggested that review might be proper where there has been a manifest abuse of discretion. *Atlantic City Elec. Co. v. A. B. Chance Co.*, 313 F.2d 421, 434 (2 Cir. 1963) (*per curiam*), *stay denied*, 83 S.Ct. 964, 10 L.Ed. 2d 122 (Harlan, Circuit Justice, 1963); *Baker v. United States Steel Corp., supra*, 492 F.2d at 1081 (Lumhard, J. dissenting).

Although early cases held such orders to be non-appealable, more recent cases expressly have held them to be appealable or have reviewed the orders without discussing appealability. 9 Moore ¶110.13[2], at 158 & nn. 27-28. For example, our Court dismissed an appeal from an order pursuant to the statutory predecessor to 35 U.S.C. §24,<sup>7</sup> holding the order to be non-final. *Tucker v. Peiler*, 297 F. 570 (2 Cir.), *cert. denied*, 265 U.S. 587 (1924). Accord, *Thomas French & Sons v. International Braid Co.*, 146 F.2d 735 (1 Cir. 1945). More recently, our Court affirmed a similar district court disclosure order without considering the question of appealability. *Babcock & Wilcox Co. v. Combustion Engineering, Inc.*, *supra*.<sup>8</sup>

We are mindful that recent decisions of other circuits have permitted appeals from orders entered pursuant to 35 U.S.C. §24. A brief analysis of their *ratio decidendi* may be appropriate since, on the facts of the instant case, we adhere to our decision in *Tucker v. Peiler*.

As Professor Moore has pointed out, the rationale of the cases allowing appeals from disclosure orders in proceedings ancillary to patent interferences is difficult to discern. 4 Moore ¶26.83[4] n. 6. For example, in *Natta v.*

7 Revised Statutes §4906, derived from Act of July 8, 1870, ch. 230, §45, 16 Stat. 204, as amended by Act of February 18, 1922, ch. 58, §7, 42 Stat. 389, 391-92.

8 Our *Babcock & Wilcox* decision, not being an en banc, may not be viewed as having overruled our earlier decision in *Tucker*. *United States v. Mount*, 438 F.2d 1072, 1074 (9 Cir. 1970) (on petition for rehearing). Moreover, the precedential value of a per curiam exercise of jurisdiction noting an affirmance in open court is at best doubtful where the issue of jurisdiction apparently was not raised but passed *sub silentio*. *Hagans v. Lavine*, 415 U.S. 528, 533 n. 5, at 534-35 (1974); *United States v. More*, 7 U.S. (3 Cranch) 159, 172 (1805) (Marshall, Ch. J.); *United States v. American Society of Composers, Authors and Publishers*, 317 F.2d 90, 93 (2 Cir.), *rev'd on other grounds sub nom. Shenandoah Valley Broadcasting, Inc. v. American Society of Composers, Authors and Publishers*, 375 U.S. 39 (1963) (per curiam).



*Zletz*, 379 F.2d 615 (7 Cir. 1967), the Seventh Circuit held appealable a district court's refusal to order document production by a party to an interference proceeding on the ground that the Patent Office could not order document production much less review the district court's order and therefore the district court's order was final. The Court of Appeals likened the case to one where testimony and document production by a non-party in one jurisdiction for use in another jurisdiction was denied. There was precedent in that circuit for allowing review in such cases. *Carter Products Co. v. Eversharp, Inc.*, 360 F.2d 868 (7 Cir. 1966).<sup>9</sup>

In allowing review in *Natta*, we think that the Seventh Circuit failed to distinguish between the situation of a party, as distinguished from that of a non-party. Such distinction strikes us as crucial. In the *Carter Products* situation, the court to which the appeal in the main action would be taken would have no power to direct production by a non-party outside its jurisdiction; hence no review of such a disclosure order would be possible unless in the ancillary jurisdiction. *Carter Products Co. v. Eversharp, Inc.*, *supra*, 360 F.2d at 871-72; *Baker v. United States Steel Corp.*, *supra*, 492 F.2d at 1078. On the other hand, where disclosure is sought from a party, the court which reviews the main action will always have the requisite jurisdiction to order disclosure. *Republic Gear Co. v. Borg-Warner Corp.*, *supra*, 381 F.2d at 554. Similarly, a court which reviews a Patent Office determination may order production by a party to the interference if it thinks such production is warranted.

This latter view, however, was rejected by the Sixth Circuit in *Ochsner v. Mills*, 382 F.2d 618 (6 Cir. 1967).

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<sup>9</sup> Accord, *Republic Gear Co. v. Borg-Warner Corp.*, 381 F.2d 551 (2 Cir. 1967).

That was an appeal from a district court's refusal to order discovery under 35 U.S.C. §24. The Sixth Circuit referred to the possibility of review of a Patent Office determination as a "legal fiction" because in a review by the Court of Customs and Patent Appeals, pursuant to 35 U.S.C. §141 (1970), no additional evidence can be taken. Moreover, according to the Sixth Circuit, in a civil action in the district court pursuant to 35 U.S.C. §146 (1970), the advantage of taking additional testimony would be counterbalanced by the presumption of administrative correctness. 382 F.2d at 622-23.

We are not persuaded by this rationale. Granted that great weight ordinarily is accorded to findings of the Patent Office, see *Speed Products Co. v. Tinnerman Products, Inc.*, 179 F.2d 778, 780 n. 3 (2 Cir. 1949), that would hardly be required where the Patent Office had ignored an issue or evidence on an issue (in the instant case, fraud) which would vitiate its finding as to priority. It is inconceivable that a district court reviewing a Patent Office determination would not order further disclosure on such an issue if it found that the original denial of disclosure, either by the Patent Office or by a district court in an ancillary proceeding under 35 U.S.C. §24, had prejudiced substantial rights of the other party.

The Tenth Circuit's decision in *Natta v. Hogan*, 392 F.2d 686 (10 Cir. 1968), strikes us as perhaps the best rationale in favor of an immediate appeal. There the district court had granted limited discovery. Both sides appealed. The court raised the issue of appealability sua sponte. Relying on *Cobbledick v. United States*, 309 U.S. 323 (1940), the Tenth Circuit held the order to be appealable.

In *Cobbledick*, the Supreme Court held that a court of appeals had no jurisdiction to review the denial of a motion to quash subpoenas duces tecum directing the petitioners



to appear before a grand jury. The Court distinguished prior cases which had held appealable orders of the district court which has compelled testimony from persons who had refused to testify in an ICC investigation. See *Ellis v. ICC*, 237 U.S. 434 (1915); *Harriman v. ICC*, 211 U.S. 407 (1908); *ICC v. Brimson*, 154 U.S. 447 (1894). The Court reasoned that in those cases the proceedings against the witnesses in the district court had been concluded. Thus, there were no considerations of avoiding piecemeal review which would delay the judicial process:

"[T]here is not, as in the case of a grand jury or trial, any further judicial inquiry which would be halted were the offending witness permitted to appeal. The proceeding before the district court is not ancillary to any judicial proceeding. So far as the court is concerned, it is complete in itself." 309 U.S. at 330.

In *Natta v. Hogan*, the Tenth Circuit reasoned that the rationale of *Cobbledick* was applicable since the appeal would not interfere with any pending judicial proceedings. All proceedings in the district court had terminated.

"In the circumstances presented a party should not be required to risk the hazard of punishment in order to obtain a determination of its rights." 392 F.2d at 689 (footnote omitted).

Other circuits have held orders pursuant to 35 U.S.C. §24 to be appealable with little or no discussion. See *Sheehan v. Doyle*, — F.2d — (1 Cir. 1975) (No. 74-1318, March 31, 1975) (order requiring production of documents); *In re Natta*, 410 F.2d 187, 189 n. 2 (3 Cir.), cert. denied, 396 U.S. 836 (1969) (order denying production of documents); *Gladrow v. Weisz*, 354 F.2d 464 (5 Cir. 1965) (order requiring production of documents).

None of these cases convinces us that we should decline to follow our decision in *Tucker v. Peiler*, especially where, as here, production of documents and testimony of witnesses has been ordered. We thus distinguish the instant case from one where a district court has *denied* production of documents or taking of testimony. In that situation, the district court order may very well be final since, as the Sixth Circuit pointed out in *Oschner*, no other court may ever be in a position to order production. See *Baker v. United States Steel Corp.*, *supra*, 492 F.2d at 1078.

In the instant case, however, disclosure was *ordered*. When such documents and testimony ultimately are presented to the Board of Patent Interferences, Xerox will have ample opportunity under Patent Office Rule 286, 37 C.F.R. §1.286 (1974), to object on evidentiary grounds to their admissibility in those proceedings. Moreover, on review by the Court of Customs and Patent Appeals or by a district court followed by appeal to the federal appellate courts, Xerox will be able to obtain review of any such decision of the Board.

In *Republic Gear Co. v. Borg-Warner Corp.*, *supra*, we recognized the distinction, for appealability purposes, between orders which granted disclosure and those which denied it. There, after noting the necessity for allowing review of orders which denied disclosure by non-parties outside the jurisdiction of the main proceeding, we stated:

“[W]here disclosure is ordered and the order is not complied with, appellate review in subsequent contempt proceedings, however risky—is available to one ordered to disclose who refuses to do so. See *Cobble-dick v. United States*, 309 U.S. at 327, 60 S.Ct. at 542. . . .” 381 F.2d at 554.

If this rationale applies to an ordinary witness, it should apply with even more force to a witness such as Weigl.



Although nominally a non-party to the patent interference, he is an employee of Xerox, one of the real parties in interest. His refusal to testify or produce the documents sought was pursuant to instructions from the Xerox attorneys.

We do not consider this to be an appropriate case for invoking the "collateral order" doctrine of *Cohen v. Beneficial Industrial Loan Corp.*, 337 U.S. 541, 545-47 (1949), to render the district court order final and appealable. The disclosure order is neither "too independent of the cause itself to require that appellate consideration be deferred until the whole case is adjudicated", nor "too important to be denied review".<sup>10</sup> *Id.* at 546. Review will be available and can await either the final judgment of the Patent Office or a contempt adjudication upon Weigl's continued refusal to disclose. *United States v. Fried, supra*, 386 F.2d at 694-95; *American Express Warehousing, Ltd. v. Transamerica Insurance Co.*, 380 F.2d 277, 280-82 (2 Cir. 1967).

While the contempt procedure sanctioned by the Supreme Court in *Cobbledick* and by our Court in *Borg-Warner* has been characterized as "old-fashioned and semi-barbaric", *International Business Machines Corp. v. United States, supra*, 471 F.2d at 511, we have adhered to it in an effort to limit piecemeal review through interlocutory appeals. Cf. *United States v. Fried, supra*, 386 F.2d at 695. Moreover, here Xerox has an alternative route of appeal—through court review of the Patent Office deter-

10 The assertion of claims of attorney work-product and attorney-client privilege does not require relaxation of the final judgment rule. *American Express Warehousing Ltd. v. Transamerica Insurance Co.*, 380 F.2d 277, 280-82 (2 Cir. 1967); cf. *Republic Gear Co. v. Borg-Warner Corp., supra*.

mination. Compare *Cobbledick v. United States*, *supra*, 309 U.S. at 328-29. We decline to add a third route of review.

Appeal dismissed for lack of appellate jurisdiction.

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MOORE, *Circuit Judge*, concurring:

Although I would not disturb Judge Burke's order on appeal, my reasons differ somewhat from those expressed by the majority.<sup>1</sup>

Two professors, learned in the field of federal procedure, have written that "An order of a district court allowing or denying discovery in [a] proceeding ancillary to a patent interference case in the Patent Office is appealable as a final judgment." 8 Wright & Miller, *Federal Practice & Procedure* §2006, at 3 (Supp. 1974).

This is a patent interference case in the Patent Office and this proceeding in the United States District Court for the Western District of New York is ancillary thereto. The conditions mentioned have been met. The authors declare that it makes no difference whether the order grants or denies discovery. At first blush there might be some basis for a distinction but upon analysis the blush quickly fades. Denial forecloses the party seeking production from placing before the Patent Office or a court such evidence of fraud as the documents might disclose; granting will reveal that which it is contended should be concealed. In choosing between these alternatives it is probably better to lean towards disclosure. If the documents disclose fraud the truth should be revealed; if no fraud is disclosed, Xerox should not be harmed. If the nature of the docu-

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<sup>1</sup> Specifically, I cannot subscribe to the majority's prophecy of what the Board will do with respect to the "priority of invention" issue. Nor do I accept any *en banc* requirement in this Circuit for not following a 51-year old decision, *Tucker v. Peiler*, 297 Fed. 570 (2d Cir., 1924), if applicable.



ments is so confidential that Xerox feels that they should not be disclosed, the merits of this question, not presently before us, can be tested in future proceedings. What effect, if any, the Board will give to whatever may be in the documents is for their determination. If fraud be irrelevant to a decision as to priority of invention, this issue is for the Patent Office—not for us. Therefore, on balance, despite my dislike for the “old-fashioned and semi-barbaric” contempt procedure, I view that procedure as the best present means of disclosing the truth and protecting each of the parties. Evolutionary process in certain procedural phases of the law is slow. Possibly our lawmakers or even the courts will find a better solution eventually.

The documents in question, apparently not having been produced even for *in camera* inspection by the trial judge, were not made the subject of any ruling as to the confidential content thereof. They are not before us on appeal. Therefore it remains for some other court on some other occasion to pass upon this issue. It is enough at this juncture and on these specific facts to decide whether the order of the district court should be affirmed and I would so hold.

EXHIBIT 11--LETTER FROM MR. KADEL TO MR. HONE  
DATED NOVEMBER 6, 1975 ANNEXED TO  
AFFIDAVIT OF ROBERT J. KADEL

PENNIE & EDMONDS

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KEITH E. MULLENOER

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DAVID WEIGL, III  
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WASHINGTON OFFICE  
PENNSYLVANIA BUILDING  
WASHINGTON, D.C. 20004

November 6, 1975

20,088.4

Francis J. Hone, Esq.  
Brumbaugh, Graves, Donohue & Raymond  
30 Rockefeller Plaza  
New York, New York 10020

Re: Shattuck et al. v. Hoegl et al.  
Interference No. 98,047

Dear Frank:

I have your letter dated November 4, 1975 enclosing copies of the documents specified in Shattuck et al. Exhibit 26, as ordered to be produced by the District Court on May 7, 1974. You did not, however, enclose copies of the Karambalas documents listed in Shattuck et al. Exhibit 27.

As I pointed out in my letter dated July 24, 1975, when we applied to the Court on April 23, 1974 for the order in connection with Dr. Weigl's allegedly privileged documents, Mr. Karambalas agreed, in a telephone conversation with Mr. Metzger and myself, that any Court ruling as to the withheld Weigl documents of Exhibit 26 would be applicable to his withheld documents of Exhibit 27. We all sought to avoid unnecessarily burdening the Court since the same legal and factual issues were involved with respect to both Weigl's withheld documents and Karambalas's withheld documents.

Accordingly, would you kindly advise us of a convenient date when we could conclude the depositions of Dr. Weigl, Mr. Karambalas, and Mr. Kondo. As I stated in my letter of October 21, 1975, Dr. Walsh has previously had to make numerous trips from California to Rochester on this matter and it would therefore be highly desirable if the above depositions could all be concluded at one time in Rochester with all the subpoenaed documents on hand.



Francis J. Hone, Esq.

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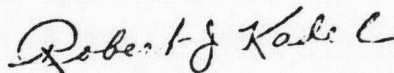
November 6, 1975

In this connection, I wish to point out that the depositions of Dr. Weigl, Mr. Karambalas, and Mr. Kondo were all suspended pending a resolution by the Court of the legal issues involved regarding your withholding of documents on the grounds of attorney-client privilege and attorney work product. With respect to Mr. Karambalas's deposition, for example, you acknowledged that his deposition was in fact suspended if "the judge actually does provide access to any of the documents that are in this list as Exhibit 27" (Karambalas deposition transcript, April 24, 1974, p.109).

Since Judge Burke has now provided access to two of the documents on that list (Documents 1a and 1c of Exhibit 26 correspond to Documents 6 and 1 of Exhibit 27), and since Mr. Karambalas agreed to produce his documents if the Court ordered the Weigl documents produced, we would want to have all the subpoenaed documents (Documents 1-13 of Exhibit 27) when we resume the depositions of Dr. Weigl and Messrs. Karambalas and Kondo in Rochester.

In summary, therefore, it would certainly appear desirable to avoid the necessity of burdening the Court again on this matter, particularly in view of (i) our understanding with Mr. Karambalas that any Court ruling as to the documents of Exhibit 26 would be applicable to the documents of Exhibit 27, (ii) the Court's order of May 7, 1974 stating that Shattuck et al. are "entitled to unrestricted access to sources of information bearing on the question of fraud", and (iii) the opinion of the Second Circuit Court of Appeals dismissing Hoegl et al.'s appeal.

Very truly yours,



Robert J. Kadel

EXHIBIT 12--LETTER FROM MR. HONE TO MR. KADEL  
DATED NOVEMBER 14, 1975 ANNEXED TO  
AFFIDAVIT OF ROBERT J. KADEL

BRUMBAUGH, GRAVES, DONOHUE & RAYMOND  
30 ROCKEFELLER PLAZA  
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FREDERICK C. CARVER  
GEORGE W. WHITNEY  
ALLEN G. WEISE

FRANCIS J. HONE  
WILLIAM F. EBERLE  
JOSEPH D. GARON  
ARTHUR S. TENSER  
DONALD S. DOWDEN  
RONALD B. HILDRETH  
ALLAN H. BONNELL  
GRANVILLE M. BRUMBAUGH, JR.  
THOMAS R. NESBITT, JR.  
ROBERT NEUNER  
RICHARD G. BERKLEY

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RICHARD S. CLARK  
THOMAS D. MACBLAIN  
BRADLEY B. GEIST  
PETER D. MURRAY  
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WILLIAM E. PELTON  
MELVIN C. GARNER  
RALPH W. SELITTO, JR.  
WILLIAM R. EVANS  
LEIGHTON K. M. CHONG  
JAMES R. NELSON  
RICHARD C. KOMSON

November 14, 1975

Robert J. Kadel, Esq.  
Pennie & Edmonds  
330 Madison Avenue  
New York, New York 10017

Re: Shattuck et al v. Hoegl et al  
Interference No. 98,047

Dear Bob:

This will acknowledge your letter of November 6, 1975, regarding the above-identified matter.

As you know, the privileged documents in the Karambelas file were not the subject of Judge Burke's Order appealed to the Second Circuit and, consequently, dismissal of the appeal does not require production of those documents. Contrary to your assertion, moreover, Mr. Karambelas never agreed to produce any of the Karambelas privileged documents in the event of a court ruling requiring production of privileged documents from the Weigl files.

As stated in the deposition transcripts, the Kondo and Karambelas depositions were terminated. Judge Burke did not order access to any documents from the Karambelas files and the fact that copies of certain of those documents were made available from the Weigl files by the Court does not constitute production of the same documents from the Karambelas files. If you believe you are entitled to further testimony from Messrs. Kondo and Karambelas, you can, of course, notice their deposition again.

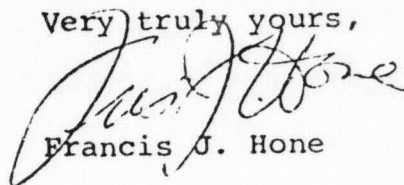


Robert J. Kadel, F 7.

-2-

If you wish to continue Dr. Weigl's deposition, I suggest that you propose several alternate dates for resumption and I will determine his availability.

Very truly yours,

A handwritten signature in cursive script, appearing to read "Francis J. Hone".

Francis J. Hone

EXHIBIT 13--TRANSCRIPT OF DEPOSITION TESTIMONY OF  
ANTHONY W. KARAMBELAS TAKEN APRIL 24,  
1974, PAGES 109 AND 110 ANNEXED TO  
AFFIDAVIT OF ROBERT J. KADEL

ANTHONY W. KARAMBELAS 109

possibility that this work could have been done  
in Switzerland by Hoegl and Barchietto.

MR. HDNE: I have no knowledge of the  
basis on which that date was selected; you are  
the one that selected it, Mr. Walsh.

MR. WALSH: Well, I think it's perfectly  
obvious that we have now reached the same stage  
we reached after the first deposition -- or  
maybe it was the second -- I forget -- the  
deposition taking session with Dr. Weigle.  
We will obviously have to have a resolution of  
this claim of privilege. I find it impossible  
to proceed with meaningful examination with the  
present objections being made, so once again I  
will have to suspend the deposition and I am  
afraid we will have to request the judge again  
to decide the issue.

MR. HOME: Well, I don't agree the deposition  
is only suspended. In my view it's terminated  
unless the judge actually does provide access  
to any of the documents that are in this list  
as Exhibit 27.

MR. WALSH: You can characterize it your



ANTHONY W. KAL BELAS

110

1 way, I will characterize it my way. The judge  
2 will reach a decision. That completes the  
3 record for today.

4 MR. HONE: I have no cross-examination.  
5 (Whereupon the deposition of Anthony W. Karambelas was  
6 concluded for this date.)  
7

8 \* \* \*

EXHIBIT 14--TRANSCRIPT OF DEPOSITION TESTIMONY OF  
PETER KONDO TAKEN FEBRUARY 21, 1974,  
PAGES 62 AND 63 ANNEXED TO AFFIDAVIT  
OF ROBERT J. KADEL

(Peter Kando)

62

1 DQ174. You are still not sure?

2 A. Right.

3 DQ175. Is there substantial doubt in your mind? I am  
4 amazed.

5 MR. HONE: Mr. Walsh, will you  
6 stop harassing the witness.

7 MR. WALSH: The witness isn't  
8 harassed. He's smiling and so am I.

9 MR. HONE: It's possible he was  
10 there at an early age and didn't know about it.

11 MR. WALSH: I really don't want  
12 to waste anymore time on this point. It is entirely  
13 possible that I may have finished my examination  
14 of Mr. Kando but for the time being. But before  
15 that I would like to confer for a few minutes with  
16 Mr. Kadel if you have no objection.

17 MR. HONE: Please do.

18 MR. WALSH: I have no further  
19 questions at this time for Mr. Kando. However,  
20 I will not terminate this deposition, rather, I  
21 will suspend it indefinitely and you will remain  
22 under subpoena and under oath.

23 MR. HONE: We don't necessarily



(Anthony W. Karambelas)

63

1 agree that the deposition is only suspended and  
2 not terminated. We will meet that issue at the  
3 time that any further attempt to examine Mr. Kando  
4 occurs. We have no questions on cross-examination.  
5

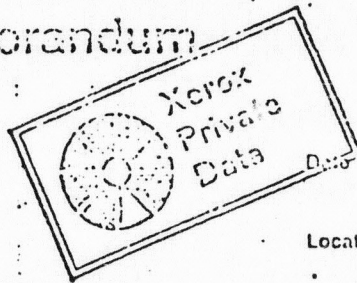
EXHIBIT 15--COPY OF MEMORANDUM FROM MR. WEIGL TO MR. MAHASSEL DATED APRIL 2, 1970, ENTITLED "INVENTION RECORD: HIGH SPEED ORGANIC PHOTOCONDUCTOR COATINGS (J. MAMMINO)" ANNEXED TO AFFIDAVIT OF ROBERT J. KADEL

XEROX Inter-Office Memorandum

To A. Mahassel  
 From J. W. Weigl  
 Subject Invention Record: High Speed Organic Photoconductor Coatings (J. Mammino)

Location W-130  
 Organization IPAT

4/2/70



Al, as you may recall, I called Jim Ralabate by telephone on March 11, 1970 to alert him to the fact that a recently issued IBM patent (Shattuck et al., U.S. 3,484,237) discloses and claims an organic photoconductor composition on which we did some early work. In this conversation, and in a subsequent detailed discussion with yourself at Xerox Square on March 12, 1970, I pointed out that Joe Mammino and Gail Jvirblis have ample notebook records of our concept and successful reductions to practice, dating back to 1963-4, and published a Xerox internal research report in August 1964, describing this work. Our dates for both concept and reduction to practice thus antedate the Shattuck filing date (June 13, 1966) by at least two years, and we thus appear to have a basis for provoking an interference with IBM.

I enclose with this memo, an invention record describing this concept and a copy of pertinent pages of the 1964 internal report in which the results are tabulated, (pp. 19-20) and in which specific uses are suggested for highly sensitized PVK (pp. 36-7). As soon as Joe returns from vacation we'll send you xeroopies of pertinent notebook pages.

Please note that the graph of data from Table III, RL64-45, has an abscissa based on weight percent of total composition, while Shattuck et al. express their concentrations in parts by weight of TNF relative to 100 parts by weight of PVK. The limits of their claimed composition are 0.49 to 1.23 moles TNF per mole carbazole:

parts TNF per 100 parts PVK (Shattuck notation)	wt percent TNF per 100 parts composition (Mammino notation)	moles TNF per mole carbazole units
80	44.5	0.49
163	62.0	1.0
200	66.7	1.23

(M.W.: 315 for TNF, 193 per PVK unit)

You will note that Joe's work covers the entire composition range claimed by Shattuck et al., and that his results, like theirs, indicate the highest photosensitivity to lie at about 1:1 mole ratio when negative charge is used.

Please let me know if we can be of assistance to you in evaluating and protecting this invention.

Best wishes.

XEROX CONFIDENTIAL

*John*

JW/bw

Enclosures: Invention Proposal, pertinent pages from report RL64-45 (August 1964)

cc: J. Mammino D.L. Stockman  
 A.G. Sweet J.J. Ralabate  
 W.W. Tyler

100 - PVK 100 - TNF  
 100 - PVK 100 - TNF



A 125

EXHIBIT 16--COPY OF MEMORANDUM FROM MR. WEIGL TO MR.  
MAHASSEL DATED APRIL 2, 1970, ENTITLED  
"BATELLE WORK ON HEAVILY DOPED PVK"  
ANNEXED TO AFFIDAVIT OF ROBERT J. KADEL

Inter-Office Memorandum

BEST COPY AVAILABLE

1-6

To	A. Mahassel	Date	4/2/70
From	J. W. Weigl	Location	W-130
Subject	Battelle Work on Heavily Doped PVK	Organization	IMAT

As you may know, the original discoverer of the use of acceptor-sensitized PVK and related aromatic polymers as photoconductors was Dr. Helmut Hoegl, who worked at Kalle & Co. during the 50's when his invention was made. About 1960 he went to Battelle (Geneva) to become head of their Chemistry Department, and he is still there in this capacity.

During 1962-5, Dr. Hoegl ran a research project at BNL (G), sponsored by Xerox Corporation and co-monitored by Erik Pell and myself. Although this project did not produce very much, either by way of scientific understanding or by way of technical innovation, it did lead to a few Xerox patent applications (notably D/1606 on DTF, a very effective charge transfer sensitizer) and a series of reports, which you may wish to peruse some day.

Two reports contain material which indirectly confirms and extends Joe Mammino's earlier findings on highly TNF-doped PVK:

Comprehensive Progress Report #6 (March 1965), (p. 18, Table 5, Figs. 14 and 16) shows data on the high photosensitivity of PVK:TNF (1:1), and shows that some improvement can be obtained in dark charge retention by overcoating the photoconductor with a thin glow-discharge polymer layer.

Their report, "Photoinduced Discharge Characteristics and Absorption Spectra of Pure and Doped Poly-n-vinyl Carbazole Films" (issued February 1966) (p. 29, Fig. 16) shows the effect of acceptor concentration on photosensitivity for a few other acceptors related to TNF - notably DTF and TENF (tetranitrofluorenone).

Copies of relevant pages are enclosed. You should have copies of the entire reports available in the Patent Department library; if you cannot locate them, additional copies should be available from the Webster 105 library, or, if necessary, from my files.

This work was carried out in coordination with Joe Mammino's work in my own group, and subsequent to the publication of Joe's report (RL64-45) on acceptor sensitization. Joe and Helmut Hoegl were kept in touch with each other's work, and Hoegl's reports could, I believe, therefore be used to extend and corroborate Mammino's discovery.

Please let me know if I can be of further assistance. Best wishes.

JWW/bw  
Enclosures  
cc: J. Mammino

enc. 9/11/70

*John*  
RECEIVED COMMUNICATIONS

1 fresh the witness' recollection. That  
2 is all I am trying to do.

3 MR. HONE: I do not think this  
4 is relevant to this proceeding.

5 A. I cannot, at this time. remember which of these two  
6 activities might have been involved. They were both  
7 nearly contemporaneous.

8 DQ73 Do you believe it was in connection with these events,  
9 though?

10 A. I guess, I don't really know precisely what use was  
11 made nor do I find any records in my file of this  
12 phone call. It was -- I have no details on it.

13 DQ74 Have you attempted to examine the records of the  
14 telephone company in regard to this call?

15 A. No, sir.

16 DQ75 Was there any correspondence between you and Dr.  
17 Hoegl in regard to this work done by Xerox in 1963,  
18 in the United States?

19 A. I believe I have told you before that, to the very  
20 best of my knowledge and belief, the results of this  
21 work at Xerox which was done early -- in late 1963  
22 and early 1964, was not communicated to Dr. Hoegl.  
23 I affirm that once again.



1 DQ76 Mr. Hone has stated that certain privileged docu-  
2 ments have not been brought here. Do you have any  
3 knowledge about these privileged documents? Have  
4 you examined them?

5 MR. HONE: Well, I think that  
6 calls for Dr. Weigl to understand what  
7 I meant when I said, "privileged  
8 documents", but I will let Dr. Weigl  
9 speak as to the knowledge he may have  
10 of documents that I have mentioned to  
11 him that may be privileged and only  
12 insofar as the time of those documents  
13 or the recipients of those documents  
14 or the originators of those documents  
15 are concerned, if he clearly recalls.

16 THE WITNESS: Would you re-  
17 state the question, please?

18 DQ77 Do you have any knowledge concerning the documents  
19 characterized by Mr. Hone as privileged which he has  
20 not brought here?

21 A. I know of one set of such documents.

22 DQ78 Have you read these documents?

23 A. This set, yes.

1 DQ79 When?

2 A. When they were first originated. Most recently,  
3 the last day or so, specifically, this morning, I  
4 just looked at them again.

5 MR. WALSH: Mr. Hone, I think  
6 we are probably going to ask that those  
7 documents you have characterized as  
8 privileged be produced and it is rather  
9 hard for us to do so if we have no way  
10 of characterizing them as to sender,  
11 receiver, recipients of copies or dates.  
12 I would ask you if you would consider  
13 bringing them here this afternoon and  
14 bringing a list characterizing the  
15 receivers, the senders, the dates, the  
16 recipients of copies?

17 MR. HONE: I will do so. I  
18 could tell you that, generally, what  
19 the dates are right now. They are in  
20 the early 1970 period and I could get  
21 a list by this afternoon.

22 MR. WALSH: Thank you. Could  
23 you bring the documents themselves here



AFFIDAVIT OF FRANCIS J. HONE WITH ANNEXED EXHIBITS A-D FILED  
IN SUPPORT OF HOEGL ET AL.'S OPPOSITION TO SHATTUCK ET AL.'S  
MOTION TO COMPEL UNDER RULE 37 F.R.CIV.P.

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF NEW YORK

-----x  
SHATTUCK ET AL,  
:  
Movants,  
:  
v. Re: Patent Interference  
No. 98,047  
:  
HOEGL ET AL,  
:  
Respondents.  
-----x

AFFIDAVIT OF FRANCIS J. HONE

STATE OF NEW YORK )  
: ss.  
COUNTY OF NEW YORK)

FRANCIS J. HONE being duly sworn deposes as follows:

1. I am an attorney at law and a member of the firm  
Brumbaugh, Graves, Donohue & Raymond, 30 Rockefeller Plaza,  
New York, New York 10020, attorneys for Hoegl et al in the  
above-captioned matter.

2. I am also attorney for Xerox Corporation in  
connection with this proceeding to compel disclosure of its  
privileged and work product information through document pro-  
duction and testimony of its employees. I am familiar with  
all of the proceedings relating to this matter.

3. Appended hereto as Exhibit A are copies of  
Pages 61-63 of the Weigl deposition taken April 24, 1975. The  
list of privileged and work product documents which are the  
subject of this motion was prepared and produced to Shattuck

et al on that day. There was no prior discussion of these documents with counsel for Shattuck et al.

4. Appended hereto as Exhibit B are copies of Pages 4, 5, 20 and 21 of the transcript of the oral argument before this Court on April 30, 1975 regarding the Exhibit 26 privileged documents. Although fully advised about the Exhibit 27 documents and the claim of privilege and work product with respect to them, Shattuck et al made no request for production of those documents at that time, thereby acquiescing in the privilege and work product claims.

5. Following final disposition on November 4, 1975 of the appeal to the Second Circuit Court of Appeals from this Court's Order dated May 7, 1974, Mr. Kadel, counsel for Shattuck et al inquired about production of the privileged and work product documents from the files of Anthony W. Karambelas, identified in Shattuck et al Exhibit 27. Since Shattuck et al had acquiesced in the claims of privilege and work product made in April 1974 with respect to those documents and since the response to the subpoenas served on Mr. Karambelas and Mr. Kondo in February 1974 had been completed, there was no reason for production of the Exhibit 27 documents. That position was set forth in my letter dated November 14, 1975 to Robert J. Kadel, a copy of which is appended hereto as Exhibit C.

6. Following service and filing of this Shattuck et al motion to compel, Hoegl et al offered to waive its priv-



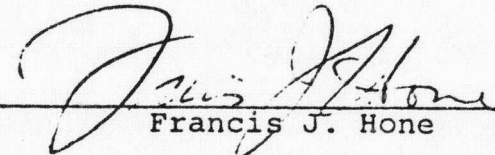
## Affidavit of Francis J. Hone

ilege and work product claims as to the subpoenaed information contained in the documents of Shattuck et al Exhibit 27, to produce Messrs. Weigl, Kondo and Karambelas for further depositions voluntarily, to permit those witnesses to testify concerning matters relevant to the interference, and to disclose to the attorneys for Shattuck et al the unsubpoenaed information in those documents, providing only that:

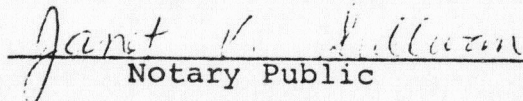
a. Shattuck et al agree that such production did not constitute a waiver of the privilege and work product protection as to unsubpoenaed information; and

b. The requirements of the Statute and Rules be followed with respect to information not within the scope of the subpoenas served in February 1974.

This offer was rejected by Mr. Kadel on behalf of Shattuck et al. A summary of the events surrounding this offer by Xerox is contained in my letter dated December 11, 1975, a copy of which is appended hereto as Exhibit D.

  
Francis J. Hone

Sworn to and subscribed before me this 19 day of December 1975.

  
Notary Public

JANET V. SULLIVAN  
Notary Public, State of New York  
No. 52-4615940  
Qualified in Suffolk County  
Certificate Filed in New York County  
Commission Expires March 30, 1977

MR. HONE:

Before you start questioning,

I want to say something. I have two comments, Mr. Walsh. First, as I told you on the phone yesterday afternoon, after I arrived here I found that an Order to Show Cause had been made returnable on Friday at ten o'clock in Judge Burke's courtroom and I advised you that I would be unable to appear and I would request a postponement of the hearing on that order, and you advised me that while you would not stipulate to a postponement you would not object if I asked for a postponement until next Tuesday. Accordingly, I called Judge Burke's chambers this morning and advised Judge Burke's secretary of that. And after Judge Burke arrived his secretary called me back and said that Judge Burke had agreed to postpone the hearing on the Order to Show Cause until next Tuesday at ten o'clock.

The second matter I have is that about two weeks ago you discussed, or someone discussed with Mr. Karambelas, production of



1 documents from the Xerox files relating to  
2 this Interference, and as a result of that  
3 question, but without conceding that I.B.M.  
4 is entitled to it, a search has been made  
5 of the Xerox files relating to Interference  
6 Number 98047 to find any documents relating  
7 to work done in connection with the subject  
8 matter of this Interference prior to August 1,  
9 1964, which documents were prepared on or  
10 before November 7, 1972.

11 I am handing you herewith a list of the  
12 privileged or work product documents which  
13 appear in that file. The only other docu-  
14 ments relating to the subject matter of the  
15 Interference are documents which you already  
16 have copies that have been produced either  
17 in connection with Dr. Weigle's subpoena or  
18 in connection with prior motions in the  
19 Interference.

20 MR. WALSH: Do you mind if we go off  
21 the record for a few minutes?

22 MR. HONE: Not at all.

23 (Discussion off the record)

1 MR. WALSH: Can we go on the record now?

2 MR. HONE: Very well.

3 MR. WALSH: I would like to have marked  
4 for identification as Shattuck, et al Exhibit  
5 "27", the page you just handed me, and I'd  
6 also move that it be entered in evidence.

7 (Whereupon, the Reporter marked for identification  
8 Shattuck, et al Exhibit "27")

9 MR. HONE: I object to the introduction  
10 of this document in evidence, in view of the  
11 absence of any relevance to the subject  
12 matter of the Interference.

13 MR. WALSH: Let the record show your  
14 objection. Dr. Weigle has been sworn.

15 D R. J O H N W. W E I G L E, called herein as a witness,  
16 having been previously sworn, testified as follows:

17 EXAMINATION BY MR. WALSH:

18 DQ110. Dr. Weigle, I'll call your attention to the docu-  
19 ment you handed to me during the previous session  
20 of your deposition. These are the documents which  
21 were produced pursuant to the subpoena duces tecum  
22 served upon you, is that correct?

23 MR. HONE: I stated that at the previous



a proposed patent application was prepared. A revised draft of a patent application was prepared but the application was not filed. Instead, with full knowledge of Mr. Mammino's prior work which they never called to the attention of the Patent Office and about which the Patent Office would never have known had it not been for your Honor's order and they proceeded to change drastically the apparent application of Hoegl and Barchietto. Their filing of the Continuation-In-Part application was done with knowledge on the part of the Xerox attorneys, the prior work of Mr. Mammino in Dr. Weigl's group.

It is possible that by a logical deduction we can prove that at the time they signed this preliminary statement in November of 1972, Dr. Hoegl and Dr. Barchietto also must have known of this work. Some of the additional documents being wheeled under the alleged claim of privilege by the Party Hoegl et al include

on Exhibit 27 Document No. 3 and 4. These are letters written respectively by Hoegl and Barchietto and these letters were written on September 14, 1972. And these documents specifically refer to work done by Mammino in the United States before the alleged conception date that they swore to in their Preliminary Statement.

We submit, your Honor, that we have proved a prima facie case of fraud on the Patent Office and for this reason the attorney-client privilege, if it does in fact exist, and we don't admit it existed in regard to many of these documents, should be stricken. Specifically we ask only for a very narrowly defined range of documents. We ask only for documents written before the date of the Preliminary Statement which was November, 1972 and not only must the documents be written before that date but they must refer specifically to work done in the United



there was no recognition on the part of Mammino of the value of his work. I submit this is clearly erroneous. The man submitted a request for a patent application to the Patent Department. Two drafts of such an application were prepared. Those drafts are part of the documents we seek to obtain. Obviously, they are very, very pertinent, very informative.

On one point, I might almost agree with Mr. Hone. We really don't need them because I think we have already proved fraud. But obviously we can never have too much proof, so to have even more proof, I request these documents.

In Exhibit 27 handed to your Honor today you will see a list of documents which they allege are privileged. I call your particular attention again to Item NO. 3 and 4, memoranda written on September 14, 1972, one by Hoegl, one by Barchietto. These documents specifi-

cally refer to the prior work of Mammino, otherwise they wouldn't have been listed there. That was a list of documents which do refer to that work. Obviously if the men write memoranda referring to the work they must have known about it. These memoranda were written before they signed their Preliminary Statement. They were written before they signed their substitute declaration in March, 1973. That March, 1973 supplemental declaration specifically said they are the first inventor.

Mr. Hone seems to be basing some defense on the fact that the specific words "first inventor" aren't in the Preliminary Statement. For whatever comfort he can get from it, let him have it but they are in the substitute declaration which was signed.

I also further submit, your Honor, that the fraud here was committed by the Xerox Patent Department. With knowledge of their work on which the men



EXHIBIT C--LETTER DATED NOVEMBER 14, 1975 TO MR.  
KADEL FROM MR. HONE ANNEXED TO AFFIDA-  
VIT OF FRANCIS J. HONE

BRUMBAUGH, GRAVES, DONOHUE & RAYMOND  
30 ROCKEFELLER PLAZA  
NEW YORK, N. Y. 10020

TELEPHONE 212 489-3300  
CABLE CAMBAUFREE  
TELEX 423148

GRANVILLE M. BRUMBAUGH  
JEN M. GRAVES  
FRANCIS J. DONOHUE  
JAMES E. DUMAPESQ  
JAMES M. RAYMOND  
JAMES W. BRUMBAUGH  
HARD G. FULLER, JR.  
JESSE H. BUCANER  
HAROLD W. FORD, JR.  
DERICK C. CARVER  
JEROME W. WHITNEY  
KEN G. WEISE

FRANCIS J. HONE  
WILLIAM F. EBERLE  
JOSEPH D. GARON  
ARTHUR S. TENSER  
DONALD S. DOWDEN  
RONALD B. HILDRETH  
ALLAN M. BONNELL  
GRANVILLE M. BRUMBAUGH, JR.  
THOMAS R. NESBITT, JR.  
ROBERT NEUNER  
RICHARD G. BERALEY

HARD V. FILARDI  
HARD S. CLARK  
HAS D. MACBLAIN  
OLEY B. GEIST  
ED MURRAY  
L.F. HILDE, JR.  
H.M. NEARY  
SELL M. FALCONER

WILLIAM E. PELTON  
MELVIN C. GARNER  
RALPH W. SELITTO, JR.  
WILLIAM R. EVANS  
LEIGHTON R. M. CHONG  
JAMES R. NELSON  
RICHARD C. KOMSON

November 14, 1975

Robert J. Kadel, Esq.  
Pennie & Edmonds  
330 Madison Avenue  
New York, New York 10017

Re: Shattuck et al v. Hoegl et al  
Interference No. 98,047

Dear Bob:

This will acknowledge your letter of November 6, 1975, regarding the above-identified matter.

As you know, the privileged documents in the Karambelas file were not the subject of Judge Burke's Order appealed to the Second Circuit and, consequently, dismissal of the appeal does not require production of those documents. Contrary to your assertion, moreover, Mr. Karambelas never agreed to produce any of the Karambelas privileged documents in the event of a court ruling requiring production of privileged documents from the Weigl files.

As stated in the deposition transcripts, the Kondo and Karambelas depositions were terminated. Judge Burke did not order access to any documents from the Karambelas files and the fact that copies of certain of those documents were made available from the Weigl files by the Court does not constitute production of the same documents from the Karambelas files. If you believe you are entitled to further testimony from Messrs. Kondo and Karambelas, you can, of course, notice their deposition again.

A 140

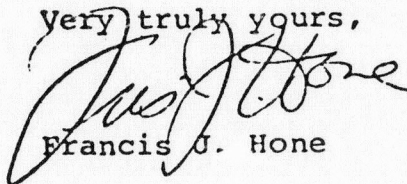
*Exhibit C Annexed to Affidavit of Francis J. Hone*

Robert J. Kade, Esq.

-2-

If you wish to continue Dr. Weigl's deposition, I suggest that you propose several alternate dates for resumption and I will determine his availability.

Very truly yours,

A handwritten signature in cursive script, appearing to read "Francis J. Hone", written in dark ink.

Francis J. Hone

bcc: Donald C. Kolasch, Esq.  
(with copy of Mr. Kadel's letter)



A 141

EXHIBIT D--LETTER DATED DECEMBER 11, 1975 TO MR.  
KADEL FROM MR. HONE ANNEXED TO AFFIDA-  
VIT OF FRANCIS J. HONE

BRUMBLUGH, GRAVES, DONOHUE & RAYMOND  
30 ROCKEFELLER PLAZA  
NEW YORK, N. Y. 10020

TELEPHONE 212 480-3300  
CARLE CAMBRUFREE  
TELEX 423148

FRANCIS J. HONE  
WILLIAM F. EBERLE  
JOSEPH D. CARON  
ARTHUR S. TENSER  
DONALD S. DOWDEN  
RONALD B. HILBRETH  
ALLAN H. BONNELL  
GRANVILLE M. BRUMBAUGH, JR.  
THOMAS R. NESBITT, JR.  
ROBERT NEUMER  
RICHARD G. REHALEY

JOHN M. HEARY  
RUSSELL M. FALCONER  
WILLIAM E. PELTON  
SANFORD J. ASHMAN  
HELVIN C. CARNER  
RALPH W. SELITTO, JR.

December 11, 1975

Robert J. Kadel, Esq.  
Pennie & Edmonds  
330 Madison Avenue  
New York, New York 10017

Re: Shattuck et al v. Hoegl et al  
Interference No. 98,047

Dear Bob:

This will summarize my discussions with you during the last few days in which I sought an amicable settlement of the issues raised by Shattuck et al's motion to compel production of documents.

Although we do not agree that Shattuck et al are entitled to the Karambelas privileged documents referred to in the motion, on Monday I offered to produce them to Shattuck et al, masking out only those portions which have no relation to the subject matter of the subpoena which was served on Mr. Karambelas. At that time, you stated that you would not accept our representation that the masked portions relate to matters outside the scope of the subpoena and asked to inspect the masked portions in order to verify that the masking would be appropriate. Yesterday I agreed to let you and Mr. Metzger review the masked portions of the privileged documents for that purpose.

With respect to depositions, I offered to make Dr. Weigl and Mr. Kondo available in Rochester for the continuation of their depositions without restriction, although I pointed out to you that the Kondo deposition taken February

Robert J. Kadel, Esq.

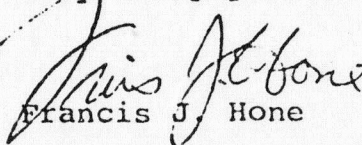
-2-

21, 1974 was terminated at that time. Despite the fact that the Karambelas deposition was also terminated April 24, 1974, I offered to permit a voluntary continuation of that deposition in California where Mr. Karambelas now resides with respect to the subject matter of the privileged documents from the Karambelas files which we had offered to produce.

You advised me today that Shattuck et al will not accept the privileged documents in masked form, even if you and Mr. Metzger are permitted to review the masked portions and would proceed with the motion even if the documents were produced.

Shattuck et al's intention to proceed with this motion, even though we offered to comply with all of the proper requests made in the motion, illustrates the overreaching attitude of Shattuck et al in seeking discovery which is unjustified and based on false and unfounded accusations of fraud. In the circumstances, I see no point in continuing our attempt to settle the matter on an amicable basis.

Very truly yours,

  
Francis J. Hone

cc: Joseph G. Walsh, Esq.

cc: Donald C. Kolasch, Esq.  
Peter P. Eichler, Esq.



AFFIDAVIT OF BORIS HASKELL FILED IN SUPPORT OF HOEGL  
ET AL.'S OPPOSITION TO SHATTUCK ET AL.'S MOTION TO  
COMPEL UNDER RULE 37 F.R.CIV.P.

AFFIDAVIT  
of  
Boris Haskell

State of Virginia            )  
County of Arlington        )

I, Boris Haskell, being duly sworn state that:

I am an attorney of record for the party Hoegl,  
et al. in Interference No. 98,047, Shattuck, et al. vs.  
Hoegl, et al., pending in the United States Patent and  
Trademark Office. Based on a review of my records, my  
recollections and my understandings, I make the following  
statements concerning certain events that transpired on  
or about June 14, 1974.

On or about June 14, 1974 I held a telephone  
conversation with Mr. Clyde C. Metzger (an attorney whom  
I knew to be representing Shattuck, et al.) concerning a  
stipulation presented for my signature for the suspension  
of proceedings in the Patent and Trademark Office in said  
Interference. During that conversation, Mr. Metzger  
stated in effect that there was an agreement between the  
parties to said Interference, providing that any court  
orders obtained in connection with the production of

*Affidavit of Boris Haskell*

documents of witness John W. Weigl (then being withheld as privileged) would apply to the documents of witness Anthony W. Karambelas (also being withheld as privileged), and that such agreement was made by Mr. Karambelas on behalf of Hoegl, et al.. (Mr. Karambelas was also an attorney representing the party Hoegl, et al. in said Interference). I responded to Mr. Metzger, stating that I was not aware of any such agreement; and in fact I was not (and still am not) aware of any such agreement or understanding.

(The working relationship between myself and Mr. Karambelas in respect to said Interference was so close, that I believe with considerable certainty that I would have been informed of any such significant event by Mr. Karambelas, if it had occurred.)

It appears that Mr. Karambelas was not available on June 14, 1974 (Friday). On Monday, June 17, 1974, I had a lengthy telephone conversation with Mr. Karambelas wherein this matter of the alleged agreement was discussed. Mr. Karambelas told me that there was no such agreement. He further pointed out that he could not have made such an agreement, because



*Affidavit of Boris Haskell*

the issues as between the Karambelas documents and the Weigl documents were quite different.

At some time subsequent to June 14, 1974, Mr. Karambelas described to me a telephone conversation he had with both Messrs. Metzger and Robert J. Kadel (also an attorney representing the party Shattuck, et al.), wherein he informed them that he had not made any such agreement as above described. It is my understanding that this latter telephone conversation occurred shortly after June 14, 1974.

It is, therefore, my understanding that:

- (1) There never was any agreement or understanding such as above described; and
- (2) In June 1974 the attorneys for the party Shattuck et al. were informed that the party Hoegl et al. denies that any such agreement ever existed.

\_\_\_\_\_  
Boris Haskell

Subscribed and Sworn to before me on the 18th  
day of December, 1975.

\_\_\_\_\_  
Notary Public  
My commission expires \_\_\_\_\_

[SEAL]

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IN THE UNITED STATES DISTRICT COURT AT ..... C.C. .... M.  
FOR THE WESTERN DISTRICT OF NEW YORK JOHN E. ADAMS, Clerk

AFFIDAVIT OF ANTHONY W. KARAMBELAS

I, ANTHONY W. KARAMBELAS, being duly sworn, depose  
and say:

2. Up until the time of my transfer to El Segundo, California in May of 1975 I was the attorney of record in charge of prosecuting the interference to which the above captioned action relates representing Hoegl et al.

3. Neither I nor to my knowledge has any representative of the party Hoegl et al ever suggested or agreed that any court ruling or order with respect to the production of



## Affidavit of Anthony W. Karambelas

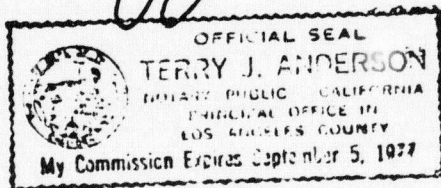
documents withheld by the witness John W. Weigl on the grounds of attorney-client privilege or attorney work product would apply to or control the production of other documents withheld by myself on the grounds of attorney-client privilege or attorney work product.

4. During the period of May and June 1974 I became aware that attorneys for the party Shattuck et al were alleging the existence of such an agreement or understanding. At that time I expressly and specifically informed the party Shattuck et al through its attorneys Clyde C. Metzger and Robert J. Kadel that no such agreement or understanding existed and any impression that they had to that effect was erroneous.

Anthony W. Karambelas  
Anthony W. Karambelas

Subscribed to and sworn  
before me this 19th day  
of December, 1975.

Terry J. Anderson  
Notary Public



SUPPLEMENTARY AFFIDAVIT OF ROBERT J. KADEL AND ANNEXED  
EXHIBITS A-C FILED IN SUPPORT OF SHATTUCK ET AL.'S  
MOTION TO COMPEL PRODUCTION UNDER RULE 37 F.R.CIV.P.

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF NEW YORK

-----	-X	
	X	
SHATTUCK ET AL.,	X	
	X	
Movants,	X	
	X	
v.	X	Patent Interference
	X	No. 98,047
HOEGL ET AL.,	X	
	X	
Respondents.	X	
-----	-X	

SUPPLEMENTAL AFFIDAVIT OF ROBERT J. KADEL

STATE OF NEW YORK :  
: ss.:  
COUNTY OF NEW YORK :

ROBERT J. KADEL, being duly sworn, deposes and says:

1. I am a member of the Bar of the State of New York, the Court of Appeals for the Second Circuit and of the firm of Pennie & Edmonds, 330 Madison Avenue, New York, New York 10017, counsel for movants, Meredith D. Shattuck and Ulo Vahtra ("Shattuck, et al."), in the above-captioned action.

2. Annexed hereto as Exhibit A is true copy of letter dated December 16, 1975 from Mr. Robert J. Kadel to Mr. Francis J. Hone which is referred to in the Shattuck et al. Supplemental Memorandum submitted herewith.

3. I have read the Affidavit of Clyde C. Metzger, dated December 31, 1975, submitted herewith, and I fully concur with, and hereby similarly attest to, the statements made therein with the exception that I have no personal knowledge as to his



## Supplementary Affidavit of Robert J. Kadel

statements regarding his conversations with Mr. Haskell. I similarly am not aware of any repudiation of the agreement, referred to in Mr. Metzger's Affidavit, between Mr. Karambelas, Mr. Metzger and myself until receipt of Mr. Francis J. Hone's letter dated November 14, 1975.

4. In a letter to Mr. Hone, dated July 24, 1975, a true copy of which is annexed hereto as Exhibit B, I referred to the agreement with Mr. Karambelas, and inquired as to whether the Karambelas documents of Shattuck et al. Exhibit 27 would voluntarily be produced once the dismissal of the appeal became final since, otherwise, Shattuck et al. "would want to apply promptly to Judge Burke for an order directed to Mr. Karambelas and Mr. Kondo, similar to that issued on May 7, 1974 with respect to Dr. Weigl".

5. Mr. Hone responded, in a letter dated July 25, 1975, a true copy of which is annexed hereto as Exhibit C, that Hoegl et al. would postpone making any decision about the documents specified in Shattuck et al. Exhibit 27 until the appeal in the case was finally dismissed.

Robert J. Kadel  
Robert J. Kadel

Subscribed and sworn to before me  
this 31st day of December, 1975.

Geraldine F. Savinelli  
Notary Public

GERALDINE F. SAVINELLI  
NOTARY PUBLIC, State of New York  
No. 31-4518-43  
Qualified in New York County  
Commission Expires March 20, 1976

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EXHIBIT A--LETTER DATED DECEMBER 16, 1975 FROM MR.  
KADEL TO MR. HONE ANNEXED TO SUPPLEMEN-  
TARY AFFIDAVIT OF ROBERT J. KADEL

BY HAND

December 16, 1975

20,088

Francis J. Hone, Esq.  
Brumbaugh, Graves, Donohue & Raymond  
30 Rockefeller Plaza  
New York, New York 10020

Re: Shattuck et al. v. Hoegl et al.  
Interference No. 98,047

Dear Frank:

This will acknowledge receipt of your letter dated December 11, 1975 wherein you set forth your summarization of our discussions seeking an amicable settlement of the issues raised by Shattuck et al's pending motion to compel production of documents.

As I pointed out to you during our discussions, Judge Burke has already ruled in this case, with respect to the witness Weigl, that Shattuck et al "are entitled to unrestricted access to sources of information bearing on the question of fraud." He also ruled that "It is essential that Shattuck et al have access to the [Weigl] documents to be able to present the facts to the Patent Office regarding the issue of fraud."

My primary concern during our discussions was that, with respect to each offer you made to amicably settle this matter, you insisted that we agree in advance to certain restrictions being placed upon sources of information which could well have a bearing on the issue of fraud.

Specifically, for example, as you note in your letter, you offered to make Dr. Weigl and Mr. Kondo available in Rochester for the continuation of their depositions without restriction.



Francis J. Hone, Esq.

Page 2

December 16, 1975

This, of course, is as it should be. With respect to Mr. Karambelas, however, you insisted that we agree that his deposition be continued on a more limited basis which presumably would be less than "without restriction."

Since, as stated above, Judge Burke has ordered that Shattuck et al are entitled to unrestricted access to sources of information bearing on the question of fraud so that all the facts can be presented to the Patent Office, and since the public interest is therefore also involved, we felt unable to agree, before even seeing the Karambelas documents, to restricting Mr. Karambelas' deposition in any manner which could possibly contravene the Court's orders previously issued in this action. It is believed that Mr. Karambelas' deposition should be continued without restriction, the same as Dr. Weigl and Mr. Kondo.

I respectfully suggest that the best procedure to follow would be to have the documents listed in Shattuck et al Deposition Exhibit 27 available in Court at the hearing on December 22, 1975 so that the Court can rule on any deletions you propose to make in them.

I would like to point out that we have attempted to amicably accommodate you whenever possible to do so. For example, you requested that Mr. Karambelas' deposition be held in California rather than Rochester. Although Shattuck et al would much prefer to have the deposition continued in Rochester, along with Dr. Weigl and Mr. Kondo, we agreed that it could be held in California so long as it was understood that it was being conducted under the supervision and control of Judge Burke. We also agreed, entirely for your convenience, to postpone the hearing on the present motion from December 8, 1975 to December 22, 1975 and we also agreed, at your request, and for the convenience of Dr. Weigl, to postpone his deposition, and that of Mr. Kondo, until early January, 1975.

I can assure you that in the future we shall continue to cooperate and attempt to amicably settle our differences whenever possible.

Very truly yours,

Robert J. Kadel

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EXHIBIT B--LETTER DATED JULY 24, 1976 FROM MR. KADEL  
TO MR. HONE ANNEXED TO SUPPLEMENTARY  
AFFIDAVIT OF ROBERT J. KADEL

PENNIE & EDMONDS

COUNSELLORS AT LAW

WILLIS H. TAYLOR, JR.  
JAMES W. LAINT  
THOMAS F. REDDY, JR.  
STANTON T. LAWRENCE, JR.  
J. PHILIP ANDEREGG  
FRANK F. SCHICK  
S. LESLIE NISHOCK  
CLYDE C. MITZLER  
DAVID J. TOOMEY  
HAROLD A. TRAYER  
HUBERT G. MOORE, JR.  
ROBERT MCKAY  
KEITH E. MULLENGER

ROBERT J. KADEL  
DAVID WEIGL, III  
CHARLES E. MCKENNEY  
HARRY C. JONES, III  
JAMES G. FOLEY  
BENJ. A. TERZIAN  
JOHN L. SIGALOS  
GERALD J. FLINTOFF  
PHILIP T. SHANNON  
SIDNEY R. BRESNICK  
BARRY D. REIN  
JONATHAN A. MARSHALL  
WILLIAM L. GREY  
\*VIRGINIA BAR

330 MADISON AVENUE  
NEW YORK, N. Y. 10017

(212) 986-8666  
CABLE: PENANGOLD

WASHINGTON OFFICE  
PENNSYLVANIA BUILDING  
WASHINGTON, D. C. 20004

July 24, 1975

Mr. Francis J. Hone, Esq.  
Brumbaugh, Graves, Donohue & Raymond  
30 Rockefeller Plaza  
New York, N. Y. 10020

Re: Shattuck et al v. Hoegl et al.  
Interference No. 98,047

Dear Frank:

In view of the July 16, 1975 decision of the United States Court of Appeals for the Second Circuit, and our desire to resume the depositions of Messrs. Weigl, Karambelas, and Kondo in the near future in connection with the allegedly privileged documents ordered to be produced by Judge Burke in his order dated May 7, 1974, would you kindly advise us as to whether you will voluntarily produce the documents listed in Shattuck et al Exhibit 27, namely, the allegedly privileged documents from Mr. Karambelas' files specified in the Karambelas subpoena (Karambelas deposition of April 24, 1974, pg. 95-6).

As you recall, when we applied to the Court for the order in connection with Dr. Weigl's allegedly privileged documents, Mr. Karambelas agreed, in a telephone conversation with Mr. Metzger and myself, that the legal issues settled by Judge Burke in connection with Dr. Weigl would obviously be applicable to the allegedly privileged documents withheld by Karambelas.

This, of course, is the same understanding we had in connection with the first discovery order of Judge Burke dated March 26, 1974. Since the subpoenas to each witness are identical in that they are directed to exactly the same group of documents, it was understood that Judge Burke's ruling as to Dr. Weigl would be applicable to Mr. Karambelas.



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Thus, in order to avoid going to Court on the same issue with each witness, and in order to expedite the interference, you permitted both Weigl and Karambelas, when their depositions were resumed on April 5, 1974 and April 24, 1974, to respond to substantive questions and produce the subpoenaed documents, except for the allegedly privileged documents of Weigl and Karambelas listed in Shattuck et al Exhibit 26 and 27 respectively (Karambelas deposition pg. 95-6).

If, therefore, Judge Burke's order of May 7, 1974 is ultimately upheld, we would appreciate your confirming your willingness to voluntarily produce the documents specified in Shattuck et al Exhibit 27 when we resume the depositions of Messrs. Weigl, Karambelas, and Kondo and your willingness to voluntarily permit their testimony in connection therewith. Otherwise we would want to apply promptly to Judge Burke for an order directed to Mr. Karambelas and Mr. Kondo, similar to that issued on May 7, 1974 with respect to Dr. Weigl.

Yours very truly,



Robert J. Kadel

cc: Anthony W. Karambelas, Esq. ~~w/enc1.~~

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EXHIBIT C--LETTER DATED JULY 25, 1975 FROM MR. HONE  
TO MR. KADEL ANNEXED TO SUPPLEMENTARY  
AFFIDAVIT OF ROBERT J. KADEL

BRUMBAUGH, GRAVES, DONOHUE & RAYMOND  
30 ROCKEFELLER PLAZA  
NEW YORK, N. Y. 10020

TELEPHONE 212 469-3333  
CABLE CAMBRUPPEE  
TELEX 423140

GRANVILLE M. BRUMBAUGH  
EBEN M. GRAVES  
NARA N. DONOHUE  
JOHN E. DUMARESCO  
DANA M. RAYMOND  
JOHN W. BRUMBAUGH  
RICHARD G. FULLER, JR.  
JAMES N. BUCKNER  
FRANK W. FORD, JR.  
FREDERICK C. CARVER  
GEORGE W. WHITNEY  
ALLEN G. WEISE

FRANCIS J. HONE  
WILLIAM F. EBERLE  
JOSEPH D. GARON  
ARTHUR S. TENSER  
DONALD S. DOWDEN  
RONALD B. MILDRETH  
ALLAN H. BONNELL  
GRANVILLE M. BRUMBAUGH, JR.  
THOMAS R. NESSITT, JR.  
ROBERT NEUNER  
RICHARD G. BERKLEY

EDWARD V. FILARDI  
RICHARD S. CLARK  
THOMAS D. MACELAIN  
BRADLEY B. GEIST  
PETER D. MURRAY  
CARL F. MILDE, JR.

JOHN M. HEARY  
RUSSELL M. FALCONER  
WILLIAM E. PELTON  
SANFORD J. ASHAN  
MELVIN C. GARNER  
RALPH W. SELITTO, JR.

July 25, 1974

Robert J. Kadel, Esq.  
Pennie & Edmonds  
330 Madison Avenue  
New York, New York 10017

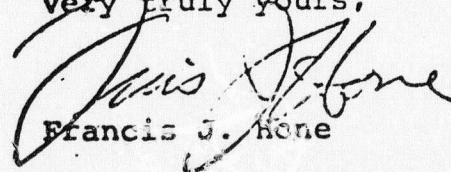
Re: Shattuck et al v. Hoegl et al  
Interference No. 98,047

Dear Bob:

This will acknowledge your letter of July 24, 1975 regarding the above-identified matter.

As I explained in our telephone conversation today, we will postpone making any decision about the documents specified in Shattuck et al Exhibit 27 until the appeal in this case has been finally dismissed or decided.

Very truly yours,

  
Francis J. Hone



State of New York :  
County of New York : ss.:  
:

On April 5, 1974, during the subsequent deposition of Dr. Weigl pursuant to the Court's order of March 26, 1974,

Hoegl et al. refused to produce certain documents on the grounds of attorney-client privilege and work product. Mr. Kadel and I, while preparing an order to show cause why the witness Weigl should not be compelled to produce the allegedly privileged documents, discussed the possibility that Mr. Karambelas and Mr. Kondo would also be withholding allegedly privileged documents on their depositions which were scheduled for April 24, 1974.

We thereupon telephoned Mr. Karambelas on or about April 23, 1974, and asked him whether or not the same type of agreement would apply to the production of the allegedly privileged documents that may be withheld during his deposition scheduled for April 24, 1974, namely, that if the Court ordered the production of the allegedly privileged documents with respect to Dr. Weigl, would Mr. Karambelas and Mr. Kondo follow the law of the case and produce any subpoenaed privileged documents that they might withhold during his deposition on April 24, 1974. To the best of my recollection Mr. Karambelas replied in the affirmative that if the Court ordered the production of the privileged documents with respect to Dr. Weigl, that Hoegl et al. would produce any documents that he may withhold on the grounds of attorney-client privilege during the April 24, 1974 deposition.

I subsequently, sometime in June, 1974, had a telephone conversation with Boris Haskell concerning a stipulation for an extension of time or suspension of proceedings of the interference in the Patent Office. This stipulation, as I recall,



contained a statement that Shattuck et al. was diligently pursuing the discovery in the courts. Mr. Haskell stated in effect that he did not want to sign this stipulation since he did not consider that Shattuck was being diligent, and thought that Shattuck et al. should have brought a similar order to show cause with respect to all witnesses, including Mr. Karambelas, to have all of the issues determined at one time. I explained to Mr. Boris Haskell, as he states in his affidavit attached to Hoegl et al. Opposition To Hoegl Et Al. To Shattuck Et Al. Motion To Compel Under Rule 37, that we were being very diligent in this matter and that it was not necessary to bring any order to show cause why Mr. Karambelas or Mr. Kondo should not produce their allegedly privileged documents, since there was an agreement between the parties providing that any court order obtained in connection with the production of documents of Dr. Weigl would apply to the witnesses, Mr. Karambelas and Mr. Kondo, as was agreed to and carried out with respect to the first order of the Court dated March 26, 1974.

I recall Mr. Boris Haskell's statement in his affidavit that he told me that he was not aware of any such agreement.

Subsequent to the conversation between Mr. Karambelas and Mr. Kadel and myself on or about April 23, 1974, and my conversation with Mr. Boris Haskell in June 1974 in which I informed him of this agreement, I have no knowledge of any repudiation or denial of this agreement. The first knowledge that I had that Hoegl et al. denied such an agreement was con-

*Affidavit of Clyde C. Metzger*

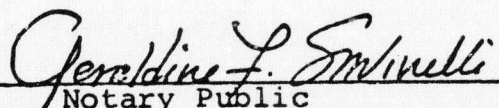
tained in Mr. Hone's letter to Mr. Kadel of November 14, 1975, attached to Hoegl et al. Opposition To Hoegl Et Al. To Shattuck Et Al. Motion To Compel Under Rule 37.

In any event, I was led to believe that this agreement was still in effect by failure to deny or repudiate the agreement after the admitted notice of it to Mr. Haskell and also after failure to deny or repudiate such agreement after Mr. Kadel's letter to Mr. Hone of July 24, 1975.

After denial or repudiation of this oral agreement, Shattuck et al. promptly brought a motion to compel production of the allegedly privileged documents.

  
Clyde C. Metzger

Subscribed and sworn to before me  
this 31st day of December, 1975.

  
Notary Public

GERALDINE F. SAVINELLI  
NOTARY PUBLIC, State of New York  
No. 31-4518-43  
Qualified in New York County  
Commission Expires March 20, 1976



NOTICE OF APPEAL DATED APRIL 9, 1976

ORIGINAL FILED

*April 9, 1976*  
2:50 P.M.JOHN K. ADAMS,  
ClerkUNITED STATES DISTRICT COURT  
WESTERN DISTRICT OF NEW YORK

SHATTUCK, ET AL,

Movants,

-VS-

HOEGL, ET AL,

Respondents.

NOTICE OF  
APPEAL

No. 98,047

NOTICE IS HEREBY GIVEN that the Movants herein,  
Meredith D. Shattuck, Ulo Vahtra and International Business  
Machines Corporation hereby appeal to the United States Court of  
Appeals for the Second Circuit from an Order of the Hon. Harold P.  
Burke dated the 11th day of March, 1976 and duly entered in the  
office of the Clerk of the U.S. District Court, Western District of  
New York on the 16th day of March, 1976 denying the motion of the  
Movants to compel the witness Karambelas to produce allegedly  
privileged documents and to compel witnesses to testify by deposi-  
tion in connection therewith, and this appeal is taken from each  
and every part of said Order as well as from the whole thereof.

Dated: April 9, 1976

Of Counsel:

Pennie & Edmonds  
Clyde C. Metzger  
Robert J. Kadel  
330 Madison Avenue  
New York, New York 10017

HARTER, SECREST &amp; EMERY

By

*Bruce E. Hansen*  
Bruce E. Hansen  
700 Midtown Tower  
Rochester, New York 14604  
Attorneys for Movants

Joseph G. Walsh, Esq.  
International Business Machines Corporation  
Monterey & Cottle Roads  
San Jose, California 95114

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Notice of Appeal Dated April 9, 1976

UNITED STATES DISTRICT COURT  
WESTERN DISTRICT OF NEW YORK

SHATTUCK, ET AL,

-vs-

HOEGL, ET AL,

Movants,

Respondents.

:

: CERTIFICATE  
: OF SERVICE

:

: No. 98,047

:

I hereby certify that a copy of the foregoing Notice of Appeal was served this day by mailing a copy thereof, postage prepaid to the following:

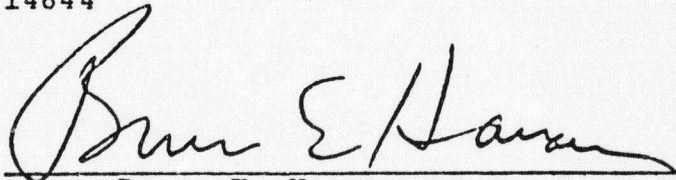
Francis J. Hones, Esq.  
Brumbaugh, Graves, Donohue & Raymond  
30 Rockefeller Plaza  
New York, New York 10020

Elliott Horton, Esq.  
(Of Counsel).  
Harris, Beach and Wilcox  
2 State Street  
Rochester, New York 14613

Boris Haskell, Esq.  
Paris, Haskell & Levine  
Pennsylvania Building  
425 13th Street N.W.  
Washington, D.C. 20004

Anthony W. Karambelas  
Xerox Corporation  
Xerox Square  
Rochester, New York 14644

Dated: April 9, 1976

  
Bruce E. Hansen



APPELLANTS' DESIGNATION OF CONTENTS OF RECORD  
WITH STATEMENT OF THE ISSUES

UNITED STATES DISTRICT COURT  
WESTERN DISTRICT OF NEW YORK

SHATTUCK, ET AL,

Movants,

-vs-

HOEGL, ET AL,

Respondents.

:  
: DESIGNATION OF  
: CONTENTS OF  
: RECORD AND  
: STATEMENT OF  
: ISSUE  
: No. 98,047

Movants-Appellants designate under Rule 11(a) of the Federal Rules of Appellate Procedure for inclusion in the Record on Appeal to the United States Court of Appeals for the Second Circuit, the following portions of the record in this matter:

1. NOTICE OF MOTION DATED NOVEMBER 26, 1975 AND ATTACHED THERETO SHATTUCK; ET AL MOTION UNDER RULE 37 F.R. CIV. P. TO COMPEL THE WITNESS KARAMBELAS TO PRODUCE ALLEGEDLY PRIVILEGED DOCUMENTS AND TO COMPEL WITNESSES TO TESTIFY IN CONNECTION THEREWITH. With attached Memorandum in Support thereof, and attached Affidavit of Robert J. Kadel with Exhibits 1-17 appended thereto.

2. OPPOSITION OF HOEGL, ET AL TO SHATTUCK ET AL'S MOTION TO COMPEL UNDER RULE 37 WITH ATTACHED AFFIDAVIT OF FRANCIS J. HONE AND EXHIBITS A-D APPENDED THERETO AND AFFIDAVITS OF BORIS HASKELL AND ANTHONY W. KARAMBELAS ATTACHED THERETO.

3. SHATTUCK, ET AL SUPPLEMENTAL MEMORANDUM IN SUPPORT OF MOTION TO COMPEL PRODUCTION OF DOCUMENTS AND TESTIMONY WITH PROPOSED ORDER ANNEXED THERETO, Supplemental Affidavit of Robert J. Kadel with Exhibits A-C and Affidavit of Clyde C. Metzger.

*Appellants' Designation of Contents of Record  
with Statement of the Issues*

4. HOEGL, ET AL REPLY MEMORANDUM IN OPPOSITION TO SHATTUCK,  
ET AL MOTION TO COMPEL.

5. DECISION AND ORDER OF THE COURT DATED MARCH 16, 1976.

6. NOTICE OF APPEAL DATED APRIL 9, 1976.

7. THIS DESIGNATION OF CONTENTS OF RECORD AND THIS STATEMENT  
OF ISSUE.

Appellants will contend that the District Court erred in:

A. Failing to compel witness Karambelas to produce allegedly  
privileged documents; and

B. Failing to compel witnesses to testify by deposition in  
connection therewith.

Dated: April 19, 1976

HARTER, SECREST & EMERY

By Bruce E. Hansen  
Bruce E. Hansen  
Attorneys for Movants-Appellants  
700 Midtown Tower  
Rochester, New York 14604

Of Counsel:

Pennie & Edmonds  
Clyde C. Metzger  
Robert J. Kadel  
330 Madison Avenue  
New York, New York 10017

Joseph G. Walsh, Esq.  
International Business Machines Corporation  
Monterey & Cottle Roads  
San Jose, California 95114



APPELLEES' RESPONSE TO DESIGNATION OF CONTENTS OF RECORD

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF NEW YORK

----- X

SHATTUCK ET AL.,	:	
	:	
Movants-Appellants,	:	
	:	Patent Interference
v.	:	No. 98,047
HOEGL ET AL.,	:	
	:	
Respondents-Appellees.	:	

----- X

APPELLEES' RESPONSE TO DESIGNATION  
OF CONTENTS OF RECORD

Pursuant to Rule 11 of the RULES SUPPLEMENTING FEDERAL  
RULES OF APPELLATE PROCEDURE for the United States Court of  
Appeals for the Second Circuit, Appellees hereby respond to  
Appellants' designation as follows:

1. Exhibits 15 and 16 appended to the Affidavit of  
Robert J. Kadel included in Item 1 of Appellants' designation  
are designated "Xerox Confidential" and were produced to the  
party Shattuck et al pursuant to a Stipulation and Order entered  
February 25, 1971 by the United States District Court for the  
Southern District of New York and were provided to the party

Shattuck et al in accordance with the Letter Agreement dated May 2, 1974 between Xerox Corporation and International Business Machines Corporation, the parties to Civil Action No. 70 Civ. 1596-DNE in the Southern District of New York. Appended hereto are copies of the Stipulation and Order, the Letter Agreement of May 2, 1974 and a letter dated December 4, 1975 transmitting to attorneys for Shattuck et al the documents which became Exhibits 15 and 16 to the Kadel Affidavit.

2. In accordance with the Stipulation and Order and the Letter Agreement between Xerox Corporation and International Business Machines Corporation, Exhibits 15 and 16 to the Kadel Affidavit were, or should have been, filed in the Western District of New York under seal. The undersigned counsel for Hoegl et al discussed this matter with counsel for Shattuck et al at the time of the Shattuck et al motion and were advised that appropriate steps were taken by Shattuck et al with respect to the filing of those documents.

3. In accordance with the Stipulation and Order, Exhibits 15 and 16 to the Kadel Affidavit should be transmitted under seal to the United States Court of Appeals for the Second



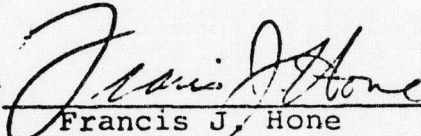
*Appellees' Response to Designation of Contents of Record*

Circuit, along with a copy of the Stipulation and Order.

Dated: April 28, 1976

BRUMBAUGH, GRAVES, DONOHUE & RAYMOND

By



Francis J. Hone  
Attorneys for Respondents-Appellees  
30 Rockefeller Plaza  
New York, New York 10020

(212) 489-3326

*Appellees' Response to Designation of Contents of Record*

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF NEW YORK

----- X

SHATTUCK ET AL.,	:	
Movants-Appellants,	:	
v.	:	Patent Interference
	:	98,047
HOEGL ET AL.,	:	
Respondents-Appellees.	:	

----- X

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Appellees' Response to Designation of Contents of Record was served this day by mailing a copy thereof, postage prepaid to the following:

Bruce E. Hansen  
Harter, Secrest & Emery  
700 Midtown Tower  
Rochester, New York 14604

Clyde C. Metzger  
Robert J. Kadel  
Pernie & Edmonds  
330 Madison Avenue  
New York, New York 10017

Joseph G. Walsh, Esq.  
International Business Machines Corporation  
Monterey & Cottle Roads  
San Jose, California 95114

Dated: April 28, 1976

\_\_\_\_\_  
Francis J. Hone



Appellees' Response to Designation of Contents of Record

IN THE UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF NEW YORK

----- X

XEROX CORPORATION,

Plaintiff,

v.

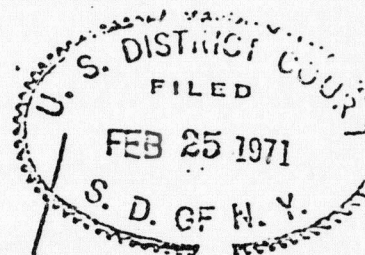
INTERNATIONAL BUSINESS MACHINES  
CORPORATION,

Defendant.

:  
:  
:  
:  
:  
:  
:  
:

Civil Action No.

70 Civ. 1596



----- X

STIPULATION AND ORDER

WHEREAS,

A. Xerox and IBM have entered into stipulations filed June 18, 1970 and July 16, 1970 relating to handling of documents and information alleged by Xerox to be trade secrets and confidential data and know-how previously disclosed to IBM by Xerox or generated by IBM under a joint development program with Xerox which documents and information are designated "Xerox Restricted".

B. IBM has served Interrogatories 27d, 27e and 27n on Xerox requiring identification of all documents relating to the conception, reduction to practice, testing and development into commercial form of the subject matter of the Xerox Patents in suit.

C. In response to such interrogatories and pursuant to a stipulation filed June 8, 1970, Xerox has

*Appellees' Response to Designation of Contents of Record*

offered to supply IBM with copies documents XC 0001 - XC 1520 which Xerox alleges contain trade secret information and confidential data and know-how never before given to IBM, such as laboratory notebook pages, laboratory reports, test reports, engineering drawings and the like, which Xerox wishes to maintain confidential;

IT IS HEREBY STIPULATED AND AGREED by and between the parties to this action, by their respective attorneys, that:

1. Any document or information in writing supplied by Xerox to IBM in this action which Xerox alleges to contain or constitute information not previously communicated by Xerox to IBM and which Xerox alleges is now a trade secret or confidential data or know-how shall be stamped or otherwise designated by Xerox as "Xerox Confidential" (in the event only a portion of a document or information in writing is alleged by Xerox to contain or constitute information which was not previously communicated by Xerox to IBM in confidence and which is alleged by Xerox to now be a trade secret or confidential data or know-how, Xerox shall designate such portion of such document or such information) and any document or information so designated shall be handled in accordance with the terms of this Stipulation and Order.

2. Except as required in the conduct of Court Proceedings or depositions, Xerox Confidential documents and



*Appellees' Response to Designation of Contents of Record*

written information shall not be disclosed to any person other than IBM counsel (i.e., IBM house counsel directly involved in this litigation and outside counsel retained by IBM in connection with this litigation), technical experts and consultants to such counsel (whether or not in the employ of IBM) and necessary secretarial and clerical personnel, except as otherwise provided in this Stipulation and Order. Before any such document or information is disclosed to any person who is not IBM counsel, or necessary secretarial or clerical personnel thereof, that person shall be given a copy of this order and shall acknowledge in writing to IBM, or its counsel, that he is fully familiar with the provisions of the order and agrees to comply with and be bound thereby.

3. Xerox Confidential documents and written information shall be used by IBM counsel and technical experts and consultants to such counsel, and necessary secretarial and clerical personnel only for the purposes of this action or for dealing with any claim or controversy which is or shall be the subject of this action.

4. If IBM should plan to file or present in Court or make public in connection with a proceeding in Court, or to use at a deposition, any Xerox Confidential document or written information supplied to IBM and so designated by Xerox pursuant to this Stipulation and Order, IBM shall give

reasonable notice to Xerox in order to provide Xerox with an opportunity to seek a protective order from the Court before such document is filed or presented, but IBM reserves the right to oppose any such application. IBM will not file or present in Court, or make public in connection with any motion for a protective order filed by Xerox. Alternatively, IBM may file Xerox Confidential documents and documents embodying Xerox Confidential information in Court under seal with instructions to the Clerk of the Court that pursuant to this Stipulation and Order, the documents filed under seal are not to be disclosed to any person other than the Court or counsel for the parties to this action unless otherwise ordered by the Court.

5. Xerox Confidential documents and documents embodying Xerox Confidential information may be used in depositions with instructions to the reporter that, pursuant to this Stipulation and Order, the deposition and deposition exhibits shall be filed in Court under seal with instructions to the Clerk of the Court that, pursuant to this Stipulation and Order, the documents filed under seal are not to be disclosed to any person other than the Court or counsel for the parties to this action unless otherwise ordered by the Court. Before using any Xerox Confidential documents or documents embodying Xerox Confidential information in connection with the deposition of a witness who is neither IBM



*Appellees' Response to Designation of Contents of Record*

counsel, nor a technical expert or consultant thereto, or a Xerox employee, the witness shall be given a copy of this Stipulation and Order and shall acknowledge in writing that he is fully familiar with the provisions of the order and agrees to comply with and be bound thereby.

6. The restrictions and obligations relating to Xerox Confidential documents and written information set forth in this Stipulation and Order shall not apply to any such document or information which both parties agree, or the Court rules, is already public knowledge or becomes public knowledge other than as a result of disclosure by IBM, or which has come or shall come into IBM's possession independently of Xerox, and shall not be deemed to prohibit IBM counsel from discussing with any person any information or document designated as Xerox Confidential if that person already has possession of all of the information to be discussed from an independent source unrelated to IBM and not resulting from disclosure by IBM. —

7. Neither this Stipulation and Order nor the supplying or identifying by Xerox to IBM of documents or information pursuant to it, nor any proceedings pursuant to this Stipulation and Order, shall be deemed to have the effect of any admission or waiver by either party, or of altering the confidentiality or non-confidentiality of

## Appellees' Response to Designation of Contents of Record

any such document or information or of altering any existing obligation of either party, or the absence thereof.

8. This Stipulation and Order shall be without prejudice to the right of either party to bring before the Court at any time the question of whether any particular document or information is confidential or whether its use should be restricted.

BRUMBAUGH, GRAVES, DONOHUE & RAYMOND

By

Francis J. Hone

Francis J. Hone  
Attorneys for Plaintiff  
90 Broad Street  
New York, New York 10004

Tel. No. (212) 344-5288

FISH & NEAVE

By

Charles H. Walker

Charles H. Walker  
Attorneys for Defendant  
277 Park Avenue  
New York, New York 10017

Tel. No. (212) 826-1050

Dated: New York, New York

FEBRUARY 25, 1971.

SO ORDERED: 2-25-71

Maurice E. Frankel

United States District Judge

EA



*Appellees' Response to Designation of Contents of Record*

May 2, 1974

Ronald Zibelli, Esq.  
Xerox Corporation  
High Ridge Park  
Stamford, CT 06904

Dear Ron:

This is to confirm the understanding that documents previously produced or hereafter produced by IBM or Xerox in the United States litigation involving Xerox Corporation and International Business Machines Corporation (70 Civ. 1596 and 73 Civ. 3421) and the Canadian litigation involving Xerox of Canada Limited, Xerox Corporation and IBM Canada Limited (Court Nos. T-730-72, T-7317-73 and T-3239-73), may be used by counsel for IBM or Xerox in connection with two United States patent interferences and two Canadian conflict proceedings (including appeals and ancillary court proceedings connected therewith) and hereafter collectively referred to as the "interference and conflict matters". The United States interferences are numbers 97,999 and 98,047 and the Canadian patent applications Serial Nos. 992,855 and 067,576. The term "counsel" shall mean any counsel retained by IBM or Xerox in connection with the interference and conflict matters, technical experts and consultants used by such counsel in connection with these matters and necessary secretarial and clerical personnel. Documents produced in any of the interference and conflict matters also may be used in any or all of the other of such interference and conflict matters.

This understanding shall not include or extend to any document which is (a) subject to the terms of a stipulation or protective order covering the production of documents containing allegedly attorney-client privilege or work product information on a limited basis for the purpose of challenging a claim of privilege or work product, (b) produced by a person or organization not a party to the above litigations and pursuant to a protective order, or (c) subject to the terms of a stipulation or protective order which does not provide for the disclosure of the document to house attorneys for IBM or Xerox.

*Appellees' Response to Designation of Contents of Record*

Ronald Zibelli, Esq.  
Page Two  
May 2, 1974

The documents and information contained therein which are made available in accordance with this understanding shall be used only for the purposes of the interference and conflict matters and for no other purpose. The terms of any and all applicable stipulations and protective orders entered and filed in the above litigations in court relative to the filing or presenting or making use at a deposition of any document will be observed in the interference and conflict matters. This agreement waives the stipulations and orders between the parties in the above-identified litigations only to the extent indicated above and only with respect to the interference and conflict matters. This agreement does not alter or effect in any manner the scope of discovery or the issues involved in such litigations and interference and conflict matters.

If the above correctly reflects our understanding, please date and sign this original and the enclosed copy of this letter and return the original for our records.

INTERNATIONAL BUSINESS MACHINES CORPORATION

By /S/ Paul D. Carmichael  
Paul D. Carmichael  
Corporate Patent Counsel

XEROX CORPORATION

By Ronald Zibelli  
Manager, Patent Licensing & Litigation

Date \_\_\_\_\_



A 175

*Appellees' Response to Designation of Contents of Record*

BRUMBAUGH, GRAVES, DONOHUE & RAYMOND

30 ROCKEFELLER PLAZA

NEW YORK, N. Y. 10020

TELEPHONE 212 487-3100  
CABLE CAMEBROFEE  
TELEX 423149

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HAROLD DONOHUE  
JOHN C. O'HARE  
DAVID M. RAYMOND  
JOHN W. BRUMBAUGH  
RICHARD G. FULTON, JR.  
JAMES N. SUGAN  
FRANK W. FORD, JR.  
FREDERICK C. CARNEY  
GEORGE A. WHITNEY  
ALLEN G. WEISE

FRANCIS J. HONE  
WILLIAM F. EBERLE  
JOSEPH D. GARDIN  
ARTHUR S. FENSER  
DONALD S. DOWDEN  
DONALD B. HILDRETH  
ALLAN M. BONHELL  
GRANVILLE M. BRUMBAUGH, JR.  
THOMAS R. HESSITT, JR.  
ROBERT NEUMER  
RICHARD G. BARKLEY

EDWARD V. FILARDI  
RICHARD S. CLARK  
THOMAS D. MACDONALD  
BRADLEY B. GEIST  
PETER D. MURRAY  
EARL F. WILDE, JR.  
JOHN M. HEART  
RUSSELL H. FALLOON

WILLIAM E. PELTON  
MELVIN C. GARNER  
RALPH W. SELITTO, JR.  
WILLIAM R. EVANS  
LEIGHTON R. H. CHONG  
JAMES R. NELSON  
RICHARD C. KIMSON

December 4, 1975

BY HAND

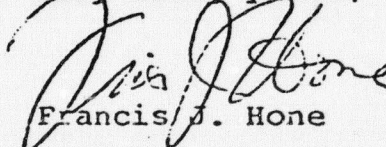
Robert J. Kadel, Esq.  
Pennie & Edmonds  
330 Madison Avenue  
New York, NY 10017

Re: Shattuck et al v. Hoegl et al  
Patent Interference 98,047

Dear Bob:

Pursuant to your request, I have enclosed a copy each of the STIPULATION AND ORDER entered in 70 Civ. 1596 which covers "Xerox Confidential" documents and the May 2, 1974 letter from Carmichael to Zibelli obligating IBM to the terms of this stipulation with respect to documents produced in the above-identified interference.

Very truly yours,

  
Francis J. Hone

Enclosures

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ORDER OF JUDGE BURKE DATED MAY 5, 1976

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF NEW YORK

SHATTUCK ET AL,

Movants-Appellants,

-VS-

HOEGL ET AL,

Respondents-Appellees.

:

:

:

:

ORDER

: Patent Interference  
No. 98,047

Pursuant to a request by counsel of the parties, it is  
hereby

ORDERED, that Exhibits 15 and 16 appended to the affidavit  
of Robert J. Kadel included in Item 1 of Appellants' designation  
of the record for appeal is to be placed under seal and transmitted  
to the United States Court of Appeals for the Second Circuit  
where it will be maintained under seal.

Dated: May 5, 1976

  
Hon. Harold P. Burke



AMENDED APPELLANTS' RESPONSE TO APPELLEES' RESPONSE  
TO DESIGNATION OF RECORD

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF NEW YORK

SHATTUCK ET AL,	)	AMENDED
	)	APPELLANTS' RESPONSE
Movants-Appellants,	)	TO APPELLEES' RESPONSE
	)	<u>TO DESIGNATION OF RECORD</u>
-vs-	)	
	)	Patent Interference
HOEGL ET AL,	)	No. 98,047
	)	
Respondents-Appellees.	)	

Appellants, in response to Appellees' statements under Rule 11 of the Supplementary Federal Rules of Appellant Procedure for the United States Court of Appeals for the Second Circuit, hereby state as follows:

1. Exhibits 15 and 16 appended to the affidavit of Robert J. Kadel included in Item 1 of Appellants' designation are among certain documents produced to the party Shattuck, et al, by the party Hoegl, et al, pursuant to Judge Burke's Order dated May 7, 1976, wherein the Judge held:

"Reference is here made to the Order of this Court dated March 26, 1974 compelling the witness Weigl to testify and to produce documents, including the documents now withheld, and holding in part, 'the Movants are entitled to unrestricted access to sources of information bearing on the question of fraud...'. It is essential that Shattuck, et al, have access to the documents to be able to present the facts to the Patent Office regarding the issue of fraud."

2. Exhibits 15 and 16 were not, therefore, produced to the party Shattuck, et al, pursuant to a Stipulation and Order entered February 25, 1971 by the United States District Court for the Seventh District of New York as stated by the Appellees.

*Amended Appellants' Response to Appellees' Response  
to Designation of Record*

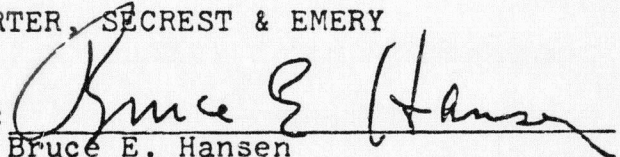
3. The party Shattuck, et al, however, did agree for the purposes of expediency of its motion before this Court to maintain the confidentiality of Exhibits 15 and 16, and, further, the party Shattuck, et al, will agree solely for the purposes of this appeal to continue to maintain the confidentiality of said Exhibits 15 and 16.

4. The party Shattuck, et al, nevertheless, remains firm in its contention that the Stipulation and Order referred to by the party Hoegl, et al, is not applicable to Exhibits 15 and 16 but, in order to facilitate the progress of this appeal, they agree to the filing of said exhibits under seal.

Dated: May 11, 1976

HARTER, SECREST & EMERY

By:



Bruce E. Hansen

Attorneys for Movants-Appellants  
700 Midtown Tower  
Rochester, New York 14604

Of Counsel:

Pennie & Edmonds  
Clyde C. Metzger  
Robert J. Kadel  
330 Madison Avenue  
New York, New York 10017

Joseph G. Walsh, Esq.  
International Business Machines Corporation  
Monterey & Cottle Roads  
San Jose, California 95114



*Amended Appellants' Response to Appellees' Response  
to Designation of Record*

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF NEW YORK

SHATTUCK ET AL,

Movants-Appellants,

-vs-

HOEGL ET AL,

Respondents-Appellees.

CERTIFICATE OF SERVICE

No. 98,047

I hereby certify that a copy of the foregoing Amended Appellants' Response to Appellees' Response to Designation of Record was served this day by mailing a copy thereof, postage prepaid to the following:

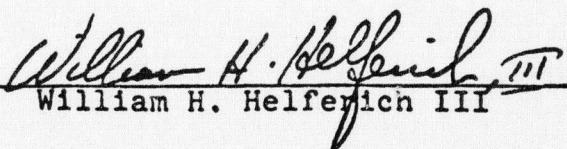
Francis J. Hone, Esq.  
Brumbaugh, Graves, Donohue & Raymond  
30 Rockefeller Plaza  
New York, New York 10020

Elliott Horton, Esq. (of Counsel)  
Harris, Beach and Wilcox  
2 State Street  
Rochester, New York 14614

Boris Haskell, Esq.  
Paris, Haskell & Levine  
Pennsylvania Building  
425 13th Street, N.W.  
Washington, D. C. 20004

Anthony W. Karambelas  
Xerox Corporation  
Xerox Square  
Rochester, New York 14614

Dated: May 11, 1976

  
William H. Helfferich III

A 180

CLERK'S CERTIFICATE CERTIFYING RECORD ON APPEAL

CLERK'S CERTIFICATE

UNITED STATES DISTRICT COURT  
WESTERN DISTRICT OF NEW YORK

SHATTUCK, et al.,

Movants

Misc. Civil

v.

(Patent Interference  
No. 98,047)

HOEGL, et al.,

Respondents

I, JOHN K. ADAMS, Clerk of the United States District Court for the Western District of New York, do hereby certify that the copy of docket entries lettered A through C, together with pertinent original papers numbered 1 through 11, constitute the Record on Appeal, and that the notice of appeal was filed on April 9, 1976.

IN WITNESS WHEREOF, I have hereunto  
subscribed my name and affixed the seal  
of the aforesaid Court at Buffalo, New  
York, this 17th day of May, 1976.

John K. Adams  
JOHN K. ADAMS, Clerk

I HEREBY ACKNOWLEDGE RECEIPT  
OF THE CERTIFIED COPY OF DOCKET  
ENTRIES, INDEX AND 11  
VOLUMES OF ORIGINAL RECORD.

DATE: 5-19-76

A. DANIEL FUSARO  
CLERK, U.S.C.A. 2nd CIR.

*10/10/11  
act clerk*



COPY RECEIVED

JUL 14 1976

BRUMBAUGH, GRAVES, DONOHUE & RAYMOND

ATTORNEYS FOR Hoeyl et al

BY Francis J. Hane/ch